TRANSCRIPT OF RECORD

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1926

No. 220-36

THE I. T. S. RUBBER COMPANY, PETITIONER,

vs.

ESSEX RUBBER COMPANY

ON WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE FIRST CIRCUIT

PETITION FOR CERTIORARI FILED DECEMBER 22, 1926

CERTIORARI GRANTED JANUARY 17, 1927

(30,750)

(30,750)

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[fol. 1] [Caption omitted]

IN UNITED STATES DISTRICT COURT

No. 1008, Equity Docket

THE I. T. S. RUBBER COMPANY, Plaintiff,

v.

ESSEX RUBBER COMPANY, Defendant

BILL OF COMPLAINT—Filed June 21, 1920

[Original Bill Filed June 21, 1920; Amended November 15, 1920, and November 27, 1920.]

To the Honorable the Judges of the District Court of the United States for the District of Massachusetts:

The plaintiff, for its bill of complaint, says:

(1) This is a suit in equity, arising under the patent laws of the United States.

(2) Plaintiff is a corporation organized and existing under the laws of the State of Ohio and having a regular and established [fol. 2] place of business in Elyria, Ohio, and the defendant, Essex Rubber Company, is a New Jersey corporation, having a regular and established place of business at 58 Lincoln Street, Boston Mass., within the District of Massachusetts, wherein the acts of infringement herein complained of took place.

(3) John G. Tufford, being within the meaning of the statutes of the United States the first, true, original and sole inventor of certain improvements in resilient heels which had not been known or used by others in this country before his invention or discovery thereof, or more than two years prior to his application to the United States Patent Office for a patent therefor, and not patented or described in any printed publication in this or any foreign country before his invention or discovery thereof, or more than two years prior to his application, and which had not been in public use or on sale in this country for more than two years prior to his said application, and which had not been abandoned, and not patented or caused to be patented by him or his legal representatives or assigns in any foreign country upon an application therefor, filed more than twelve months prior to the filing of his said application for Letters Patent of the United States, and being entitled to a patent therefor under the provisions of said statutes, duly applied to the Commissioner of Patents of the United States for Letters Patent thereon, on July 21, 1913. Thereafter, and prior to the issue of the herein-mentioned original patent from said application, the said Tufford assigned by instruments in writing,

duly recorded in the United States Patent Office, one-sixth of his entire right, title and interest in said application and in said invention to Carl H. Ingwer, of Elyria, Ohio, one-sixth thereof to Arthur G. Smith, of Elyria, Ohio, and one-twelfth thereof to William C. Smith, of Elyria, Ohio, and requested that the patent so issue. All of the requirements of the statutes then in force having been complied with, there were issued, under date of September 15, 1914, to the said Tufford, Ingwer, A. G. Smith and W. C. Smith, United States Letters Patent No. 1,110,730, for such improvements whereby there was secured to said Tufford, Ingwer, A. G. Smith and W. C. Smith their legal representatives and assigns, for the [fol. 3] term of seventeen years, from September 15, 1914, the exclusive right to make, sell and use said improvements.

Thereafter, on October 9, 1914, prior to the issue of the hereinafter-mentioned reissue patent, the said Tufford, Ingwer, A. G. Smith and W. C. Smith assigned, by another instrument in writing, dated October 9, 1914, and duly recorded in the United States Patent Office, all of the right, title and interest in the said patent No. 1,110,730 and to the said Tufford improvement in resilent heels to the plaintiff herein.

(4) Thereafter, on the twenty-second day of June, 1915, for good and lawful cause, plaintiff herein surrendered said original Letters Patent No. 1,110,730 to the Commissioner of Patents, and having made due application therefor on June 22, 1915, and having in all things complied with the acts of Congress in such cases made and provided, said original Letters Patent were cancelled and new Letters Patent, which were marked "Reissued January 11, 1916, No. 14,049", were, on January 11, 1916, in due form of law, issued to the plaintiff, which said mentioned reissued Letters Patent are of record in the Patent Office of the United States and which (or a certified copy thereof) is ready here in court to be produced. (Copy of reissue patent attached.)

(5) Since the date of said last named assignment conveying the rights to the plaintiff herein, and since January 11, 1916, the plaintiff has been and is now possessed of all the right, title and interest in and to said invention and said reissued Letters Patent, and entitled to all the benefits thereof.

(6) And plaintiff further shows that the plaintiff recovered a decree on said Letters Patent in suit in the District Court of the United States for the Northern District of Ohio, Eastern Division, against Fetzer & Spies Leather Co., which decree was sustained by the United States Circuit Court of Appeals for the Sixth Circuit (260 Fed. 939); and the plaintiff did recover a decree upon said Letters Patent here in suit in the District Court of the United States for the Northern District of Ohio, Eastern Division, against United States Rubber Company, which was sustained by the United States Circuit Court of Appeals for the Sixth Circuit (260 F. R. 947); [fol. 4] and thereafter, the plaintiff did recover a decree upon said Letters Patent in suit in the District Court of the United

States for the Northern District of Ohio, Eastern Division, against the Hill Rubber Heel Company; and thereafter the plaintiff did recover a decree upon said Letters Patent in suit in the District Court of the United States for the Northern District of Ohio, Eastern Division, against Tee Pee Rubber Company, Inc., and still another decree upon said Letters Patent in suit in the District Court of the United States for the District of Rhode Island against United Lace & Braid Manufacturing Co.

Plaintiff has recovered default decrees on articles made by this defendant, and like, or substantially like, those here charged to infringe in the following five instances: H. H. Hackman & Co. and Thomas Urbansky & Sons Co., in the Northern District of Ohio, Eastern Division; John Piatek & Co. in the Northern District of Ohio, Western Division, and against Jones & Rosser and John Wendt in the Eastern District of Michigan.

The plaintiff herein did, about February 25, 1920, file its bill of complaint in the United States District Court for the Eastern District of Michigan, Southern Division, against Walter Wendt, doing business as Walter Wendt & Co., alleging infringement of claims five (5) to nine (9), inclusive, of the Tufford reissue patent No. 14,049 here in suit, by said Wendt, by the sale of Essex Tite-Edge heels exactly like (except perhaps as to size and color) "Plaintiff's Exhibit No. 1, Defendant's Heels", and asking for the relief usually asked for in patent cases. Essex Tite-Edge heels exactly like those constituting Plaintiff's Exhibit No. 1, Defendant's Heels, here (except perhaps in size and color) were exhibits in the Wendt case.

Plaintiff is informed and believes that the Essex Rubber Company assumed the entire charge of such suit, controlled and maintained such suit until entry of final decree, about November 1, 1920. Plaintiff is informed and believes that the Essex Rubber Company participated in such suit and did agree with said Wendt to, and did, pay all the expenses thereof, including defendant counsel's expenses and fees, costs and judgment.

[fol. 5] After the time when plaintiff is informed and believes the Essex Rubber Company assumed entire control of this suit, an interlocutory pro confesso decree was entered, adjudging the patent valid and infringed, and thereafter the matter was referred to a master for an accounting. Proceedings were had in connection with the accounting and before the master, at which counsel, who, plaintiff is informed and believes, was attorney for and in the employ of the Essex Rubber Company, appeared and presented the Essex Rubber Company's interests. Thereafter plaintiff's claim for damages and profits having been adjusted between plaintiff and counsel, who, plaintiff was informed and believed, was attorney for the Essex Rubber Company, final decree was entered about November 1, 1920, adjudging the patent valid and infringed by the sale of such Essex Tite-Edge heels, title in the plaintiff, and ordering the issue of a permanent injunction, and that plaintiff recover in lieu of profits from the sale of Essex Tite-Edge heels the amount agreed upon. And it was agreed, prior to entry of final

decree, by counsel for defendant, who plaintiff is and was then informed and believes was in the employ of and acting for the Essex Rubber Company, that there would be no appeal from such final decree, and such agreement was executed and filed in court.

Plaintiff was informed of and believed in the exclusive control of the suit by the Essex Rubber Company, its participation in such suit, its contributions thereto and its conduct and maintenance thereof from time to time during the prosecution of the suit and all before the entry of final decree therein, as such actions were done openly by the Essex Rubber Company. Wherefore, in view of the above facts, the Essex Rubber Company, defendant in the case at bar, is concluded and estopped by the judgment in the said Wendt case from contesting each and every issue in the case at bar, and each and every such issue is res adjudicata, so far as the defendant here is concerned.

The plaintiff herein did, about February 25, 1920, file its bill of complaint in the United States District court for the Eastern District of Michigan, Southern Division, against Jones & Rosser, a co-partnership, alleging infringement of claims five (5) to nine (9), [fol. 6] inclusive, of the Tufford reissue patent No. 14,049 here in suit by said Jones & Rosser, by sales of Essex Tite-Edge heels, exactly like (except perhaps as to size and color) Plaintiff's Exhibit No. 1, Defendants's Heels, in the case at bar, and asking for the relief usually asked for in patent cases. Essex Tite-Edge heels exactly like those constituting Plaintiff's Exhibit No. 1, Defendant's Heels, here (except perhaps in size and color) were exhibits in the Jones & Rosser case.

Plaintiff is informed and beiieves that the Essex Rubber Company assumed the entire charge of said suit, controlled and maintained such suit until entry of final decree about November 1, 1920. Plaintiff is informed and believes that the Essex Rubber Company participated in such suit and did agree with such Jones & Rosser to, and did, pay all expenses thereof, including defendant counsel's expenses and fees, cost and judgment.

After the time when plaintiff is informed and believes the Essex Rubber Company assumed entire control of this suit an interlocutory pro confesso decree was entered, adjudging the patent valid and infringed, and thereafter the matter was referred to a master for an accounting. Proceedings were had in connection with the accounting and before the master, at which counsel, who, plaintiff is informed and believes, was in the employ of the Essex Rubber Company, appeared and represented the defendant. Thereafter plaintiff's claim for damages and profits having been adjusted between plaintiff and counsel who, plaintiff was informed and believes, was employed by the Essex Rubber Company, final decree was entered about November 1, 1920, adjudging the patent valid and infringed by the sale of such Essex Tite-Edge heels, title in the plaintiff, and ordering the issue of a permanent injunction, and that plaintiff recover in lieu of profits from the sale by the defendant, Jones & Rosser, of Essex Tite-Edge heels, the amount agreed upon, and it was agreed, prior to the entry of final decree,

by counsel for defendant, who, plaintiff is and was then informed and believed, and was in the employ of and acting for the Essex Rubber Company, that there would be no appeal from such final [fol. 7] decree, and such was executed by counsel for plaintiff, and by counsel for defendant filed in court.

Plaintiff was informed of and believed in the exclusive control of the suit by the Essex Rubber Company, its participation in such suit, its contribution thereto, and its conduct and maintenance thereof from time to time during the prosecution of the suit and before the entry and final decree therein, as such actions were done openly by the Essex Rubber Company. Wherefore, in view of the above facts, the Essex Rubber Company, defendant in the case at bar, is concluded and estopped by the judgment in the said Jones & Rosser case from contesting each and every issue in the case at bar, and each and every such issue is res adjudicata, so far as the defendant here is concerned.

The plaintiff herein did, about the seventeenth day of October, 1919, file its bill of complaint in the United States District Court for the Northern District of Ohio, Eastern Division, against H. H. Hackman & Co., a partnership, alleging infringement of claims five (5) to nine (9), inclusive, of Tufford reissue patent No. 14,049 here in suit, by said H. H. Hackman & Co., by the sale of Essex Tite-Edge heels, exactly like (except perhaps as to size and color) Plaintiff's Exhibit No. 1, Defendant's Heels, in the case at bar, and asking for the relief usually asked for in patent cases. Essex Tite-Edge heels exactly like (except perhaps in size and color) those constituting Plaintiff's Exhibit No. 1, Defendant's Heels, here were filed in the court there.

Thereafter, during the month of October, 1919, the plaintiff moved for a preliminary injunction in the said Hackman case, which was heard about November 8, 1919, by his Honor Judge Westenhaver, to whom were submitted in connection with the motion heels exactly like (except perhaps in size and color) the heel lifts constituting Plaintiff's Exhibit No. 1, Defendant's Heels, in the instant case, which were inspected by his Honor Judge Westenhaver, and a preliminary injunction was granted.

Thereafter, about December 23, 1919, an interlocutory pro confesso decree was entered, and thereafter, about August 7, 1920, a final decree was entered.

[fol. 8] Plaintiff is informed and believes that defendant here, the Essex Rubber Company, contributed to the expenses of such suit, paying all such expenses thereof, and agreeing in advance with H. H. Hackman & Co. to pay all of the expenses of said suit. Plaintiff is informed and believes that all court costs were paid directly by the defendant in the instant case. All of these acts were done to the knowledge of plaintiff, which was acquired before the entry of final decree.

Wherefore, in view of the above facts, the Essex Rubber Company, defendant in the case at bar, is concluded and estopped by the judgment in the said Hackman case from contesting each and every issue in the case at bar, and each and every such issue is res adjudicata, so far as the defendant here is concerned.

Plaintiff here did, about December 7, 1919, file its bill of complaint in the United States District Court for the Northern District of Ohio, Eastern Division, against Thomas Urbansky & Sons Co., of Cleveland, Ohio, alleging infringement of claims five (5) to nine (9), inclusive, of the Tufford reissue patent No. 14,049 here in suit, by said Thomas Urbansky & Sons Co., by the sale of Essex Tite-Edge heels, exactly like (except perhaps as to size and color) Plaintiff's Exhibits Nos. 1 and 2, Defendant's Heels, in the case at bar, and asking for the relief usually asked for in patent cases. Essex Tite-Edge heels exactly like those constituting Plaintiff's Exhibits Nos. 1 and 2, Defendant's Heels, here (except perhaps as to size and color) were filed in the court there.

Plaintiff is informed and believes that the Essex Rubber Company, the defendant here, paid all of the expenses of the said Urbansky suit, and that Urbansky took no steps therein without consulting the Essex Rubber Company and obtaining their direction with regard to said suit, and further that the Essex Rubber Company agreed with Urbansky to pay all of the expenses of such suit directly after the suit was instituted.

About January 28, 1920, an interlocutory pro confesso decree was entered in the said Urbansky suit, adjudging the patent valid and infringed, and thereafter the matter was referred to a master for an accounting. Proceedings were had in connection with the [fol. 9] accounting and before the master, and plaintiff's claim for damage and profits having been adjusted, final decree was entered August 7, 1920.

Plaintiff was informed of the control of the suit by the Essex Rubber Company and its contribution thereto prior to the entry of final decree therein, as such actions were done openly by the Essex Rubber Company.

Wherefore, in view of the above facts, the Essex Rubber Company, defendant in the case at bar, is concluded and estopped by the judgment in the said Urbansky case from contesting each and every issue in the case at bar, and each and every such issue is res adjudicata, so far as the defendant here is concerned.

(7) Plaintiff avers on information and belief that since January 11, 1916, the date of the reissue of said Letters Patent and prior to the filing of this bill of complaint, the defendant, Essex Rubber Company, within the District of Massachusetts and elsewhere in the United States, sold or caused to be sold, or used or caused to be used, or threatened to sell or use, resilient heels which embody the improvements described in said reissue Letters Patent No. 14,049, unlawfully and without the license of plaintiff and in infringement of said Letters Patent and plaintiff's rights thereunder, all unlawfully and without the license of said plaintiff, and said defendant threatens to continue said infringement, and has gained great profits from such infringement, plaintiff is informed and believes, wherefore plaintiff prays that the defendant may be required to make full discovery of the gains from such infringement.

Claims 5 to 9 inclusive are infringed.

(8) The plaintiff has marked its resilient heels with the word "Patented" and the number and date of the reissue patent here in suit. The defendant has infringed said patent since plaintiff's heels, so marked with the word "Patented" and the date of the reissue patent, have been distributed.

(9) But for the wrongful acts of this defendant, the plaintiff would be able to make, use or sell the improvements claimed in said reissue patent with great profit and advantage. By such wrong-
[fol. 10] ful acts of said defendant, the plaintiff, having no adequate remedy at law, is suffering irreparable damage, and is threatened with continued irreparable damage, unless this infringement by defendant is restrained by order of court.

Wherefore, the plaintiff prays:

1. For such preliminary and perpetual injunction against infringement of said reissued Letters Patent as to this court may seem just.

2. For an accounting of damages and profits due to such infringement, and that defendant may be compelled to pay over to the said plaintiff said damages, as well as the profits.

3. For costs, and

4. For such other relief as to equity may seem just.

5. The plaintiff further prays for a writ of subpœna ad respondendum, directed to the defendant, Essex Rubber Company, commanding it to appear and make answer to the bill of complaint (but not under oath, an answer under oath being hereby waived), and to perform and abide by such orders and decrees herein as to this court may seem required by the principles of equity and good conscience.

The I. T. S. Rubber Company, by J. G. Tufford, President. Frederick A. Tennant, Solicitor for Plaintiff. F. O. Richey, E. D. Fales, Counsel for Plaintiff.

Sworn to by John G. Tufford. Jurat omitted in printing.

[fol. 11] [Memorandum.—Copy of reissued patent No. 14,049 is here omitted as it appears of record among the exhibits as Plaintiff's Exhibit 12. James S. Allen, Clerk.]

Minute Entry

The cause was thence continued from term to term to the September Term, A. D. 1920, when, to wit, September 18, 1920, an answer was filed by consent.

In United States District Court

Stipulation re Bill of Complaint—Filed October 19, 1920

It is stipulated and agreed by and between the plaintiff and defendant in the above-entitled cause that the heels forming Plaintiff's Exhibits Nos. 1 and 2, Defendant's Heels, Series A and B, were sold by the defendant in the District of Massachusetts between January 11, 1916, the date of the Letters Patent in suit, and the date when the complaint in this cause was filed, and that the "acts of infringement" pleaded in paragraph (2) of the complaint and relied upon by plaintiff to give this court jurisdiction are based solely upon the sale in the District of Massachusetts by the defendant of the heel lifts which formed Plaintiff's Exhibits Nos. 1 and 2, Defendant's Heels, Series A and B, or other heels exactly like them except as to size and color.

It is further stipulated that the advertisements appearing upon page 21 of "Shoe Findings" of April 1, 1918, and upon page 11 of "Shoe Repair Service" of July, 1920, were issued and published under the authority of the defendant on or about the dates of the publication in question.

It is further stipulated that plaintiff may amend the seventh section of the bill of complaint by inserting between "Massachusetts" [fol. 12] and the comma, lines 4 and 5 thereof, the words "and elsewhere"; and that the answer denying the averments of original paragraph (7) of the complaint shall stand as denying the averments of said paragraph as amended.

F. O. Richey, Attorney for Plaintiff. Emery, Booth, Janney & Varney, Attorneys for Defendant.

In United States District Court

Minute Entries

At the same term, to wit, October 21, 1920, a motion to dismiss was filed by defendant.

Also, at the same term, to wit, on November 1st, 2d and 3d, said cause came on to be heard, on the motion to dismiss, the Honorable George W. Anderson, Circuit Judge, duly assigned to hold said District Court, sitting.

Also at the same term, to wit, November 15, 1920, an order of court was entered permitting an amendment to section 7 of the bill of complaint.

On the twenty-seventh day of said November, a stipulation as to amendment to bill was filed.

On the said twenty-seventh day of November, the aforementioned stipulation was confirmed by the court, and the amendment to the bill of complaint was allowed by the court nunc pro tunc per stipulation.

Also on the said twenty-seventh day of November, A. D. 1920, an opinion of the court was announced, allowing motion to dismiss for want of jurisdiction and dismissing bill of complaint.

On the sixth day of December, A. D. 1920, said cause came on to be heard on a motion for entry of decree, the Honorable George W. Anderson, Circuit Judge, sitting as aforesaid, and a final decree was entered.

This cause was thence continued to the December Term, A. D. 1920, when, on the fourteenth day of January, A. D. 1921, The I. T. S. Rubber Company, plaintiff, claimed an appeal to the United States Circuit Court of Appeals for the First Circuit and gave good [fol. 13] and sufficient security to prosecute its said appeal to effect and answer all costs if it failed to make its plea good, and said appeal was accordingly allowed and a citation was issued to the said Essex Rubber Company, defendant, returnable in said Circuit Court of Appeals on the twelfth day of February, A. D. 1921.

This cause was thence continued from term to term to the June Term, A. D. 1922, when, to wit, August 8, 1922, a mandate of the United States Circuit Court of Appeals for the First Circuit was received and filed, and the same being understood by the court, it was ordered that the same be entered of record, and it appearing by said mandate that the decree of the District Court, entered December 6, 1920, be reversed, said cause was remanded to the District Court for further proceedings not inconsistent with the opinion of the United States Circuit Court of Appeals.

On the seventeenth day of August, A. D. 1922, a motion to amend bill of complaint was filed.

This cause was thence continued to the September Term, A. D. 1922, when, to wit, October 25, 1922, a motion to amend answer was filed, and the following Amended Answer to the Amended Bill of Complaint was filed:—

In United States District Court

Amended Answer—Filed October 25, 1922

1. Defendant admits that the above-entitled cause is a suit in equity arising under the patent laws of the United States.

2. Defendant does not know whether plaintiff is a corporation as alleged. It admits that it, the defendant, is a New Jersey corporation and has a regular and established place of business at 58 Lincoln Street, Boston, Massachusetts, within the District of Massachusetts, but denies that any acts of infringement were committed by it there or elsewhere in the District of Massachusetts. Defendant therefore appears specially and avers that this court has no jurisdiction of the alleged cause of action set forth in the complaint, or of any cause of action which may exist against this defendant for infringement of the reissued Letters Patent specified in said complaint. Without waiving [fol. 14] its rights to contest the jurisdiction of this court on the

ground that the defendant has not committed an act of infringement within the District of Massachusetts, defendant further answers as follows:

3. Defendant admits the averments of article (3) of the complaint.

4. Defendant admits the averments of article (4) of the complaint and also that the Tufford reissued Letters Patent 14,049 are good and valid.

5. Defendant admits the averments of article (5) of the complaint.

6. Defendant admits the bringing of suits involving the Tufford reissued Letters Patent as specified in the first paragraph of article (6) of the complaint as amended, but is without knowledge of the precise decrees which were entered therein; and defendant avers, upon information and belief, that some of the alleged "decrees" which plaintiff claims to have recovered in those suits were merely interlocutory orders granted on motions for preliminary injunction.

Defendant also admits the bringing of infringement suits by plaintiff under said Tufford reissued Letters Patent in the United States District Court for the Eastern District of Michigan, Southern Division, against Walter Wendt and against Jones & Rosser, and the bringing of similar suits in the United States District Court for the Northern District of Ohio, East Division, against H. H. Hackman & Co., and against Thomas Urbansky & Sons Co. Defendant avers that the four persons or concerns just referred to are jobbers or retailers residing in the Sixth Judicial Circuit and prior to the bringing of the suits referred to, had purchased from defendant and sold and distributed in the Sixth Judicial Circuit rubber heel lifts manufactured by defendant; that upon being sued by plaintiff, each of said persons or concerns notified defendant thereof; that in the case of Jones & Rosser, H. H. Hackman & Co. and Thomas Urbansky & Sons Co., the defendant, upon receiving such notice, advised each of said concerns that it would not defend the said against it, but would pay any judgment or decree recovered therein by the plaintiff; that defend-
[fol. 15] ant took no steps whatever to defend said suits and that no answers or even appearances were filed by or on behalf of any of the nominal defendants in those cases; that plaintiff accordingly took a decree pro confesso in each suit which, under Equity Rule 16, left each such suit to be proceeded in as an ex parte matter, and that when such suit thus became an ex parte matter the defendant herein negotiated a settlement with the plaintiff to avoid the proceedings and in accounting ordered by the decree in each case, and paid the judgments thereon.

That in the case of the suit against Walter Wendt, defendant, upon notification thereof, advised the said Wendt that it would not defend said suit unless it appeared that plaintiff was charging as an infringement the new rubber heel lift which defendant had designed and placed upon the market subsequent to the decisions of the United States Circuit Court of Appeals for the Sixth Circuit in the suits against the United States Rubber Company and

Fetzer & Spies Leather Co. (referred to in the first paragraph of article (6) of the complaint) which was passed down October 7, 1919; and that, for the purpose of determining whether such new heel lifts were included in the charge of infringement in that suit, defendant sent its attorney to Detroit to examine the alleged infringing heels which plaintiff had there placed on file in the office of the clerk of the court in which said suit had been brought; and before so sending his attorney, defendant employed local consul at Detroit to obtain from plaintiff, through the said Wendt and his counsel, an extension of time to investigate said suit; that defendant, after so investigating and ascertaining that samples of its new heel lift were not on file in said suit, notified the said Wendt that it would not defend said suit, but would allow the same to go by default; that defendant also advised the said Wendt that in its opinion it would be useless to attempt to defend said suit in view of the decisions of the United States Circuit Court of Appeals for the Sixth Circuit, just referred to, but assured the said Wendt that it would pay any judgment which might be taken in the suit on account of said infringement; that neither defendant nor the said Wendt filed an answer in said suit nor even an [fol. 16] appearance, and defendant took no action whatever therein beyond requesting the said Wendt to obtain an extension of time as aforesaid; that, accordingly, plaintiff took a decree pro confesso in said suit which under Equity Rule 16, left the suit to be proceeded in as an ex parte matter; and that when said suit thus became an ex parte matter, the defendant herein negotiated a settlement with the plaintiff to avoid the proceedings in accounting ordered by the decree in said case, and paid the judgment therein.

Defendant denies each and every allegation of fact and each and every conclusion stated in article (6) of the complaint which is inconsistent with the foregoing averments and particularly denies that at any time prior to the entry of the decrees pro confesso in said suits it had control thereof, made any defense therein, or that it could have prevented the nominal defendants therein from defending had they so chosen, or that it ever did more than persuade said nominal defendants in those suits that the decisions of the United States Circuit Court of Appeals for the Sixth Circuit above referred to made it doubtful that any defense, if made, would be successful. And defendant further avers that by its every act and deed it clearly indicated its election not to defend the aforesaid suits, but to have its day in court if and when suit was brought directly against it by plaintiff.

7. Defendant denies infringement and all the averments of article (7) of the complaint.

8. Defendant is without knowledge of the facts averred in article (8) of the complaint.

9. Defendant denies all the averments of article (9) of the complaint.

10. Defendant avers that by reason of the rejection of claims in the original Tufford application and of the claims of the reissue

application as filed, as well as other claims substituted for them in the reissue application, upon reference to certain patents in the prior art which were specified in the Patent Office proceedings had upon those applications, and the acquiescence of the applicant, Tufford, in said rejections as evidenced by the cancellation of some [fol. 17] of the rejected claims and the amendments and changes incorporated in the others, Tufford, and therefore plaintiff, not only admitted that the invention of the said Tufford reissue patent did not cover or include every form of resilient heel lift which was "concavo-convex on every line of cross section", but publicly conceded, in order to overcome the Patent Office objections and to obtain the allowance of any claims at all by the reissue, and in particular the claims in suit (5 to 9 of the reissued patent), that the invention covered by said claims included only such heel lifts of "concavo-convex form on every line of cross section" as had, in addition, the further characteristics specified in each of said claims and without the specification of which the Patent Office had refused to allow said claims or any claims at all except those of the original Tufford patent; and therefore defendant avers that plaintiff has disclaimed, as being of the invention protected by said Tufford reissued patent, the form of heel lift made and sold by defendant, and is now estopped to deny a construction of the claims in suit which will cover or include the defendant's heel lift.

And defendant gives notice that it will refer at final hearing to the prior patents cited in the Patent Office proceedings aforesaid, for the purpose of showing the prior art and of construing the scope of the claims in suit.

Wherefore defendant prays the dismissal of the complaint with costs.

Essex Rubber Company, by L. E. Varney, its Attorney.
Emery, Booth, Janney & Varney, Solicitors for Defendant.

In United States District Court

Minute Entries

This cause was thereupon set down for hearing on the twentieth, tweny-first and twenty-second days of November, A. D. 1922, the Honorable George H. Bingham, Circuit Judge, sitting.

Said cause was thence continued under advisement to the present December Term, A. D. 1922, when, to wit, December 18, 1922, an opinion of the court is announced.

Thereupon, to wit, February 3, 1923, the following Final Decree, dismissing bill, is entered:

[fol. 18] IN UNITED STATES DISTRICT COURT

FINAL DECREE—February 3, 1923

BINGHAM, J.:

This cause having come on for final hearing at the October, 1922, term of this court, was heard on pleadings and proofs and argued and submitted by counsel; and now, after due deliberation had, it is

Ordered, adjudged and decreed that the bill of complaint herein be and the same hereby is dismissed for want of infringement, with costs to the defendant.

By the court:

John E. Gilman, Jr., Deputy Clerk.

G. H. B.

Approved as to form. Frederick A. Tennant, Solicitor for Plaintiff.

IN UNITED STATES DISTRICT COURT

NOTE ON APPEAL

From the foregoing final decree, the plaintiff claims an appeal to the United States Circuit Court of Appeals for the First Circuit and gives good and sufficient security that it will prosecute its appeal to effect and answer all costs if it fail to make its appeal good, and said appeal is allowed accordingly.

IN UNITED STATES DISTRICT COURT

OPINION—December 18, 1922

BINGHAM, J.:

This action is now before the court for hearing on bill, answer and proofs, and is the same case that was before the District Court in 270 Fed. 503, and on appeal before the Circuit Court of Appeals in 276 Fed. 178, and 281 Fed. 5. It is a suit in equity charging infringement of reissued Letters Patent No. 14,049, applied for June 22, 1915, and issued January 11, 1916, to The I. T. S. Rubber Company, assignee, through mesne assignments from John G. Tufford.

The invention is for an improvement in resilient heels and particularly in cushion heels of the type comprising an elastic lift adapted to be applied to the ordinary shoe heel. Claims 5, 6, 7, 8 [fol. 19] and 9 are in issue, and the contention is that certain heels (similar to Exhibit 1, Series A, and Exhibit 2, Series B), which it is agreed were sold by the defendant in the district of Massachusetts between January 11, 1916, the date of the Letters Patent, and the date when the complaint in the cause was filed, infringe these claims.

In addition to the usual allegations in a bill for infringement, the plaintiff alleged that these same claims had been put in issue in two suits brought by it in the United States District Court for the Eastern District of Michigan, Southern Division, one against Walter Wendt & Co. and the other against Jones & Rosser, in which these parties were charged with infringement by sale of Essex Tite-Edge heels exactly like (except perhaps as to size and color) Exhibit No. 1, Series A; that the Essex Rubber Company assumed the entire charge of such suits and controlled and maintained the same until entry of final decree, about November 1, 1920; that it participated in the suits and agreed with the defendants to and did pay all expenses thereof, including the expenses and fees of defendants' counsel and the costs and judgments; that after the plaintiff was informed that the Essex Company had assumed entire control of the suits, interlocutory decrees pro confesso were entered adjudging the patent valid and infringed and thereafter the matters in each case were referred to a master for accounting; that proceedings were had before the master at which counsel of the Essex Rubber Company appeared and presented the Essex Rubber Company's interest; that, thereafter, the plaintiff's claims for damages and profits having been adjusted between the plaintiff and such counsel for the Essex Rubber Company, final decrees were entered (November 1, 1920), adjudging the patent valid and infringed by the sale of such Essex Tite-Edge heels, title in the plaintiff, and ordering the issuing of permanent injunctions, and that the plaintiff recover, in lieu of profits, the amounts agreed upon. The plaintiff further charged that it was informed and believed in the exclusive control of the suits by the Essex Rubber Company, its participation therein, and its contribution thereto, before the entry of final decrees, as such actions were done openly [fol. 20] by the Essex Rubber Company; and, in view of the foregoing allegations, it alleged that the Essex Rubber Company was estopped by the adjudication in the Wendt and Jones & Rosser cases from contesting each and every issue in the case at bar and in particular the question of infringement so far as it related to the sale by the Essex Rubber Company of heels like Exhibit 1, Series A.

The plaintiff also alleged in its bill that these same claims were put in issue in two suits brought by it in the United States District Court for the Northern District of Ohio, Eastern Division, one against H. H. Hackman & Co. and the other against Thomas Urbansky & Sons Co., in which H. H. Hackman & Co. were charged with infringement by sales of Essex Tite-Edge heels exactly like Exhibit No. 1, Series A, and Thomas Urbansky & Sons Co. with infringement by sales of Essex Tite-Edge heels exactly like Exhibit No. 1, Series A, and Exhibit No. 2, Series B. It is further alleged that about November 8, 1919, the plaintiff procured a preliminary injunction in the Hackman suit as to heel Exhibit 1, Series A; that about December 23, 1917, an interlocutory pro confesso decree was entered, and about August 7, 1920, a final decree; that the Essex Rubber Company contributed to the expenses of such suit, paying all the expenses, and agreeing in advance with H. H. Hackman & Co. to pay all ex-

penses of the suit, and that it paid all the court costs; and that all these acts were done to the knowledge of the plaintiff which was acquired before the entry of final decree.

As to the Urbansky suit it alleged that the Essex Rubber Company paid all the expenses of the suit; that Urbansky took no steps therein without consulting the Essex Rubber Company, obtaining their direction with regard to said suit and agreed with Urbansky to pay all expenses of such suit directly after the suit was instituted; that about January 28, 1920, an interlocutory decree pro confesso was entered; that thereafter the matter was referred to a master for accounting; that proceedings were had before the master and the plaintiff's claim for damages and profits having been adjusted, a final decree was entered about August 7, 1920; that the plaintiff was in- [fol. 21] formed of the control by the Essex Rubber Company of the suit and its contribution thereto prior to the entry of said final decree, as such actions were done openly by said Essex Rubber Company.

In view of the foregoing the plaintiff alleged that the Essex Rubber Company was estopped, by the decree in the Hackman case, to contest the issue of infringement in this case as to heels like Exhibit No. 1, Series A, and by the decree in the Urbansky case to contest that issue as to heels like Exhibit 1, Series A, and Exhibit 2, Series B.

In support of its allegations as to the Hackman matter it appeared that Hackman & Co. were dealers in rubber heels and had purchased heels from the Essex Rubber Company like those here in question. The plaintiff introduced a certified copy of the record in that suit, which comprised a bill of complaint charging infringement of the plaintiff's patent by the sale of Essex Tite-Edge heels like Exhibit 1, Series A, a motion for a preliminary injunction, a portion of a decree granting a preliminary injunction, a decree styled a final decree, but in fact being only an interlocutory decree pro confesso, as it referred the case to a master to ascertain, state and report to the court an account of the damages and profits due to infringing the plaintiff's exclusive rights. The record does not show that Hackman & Co. appeared in the case or filed an answer or that anyone else appeared and filed an answer either in Hackman & Co.'s behalf or in behalf of themselves; and as the record fails to show that a final decree was entered, it necessarily follows that neither Hackman & Co. nor the defendant here is estopped by the interlocutory decree pro confesso. McGourkey v. Toledo & Ohio Ry., 146 U. S. 536, 545; Smith v. Vulcan Iron Works, 165 U. S. 518, 524; Humiston v. Stainthorp, 2 Wall. 106; Australian Knitting Co. v. Gormley, 138 Fed. 92, 100, and cases there cited. This renders it unnecessary to consider whether the Essex Rubber Company could, in any view, be regarded as a party to the cause and bound by a decree therein if a final decree had been entered. But I find that the Essex Rubber Company did not defend or control the suit; that on being notified by Hackman & Co. of the [fol. 22] bringing of the suit it replied that it would not defend it but would reimburse them, in case they concluded not to defend, for damages that might be recovered against them; and that Hackman & Co. replied that they had no intention of defending the suit.

As to the Urbansky matter it appeared that Thomas Urbansky & Sons Co. were also dealers in heels purchased from the Essex Rubber Company, and the plaintiff introduced a certified copy of the record in that case, comprising a bill of complaint charging infringement of plaintiff's patent by the sale of Essex Tite-Edge heels, a motion for preliminary injunction, an interlocutory decree pro confesso directing a reference to a master for an accounting, an order fixing the compensation of the master and stenographer and directing that the same be taxed as costs, and an order stating that, as a settlement had been made of all claims for profits, the reference to the master was withdrawn, the interlocutory decree made final, and the plaintiff was to pay all costs. There is nothing in the record that shows anyone filed an appearance or answer in that case for the defendant or took any action in its behalf. The inference to be drawn from the record is that, after the case was sent to the master, before whom it was necessary for the complainant (the present plaintiff) to adduce evidence showing what its damages were, the plaintiff procured an agreement with Thomas Urbansky & Sons Co. as to the amount due it, obtained satisfaction thereof, and then had an order entered making the interlocutory decree pro confesso final without having any sum adjudged due it as damages, but ordering that the costs incurred be paid by itself.

The deposition of Thomas J. Urbansky, vice-president and secretary of the Urbansky Company, was introduced in evidence. In it he testified that after the suit was brought against his company he wrote to the Essex Rubber Company that they had been sued and that the Essex Company replied advising the Urbansky Company to let the matter go by default and it would reimburse them for the expense they were put to; that if this request had been contrary to their own interests they would not have acquiesced in it; that neither the Essex [fol. 23] Company nor anyone representing them took any part in the conduct of the litigation; that all the Essex Company did was to reimburse them for what they paid out; that he personally arranged the settlement with Mr. Fales, attorney for the plaintiff; that Fales undertook to make him account for damages and profits from the sale of other types of heels in addition to the Tite-Edge; that the Essex Company reimbursed him but that he did not rely upon its promise to do so, as the expense was small and it would have been the same anyway because that company had not undertaken to protect his company against any losses when the goods were purchased. The correspondence between the Urbansky Company and the Essex Company shows that the latter advised the former that it would stand behind its jobbers and pay any judgment which might be obtained against them by reason of any infringement caused by the handling or sale of its goods; that what The I. T. S. Rubber Company was suing its jobbers for was to compel it to submit its case to the courts out in Cleveland, but that it did not propose to do that as it had its disadvantages. The deposition of E. D. Fales, a member of the firm of Richey, Slough & Fales, counsel for the plaintiff in this suit, was introduced in evidence and related to the matter now under con-

sideration. Mr. Fales had charge of the Hackman and Urbansky suits as counsel for the plaintiff, and, after taking the depositions of Mr. Urbansky and others in this suit, gave his own deposition. Fales testified that Urbansky told him that the Essex Company had agreed to reimburse his company and that his company was conducting the case subject to the direction and suggestions of the Essex Company, and was doing nothing otherwise. But the correspondence introduced through these witnesses shows that Urbansky made the settlement with the plaintiff without any direction or suggestion from the Essex Company and that all the Essex Company did was to reimburse him after it was notified of the settlement.

Taking into consideration all the evidence in the case, I find, as a fact, that the Urbansky Company of its own accord permitted the suit to go by default and adjusted and settled the matter of accounting after the interlocutory decree pro confesso was entered; [fol. 24] that the final judgment made no award of damages, as they had been adjusted and settled by Urbansky out of court; and that the Essex Company did not control the disposition of the case either openly or otherwise. And I rule that the Essex Company is not estopped by the decree in the Urbansky case to contest the question whether heels like Exhibit 1, Series A, and Exhibit 2, Series B, infringe the claims here in issue.

In the suit against Wendt & Co., F. O. Richey and E. D. Fales were the counsel, and Campbell, Bulkley & Ledyard were the solicitors for the plaintiff. The record in that case consists of a bill in equity charging the defendant with infringement of the claims here in issue by the sale of Essex Tite-Edge heels like Exhibit 1, Series A; the affidavit of John G. Tufford; the affidavit of Frank M. Slough; an order entered May 3, 1920, to take the bill pro confesso, no appearance having been entered on the part of the defendant or answer or other pleading filed, although they should have been on or about the 26th of April, 1920; a copy of an order filed April 1, 1920, directing Wendt & Co. to appear on the 19th of April, 1920, and show cause why an injunction should not issue as prayed for in the bill; an interlocutory decree pro confesso entered June 17, 1920, appointing a commissioner to ascertain, take and state an account, and adjudging that the plaintiff on such accounting should have the right to cause the examination of the defendant, his associates, clerks, servants, workmen and other employees, and the production of books, vouchers and documents of such defendant, and that such defendant attend before the master, and awarding a perpetual injunction and costs; a copy of the perpetual injunction filed June 24, 1920; a stipulation filed November 1, 1920, signed September 13, 1920, by F. O. Richey and E. D. Fales as counsel for the plaintiff, and Angel & Turner for the defendant, in which it was stipulated that the defendant would pay at once to the plaintiff one thousand dollars in cash, that the plaintiff would accept the one thousand dollars in lieu of profits and damages and that no appeal should be taken from the final decree of the court in the case; a copy of a final decree entered November 1, 1920, reciting that

[fol. 25] the defendant, having made settlement of all claims and profits for the sum of one thousand dollars, the reference to the master was withdrawn, and the plaintiff recover of the defendant the sum of one thousand dollars and the order for an accounting be withdrawn. It further recited the matters set out in the interlocutory decree pro confesso as to validity and infringement.

The record in the Jones & Rosser suit differs in no material respect from the facts shown in the record in the Wendt suit. Both suits were begun at the same time; the patent relied on by the plaintiff in each was the same; the heels charged to be infringements were the same, and the orders taking the bills pro confesso, the interlocutory decrees pro confesso were of the same character and the respective dates at which they were entered up were the same. As to both matters in appears that Wendt, on April 7, 1920, and Jones & Rosser on April 12, 1920, notified the Essex Rubber Company of the commencement of the suits by The I. T. S. Rubber Company against them, and that the orders to show cause why a temporary injunction should not issue were returnable April 19, 1920, that the Essex Company, being unaware of what heels the plaintiff was relying upon in these suits as infringements, arranged, through Angell & Turner, attorneys in Detroit, to procure, if possible, a postponement of the hearings on temporary injunction so that it might have an opportunity to examine the exhibits and determine whether it desired to appear and defend; for, if the heels relied upon as infringements included the new type of heel which it was manufacturing, it desired to appear and defend, otherwise not; that Angell & Turner conferred with plaintiff's local counsel, who agreed to a postponement as the plaintiff was desirous of having the Essex Rubber Company appear and defend the suits in that district; that the infringing heels relied upon the two suits were produced for the examination of New York counsel representing the Essex Company, who, after examining the heels and ascertaining that they did not include the Essex Company's new type of heel, on April 28, 1920, wrote plaintiff's counsel that the Essex Company would not appear and, on April 29, 1920, they wrote Angell & Turner, who [fol. 26] also informed plaintiff's counsel that the Essex Company did not wish to appear; that, no appearances having been entered and no answers filed in either case, orders taking the bill pro confesso were entered May 3, 1920, and that on June 17, 1920, interlocutory decrees pro confesso were entered in both suits; that in July, 1920, the defendants having been ordered to account and the Essex Company being informed of this and having previously written Wendt and Jones & Rosser that they would reimburse them for any losses they sustained by reason of suits, suggested to Wendt and Angell & Turner that they procure an adjustment of the damages and profits in the respective suits; that Wendt and a representative of the firm of Angell & Turner, having ascertained about what the plaintiff would be entitled to recover as damages and profits in the respective suits, proposed a settlement of a thousand dollars and costs in the Wendt suit and two hundred dollars and costs in the Jones & Rosser suit, which were accepted by the plaintiff and final

judgments pro confesso, based upon these agreements and the interlocutory decrees, were entered; that Wendt paid the judgments in the respective suits and was reimbursed by the Essex Company.

Down to the time of the entry of the interlocutory decrees pro confesso and the issuing of the notices to the respective defendants to appear and account, I find that the Essex Company did not exercise control over the management and conduct of the suits; that the respective defendants allowed them to go by default of their own free will, and that the plaintiff had no reason to understand or believe that it was managing or conducting the cases.

Rule 16 in equity provides:

"It shall be the duty of the defendant, unless the time shall be enlarged, for cause shown, by a judge of the court, to file his answer or other defense to the bill in the clerk's office within the time named in the subpoena as required by rule 12. In default thereof the plaintiff may, at his election, take an order as of course that the bill be taken pro confesso, and thereupon the cause shall be proceeded in ex parte."

[fol. 27] When the orders and interlocutory decrees pro confesso were entered the cases thereupon, as required by the above rule, proceeded ex parte. Thereafter neither Wendt & Co. nor Jones & Rosser, nor anyone else, had any right to appear and never did appear as a party in defense of either suit. Frow v. De La Vega, 15 Wall. 522, 554; Thomson v. Worcester, 114 U. S. 104, 119. And when Wendt & Co. and Jones & Rosser went before the master in response to his summons to account, they did so as witnesses in the plaintiff's behalf and in no other way. And the fact that the Essex Company co-operated with Wendt and Jones & Rosser through Angell & Turner to bring about adjustments of the damages and profits, which adjustments were used by the plaintiff, in place of the master's findings, as a basis upon which, in part at least, to obtain the final decrees, does not seem to me to be such an exercise of control of the cases as would make the Essex Company a party defendant, even though the plaintiff understood that Angell & Turner represented the Essex Company as well as Wendt and Jones & Rosser in adjusting the damages and profits.

Before the damages were adjusted the issue of infringement upon which the plaintiff here relies had been decided by the court and embodied in the pro confesso decrees (Thomson v. Worcester, 114 U. S. 104, 113), and, although these decrees did not become binding as an estoppel until the entry of the final decrees and the expiration of the term at which they were entered (L. E. Waterman Co. v. Modern Pen Co., 193 Fed. 242, 243), no one sought or procured leave to appear as a party or to in any way interrupt the ex parte course which the cases were to take under the rule. After the entry of the pro confesso decrees and as long as they stood unrevoked, Wendt & Co. and Jones & Rosser were absolutely barred and precluded from alleging anything in opposition to or in derogation of them, and, as the decrees were never revoked, they were bound by them as to the question of infringement

from the date of their entry. Thomson v. Worcester, 114 U. S. 104, 114.

Under the circumstances I find that the Essex Company did not control either the Wendt or Jones & Rosser suits, and rule [fol. 28] that they are not estopped from contesting the question of infringement raised in this case.

The claims here in issue read as follows:

"5. A heel lift of substantially non-metallic resilient material having its body portion of concavo-convex form on every line of cross section, the concave upper face lying entirely below a plane passing through the rear upper edge and the breast corners of the lift.

"6. A heel lift of substantially resilient material having its body portion of concavo-convex form on every line of cross section, the concave upper face lying entirely below a plane passing through the rear upper edge and the breast corners of the lift, said lift being provided with nail receiving openings located near the center thereof.

"7. A heel lift of substantially resilient material comprising a body portion, the attaching face of which is concave and the tread face of which is convex on every line of cross section and normally held in such form by its own inherent resiliency, the concave attaching face lying entirely below a plane passing through the rear upper edge and the breast corners of the lift, whereby to cause the entire margin of said lift to exert a uniform pressure on the heel of a shoe when said lift is positioned on the heel and the convex tread face thereof depressed to flatten said lift.

"8. A heel lift of resilient material comprising a body portion of uniform thickness throughout its entire area and of concavo-convex form on every line of cross section, the concave upper face of the lift lying entirely below a plane passing through the upper edge and the breast corners of said lift.

"9. A heel lift of resilient material comprising a body portion, the attaching face of which is concave and the tread face of which is convex, the concave face of the lift being unbroken and lying entirely below a plane passing through the rear upper edge and the breast corners of the lift, whereby when the convex tread face is [fol. 29] depressed to flatten said lift a suction will be created between the lift and the heel to hold the attaching face of the lift throughout its entire extent in contact with the exposed face of the heel."

It will be seen that each of these claims, with the exception of claim 8, contains a clause wherein the concave upper face is described as "lying entirely below a plane passing through the rear upper edge and the breast corners of the "lift"; and that in claim 8 the language of the claim is the same with the exception that the word "rear" before "upper edge" is omitted. It appears,

however, from an examination of the file-wrapper of the reissued patent that the omission of the word "rear" in the eighth claim was a clerical error due to oversight; that counsel for the applicant and the examiner in charge of the application understood that all these claims as drawn at the time they were allowed contained the word "rear" preceding the words "upper edge". This appears from what will be found in the file-wrapper of the reissued patent beginning on page 50 and extending to page 56. On page 54 of the file-wrapper the examiner says: "In each of the claims 5, 6, 7, 8 and 9 applicant specifies 'that the concave upper face lies entirely below a plane tangent to the rear upper edge and the breast corners of the lift'", and it there appears that these claims were rejected not because of the wording of the claims, but because of one of the drawings (Fig. 2) filed in the case. This drawing (Fig. 2) did not at that time conform to the shape of the plaintiff's heel and, because of that, the claims were disallowed as they would not read upon Fig. 2. The only change thereafter made in the claims as they then stood was the insertion of the words "passing through" for "tangent to" in the clause here in question, and to define the meaning of the caluse as amended, Figure 2 having been changed to conform to the plaintiff's heel, the following provision was inserted in the specification:

"By references to Figs. 2 and 4 of the drawings, it will be seen that the concave upper face of the lift lies entirely below a plane passing through the rear upper edge and breast corners of the [fol. 30] lift whereby to cause the entire margin of said lift to exert a uniform pressure on the heel of a shoe when the lift is positioned on the heel and the convex face thereof depressed to flatten said lift. In other words owing to the curvature of the concave attaching face of the lift, the rear upper edge and breast corners of said concave attaching face are disposed in a plane above the upper side edges and the breast edges of the lift."

This amendment in connection with new Figure 2 clearly shows that the plaintiff's heel was to have a rear upper edge and breast corners located "above the upper side edges and the breast edges of the lift", and that the words "passing through" meant a plane passing through the rear upper edge and breast corners and above the side and breast edges.

The conclusion that the word "rear" was omitted from the clause under consideration in claim 8 through inadvertence and was a clerical error is further shown by the language used in the claim itself, for a plane passing through the upper edge, if upper edge meant the entire upper edge as in defendant's heel, would pass through the breast corners as well, and there would have been no occasion for stating in that clause that it passed through the breast corners. Then again, down to the time it was pointed out in the decision of the Court of Appeals of June 7, 1922, the plaintiff had always recognized that this clause in claim 8 read the same as it does in the other claims; that was its position before the

District Court before the case was taken to the Court of Appeals; and has apparently been its position before other courts where these claims have been considered.

The defendant makes and sells two sets of heels which the plaintiff claims infringe its patent.—Exhibit No. 1, Series A, and Exhibit No. 2, Series B. Exhibit No. 1, Series A, is a concavo-convex heel on every line of cross section, the concave face of which, however, is located below a plane which passes through the entire upper edge of the lift, except the breast edge. The breast edge is raised considerably above the lowest point back of it in its concave face, but [fol. 31] not enough to be in the same plane with the side and rear upper edges of the heel. Exhibit No. 2, Series B, differs from Exhibit No. 1, Series A, only in the fact that the breast edge at its lowest point is about one-fiftieth of an inch higher than the lowest point back of it in the concave face of the lift.

In the decision handed down by the Court of Appeals in this case on June 7, 1922, it was held that the heel described by the language of claims 5, 6, 7 and 9 was "the three-point contact form having its side and breast edges, as well as its concave attaching face, located below a plane passing through the rear upper edge and breast corners of the concave face," and that this was due to the fact that the claims contained the clause defining the concave upper face as "lying below a plane passing through the rear upper edge and the breast corners of the lift." And as I find that claim 8 embodies the same clause, the word "rear" having been omitted through oversight, that claim, as well as claims 5, 6, 7 and 9, described a heel of "the three-point contact form having its side and breast edges, as well as its concave attaching face, located below a plane passing through the rear upper edge and breast corners of the concave face." So far as this clause of the claims is concerned, they stand alike upon the question of infringement.

It is the contention of the defendant that these claims are not entitled to a broad construction; that the patentee, by acquiescing in the denial of claims asked for in the Patent Office and by the acceptance of claims embodying the clause "the concave upper face lying entirely below a plane passing through the rear upper edge and the breast corners of the lift," limited himself in such a way that he is not entitled to a broad range of equivalents and that, when the claims are so limited, the defendant's heels do not infringe.

In the original application, by amendments filed December 15, 1913, and April 21, 1914, the applicant asked for claims reading as follows:

"A cushion heel lift having a concave attaching face and a convex tread face, the edges of the attaching face all occupying the same plane.

[fol. 32] "A cushion heel lift having a concave attaching face and a convex tread face and having its edges radial to the curvature of said faces, the edges of the attaching face all occupying the same plane."

These claims, July 7, 1914, were rejected by the examiner, the rejection was acquiesced in by the applicant, and the original patent was issued with claims 1, 2, 3 and 4 only. The claims here in controversy were granted on the application of June 22, 1915, of the reissued patent. In that application six new claims were asked for, all of which, on July 8, 1915, were rejected. These claims read as follows:

"5. A cushion heel lift having a concavo-convex form on every line of cross section.

"6. A cushion heel lift, the attaching face of which is concave and the tread face of which is convex on every line of cross section.

"7. A cushion heel lift, the attaching face of which is concave and the tread face of which is convex on every line of cross section, there being nail receiving openings penetrating the lift near the center thereof.

"8. A cushion heel lift the attaching face of which is normally concave and the tread face of which is normally convex on every line of cross section, thereby to cause the entire margin of the lift to snugly engage the heel of a shoe when said lift is positioned on a heel and pressure applied to the convex face thereof to flatten said lift.

"9. A cushion heel lift having a concavo-convex form on every line of cross section and provided with openings piercing the lift near the crest of the convex face thereof.

"10. A heel lift formed of yieldable material and provided with a normally convex tread face and a normally concave attaching face defining a suction area whereby, when the lift is positioned on the flat surface of a heel and pressure is applied to the convex face of [fol. 33] the lift, the margin of said lift will be retained in engagement with the margin of the heel by the action of the suction area."

These claims having been rejected by the examiner, the applicant, on August 20, 1916, asked that they be reconsidered and filed an additional claim No. 11. August 30, 1915, the applicant acquiesced in the rejection of claims 5 and 6, suggested slight amendments to the others and added two claims, requesting that claim 7 be numbered 5 and so on, down to 11. October 2, 1915, the examiner rejected these claims and on October 13, 1915, the applicant acquiesced in the rejection, and requested the substitution of four new claims, 5, 6, 7 and 8. These last claims read as follows:

"5. A heel lift of resilient material comprising a body portion of concavo-convex form on every line of cross section and normally held in such form by its own inherent resiliency.

"6. A heel lift of resilient material comprising a body portion, the attaching face of which is concave and the tread face of which is convex on every line of cross section and normally held in such form

by its inherent resiliency only, said lift being provided with nail receiving openings located near the center thereof.

"7. A heel lift of resilient material comprising a body portion, the attaching face of which is concave and the tread face of which is convex on every line of cross section and normally held in such form by its inherent resiliency only, whereby to cause the entire margin of the lift to exert a uniform pressure on the heel of a shoe when said lift is positioned on the heel and the convex tread face thereof depressed to flatten said lift.

"8. A heel lift of resilient material comprising a body portion, the attaching face of which is concave and the tread face of which is convex and normally held in such form by its inherent resiliency only, the concave face of the lift being free from projections, whereby [fol. 34] when the convex tread face is depressed to flatten said lift, a suction will be created between the lift and the heel to hold the attaching face of the lift through its entire extent in contact with the exposed face of the heel."

In the remarks of applicant's counsel in presenting these new claims it was stated that "the foregoing amendment has been made after a personal interview with the Principal Examiner, during which a specimen heel lift, constructed in accordance with applicant's invention and also exhibit rubber heels now on the market, were presented for inspection."

October 22, 1915, the examiner, replying to the amendment filed October 13, 1915, rejected the claims and stated: "Applicant may regard this rejection as final if he so desires," which meant that he might take an appeal if he wished.

October 27, 1915, the applicant acquiesced in the rejection of these four claims and offered an amendment to his specification reading as follows:

"By reference to Figs. 2 and 4 of the drawings, it will be seen that the concave upper face of the lift lies entirely below a plane tangent to the rear upper edge and the breast corners of the lift, whereby to cause the entire margin of said lift to exert a uniform pressure on the heel of a shoe when the lift is positioned on the heel and the convex face thereof depressed to flatten said lift."

He also offered five new claims,—containing the clause "the concave face lying entirely below a plane, etc."—which read the same as claims 5, 6, 7, 8 and 9 of the reissued patent, except that where the words "passing through" are used in the claims in suit the words "tangent to" appeared. From the remarks of counsel in presenting these amendments it appears that he relied largely, to differentiate these claims from the prior art, on the fact that the concave upper face of the lift lay entirely below a plane tangent to the rear upper edge and breast corners of the lift.

On November 16, 1915, the examiner, in his reply to the amend- [fol. 35] ments of October 27, 1915, adverted to the applicant's amendment of claims 4 and 5 of the original application by add-

ing thereto the phrase "the edges of the attaching face all occupying the same plane," and the remarks of the applicant of October 13, 1915, in the present application, where he said: "Even were the breast of the heel closed, as in applicant's device, etc."; and that he would judge that "applicant's heel lift was meant to be so constructed as to have all of its upper edges occupy the same plane, etc." Then he calls attention to applicant's amendment to his specification of October 27, 1915, where it says: "By reference to Figs. 2 and 4 of the drawings, it will be seen that the concave upper face of the lift lies entirely below a plane tangent to the rear upper edge and the breast corners of the lift," and concludes that "Fig. 2 does not show such construction since a point midway between the breast corners of the lift is shown to be in contact with the upper heel portion"; that, according to this figure, a plane tangent to the rear edge and the breast corners would also pass through the entire front edge of the lift. The examiner also stated that Fig. 2 does not correspond to the sample lift shown him, "since all the points of its breast except the two corner points lie below a straight line passing through these points," and he rejected claims 5 to 9, inclusive, because they did not read on the drawing. This also shows that the examiner regarded the words "tangent to" and "passing through" as meaning the same thing.

On November 24, 1915, the applicant presented a new sketch of Fig. 2, showing the breast and side edges of the heel slightly curved so that it presented a correct sectional view of Fig. 4, and asked to amend the clause added to the specification by the amendment of October 27, 1915, so that it should read as follows:

"By references to Figures 2 and 4 of the drawings, it will be seen that the concave upper face of the lift lies entirely below a plane passing through the rear upper edge and breast corners of the lift whereby to cause the entire margin of said lift to exert a uniform pressure on the heel of a shoe when the lift is positioned on the heel [fol. 36] and the convex face thereof depressed to flatten said lift. In other words, owing to the curvature of the concave attaching face of the lift, the rear upper edge and breast corners of said concave attaching face are disposed in a plane above the upper side edges and the breast edges of the lift."

And to meet the change in the specification from "tangent to" to "passing through", he requested that the words "tangent to" in his five new claims of October 27, 1915, be changed to "passing through", and asked that an additional claim, which is claim 10 of the patent, be allowed.

It is apparent from the matters referred to as having taken place during the course of proceedings in the Patent Office, that the patentee sought broad claims, but was denied them, and acquiesced in the denial.

In the original patent he sought claims for a concavo-convex heel having a straight upper edge, but was denied them.

In the reissued patent he first sought claims for "a heel lift having a concavo-convex form on every line of cross section" — very broad claims, and in nowise limited as to character or location of the edges of the attaching face of the heel. He was denied these. He then asked for claims somewhat more limited, calling for "a lift of resilient material comprising a body portion of concavo-convex form on every line of cross-section and normally held in such form by its own inherent resiliency", but so far as the character and location of the edges of the attaching face were concerned equally as broad as the first asked for. These claims were denied and he acquiesced. Finally, on October 13, 1915, he submitted five claims substantially like those previously submitted but all containing the clause "the concave upper face lying entirely below a plane passing through the rear upper edge and the breast corners of the lift" or its equivalent, which defined the character and location of the edges of the attaching face.

Such being the case, it necessarily follows that claims which were allowed with the qualifying clause cannot be construed broadly [fol. 37] and to cover what would be embraced within the claims as they stood June 22, 1915, or October 13, 1915; for to do so would render the qualifying clause meaningless and give to the present claims an interpretation such as the plaintiff would only have been entitled to had the earlier claims of June 22 and October 13, 1915, not been rejected. The patentee having narrowed his claims by the insertion of the restricting clause, in order to obtain any claim under the reissued patent, cannot, by construction or by resorting to the doctrine of equivalents, give the claims the larger scope which they might have had without the restricting clause. Webber Electric Co. v. Freeman Electric Co., 253 U. S. 668, 677. Having acquiesced in the rejection of the claims as offered on June 22 and October 13, 1915, he is now estopped from claiming the benefit of those claims or such a construction of his present claims as would be equivalent thereto. Morgan Envelope Co. v. Albany Paper Co., 152 U. S. 425, 428, 429; Thomas v. Rocker Spring Co., 77 Fed. 420.

It has been argued before me that claims 5, 6, 7, 8 and 9 of the patent cannot be differentiated from claim 10, if the restricting clause of these claims is given the same meaning as the restricting clause in claim 10, and which the specification says means the same. I do not think this is so. Claim 5 is differentiated from all other claims in that it requires the heel lift to be of "substantially non-metallic resilient material". Claim 6 is differentiated by the heel being provided with "nail receiving openings located near the center thereof"; claim 7 by the fact that the heel is "normally held in such form by its own inherent resiliency"; claim 8 by the body portion of the heel being of "uniform thickness throughout its entire area"; claim 9 by "the concave face of the lift being unbroken." Claim 10 is differentiated from claim 5 by the clause "substantially resilient material" which is

not necessarily non-metallic as in claim 5; from claim 6 by not having nail receiving openings; from claim 7 by not being held in shape by its own inherent resiliency; from claim 8 by not being of uniform thickness throughout its entire area; and from claim 9 by not having its face limited to an unbroken concave face. [fol. 38] Claims 5, 6 and 8 in express terms provide that the body portion of the heel shall be "of concavo-convex form on every line of cross section; claims 7 and 10 that the attaching face of the heel shall be "concave and the tread face convex on every line of cross section". Claim 7 also contains a whereby clause which states in substance that the elements of the claim are such as to cause the entire margin of the lift to exert a uniform pressure on the shoe heel when said lift is positioned on the heel, and the evidence shows that this uniform pressure can be obtained only in case the breast edge is raised, as well as the side and rear edges. This being so, it follows that the elements described in claim 7 call for a heel the concave face of which is concave on every line of cross section. And what is true of claim 7 is true of claim 10. Claim 9 does not use the term "on every line of cross section" either as to the concave face or the convex tread, but contains a whereby clause in which it states that "when the convex tread face is depressed to flatten said lift a suction will be created between the lift and the heel to hold the attaching face of the lift throughout its entire extent in contact with the exposed face of the heel". While the language of this whereby clause is not the same as the whereby clause in claim 7, it means the same, and the evidence shows that the result here claimed can be produced only in case the breast is raised as well as the side and rear edges of the heel. Furthermore, if claims 7, 9 and 10 are not capable of this construction, they would not seem to be invalid, as calling for a heel not disclosed in the specification.

As said by the Court of Appeals in this case "the fundamental conception of plaintiff's patent as to form is one 'molded or cut so as to be of a concavo-convex form on any line of cross section'; and its principal object or function when so formed is (according to the language of the specification) 'that when the lift is subjected to pressure any tendency for the edge portions of the lift to crowd beyond the sides of the shoe heel will be counteracted and there will be equally as great a tendency for the material of the lift to crowd or compress toward the center thereof'. This means that the retroactive force inherent in the rubber will counteract [fol. 39] any tendency of the edge portions of the lift to crowd beyond the sides of the shoe heel when the lift of the patent is subjected to pressure, and thus keep the side and breast edges of the lift in alignment with the side and breast edges of the shoe heel and in close contact therewith."

It is conceded by the defendant that if plaintiff's claims are not restricted by the clause here under consideration and are entitled to a construction warranting a wide range of equivalents, it

infringes; but I rule that the claims are restricted by the provision which they all contain, that plaintiff is not entitled to a broad construction of its claims, and find that heels like Exhibit 1, Series A, and Exhibit 2, Series B, do not infringe the plaintiff's claims.

A decree will be prepared dismissing the plaintiff's bill.

PLAINTIFF'S PETITION FOR APPEAL—Filed February 19, 1923.

The above-named plaintiff, The I. T. S. Rubber Company, conceiving itself to be aggrieved by the decree made and entered by this court on the third day of February, 1923, in the above-entitled cause, now comes by its solicitor, F. A. Tennant, and hereby appeals from the said decree to the United States Circuit Court of Appeals of the First Circuit, for the reasons specified in the assignment of errors which is filed herewith, and prays that the appeal may be allowed and that a citation be issued, as provided by law, directed to the above-named defendant, and that a transcript of the record, testimony, proceedings, papers, exhibits, documentary or otherwise, may be sent to the United States Circuit Court of Appeals for the First Circuit, and that an order may be made fixing the amount of the bond which shall be furnished on said appeal.

The I. T. S. Rubber Company, by Frederick A. Tennant, its Solicitor. F. O. Richey, of Counsel for Plaintiff.

Allowed February 23, 1923. George H. Bingham, U. S. Circuit Judge.

[fol. 40] ASSIGNMENT OF ERRORS—Filed February 19, 1923

And now on the nineteenth day of February, 1923, comes the appellant, The I. T. S. Rubber Company, by its counsel, and having prayed an appeal to the United States Circuit Court of Appeals for the First Circuit from the decree of the District Court entered in this case on the third day of February, 1923, presents, with the accompanying petition for appeal from said decree, the following assignment of errors which intervened to the prejudice of appellant, to wit:

1. The court erred in not finding the Tufford reissue Letters Patent No. 14,049, reissued January 11, 1916, infringed by defendant as to the claims in suit, namely, claims 5, 6, 7, 8 and 9, or as to any of said claims, and particularly by the sale by defendant of defendant's heel lifts, Plaintiff's Exhibit 1, Series A, and Exhibit 2, Series B.

2. The court erred in finding that the Tufford reissue Letters Patent No. 14,049, reissued January 11, 1916, is not infringed by defendant and especially by the sale by defendant of defendant's heel lifts, Plaintiff's Exhibit 1, Series A, and Exhibit 2, Series B.

3. The court erred in not holding that defendant was estopped to contest any of the issues in this case by the adjudication in the United States District Court, Eastern Division of Michigan, Southern Division, in the case of The I. T. S. Rubber Company v. Walter Wendt, doing business as Walter Wendt & Co., in Equity No. 325.

4. The court erred in not holding that defendant was estopped to contest any of the issues in this case by the adjudication in the United States District Court, Eastern Division of Michigan, Southern Division, in the case of The I. T. S. Rubber Company v. Jones & Rosser, a co-partnership consisting of Richard S. Jones and Edward S. Rosser, in Equity No. 326.

5. The court erred in not holding that defendant was estopped to contest any of the issues in this case by the adjudication in the United States District Court, Northern District of Ohio, Eastern Division, in the case of The I. T. S. Rubber Company v. H. H. Hackeman & Company, in Equity No. 506.

[fol. 41] 6. The court erred in not holding that defendant was estopped to contest any of the issues in this case by the adjudication in the United States District Court, Northern District of Ohio, Eastern Division, in the case of The I. T. S. Rubber Company v. The Thomas Urbansky & Sons Company, in Equity No. 514.

7. The court erred in holding that the adjudication in any or all of the above identified Wendt, Jones & Rosser, Hackman and Urbansky cases did not estop defendant to contest the issue of infringement in this case.

8. The court erred in dismissing the bill.

9. The court erred in not awarding the costs in this case to plaintiff.

10. The court erred in awarding the costs to defendant.

Therefore the appellant prays that the final decree of the District Court be reversed and that the said court may be directed to enter a decree in accordance with the prayer of the bill.

The I. T. S. Rubber Company, by Frederick A. Tennant, Its Counsel.

Bond on Appeal for $500—Approved and Filed Feb. 23, 1923; omitted in printing

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[fol. 42] In United States District Court

Order Allowing Appeal—February 23, 1923

On petition of the solicitor for plaintiff herein, it is hereby ordered that the appeal on the part of the plaintiff herein to the United States Circuit Court of Appeals for the First Circuit from the decree

of this court entered and filed herein on the third day of February, 1923, be and the same is hereby allowed; that so much of the transcript of the record herein that is necessary and essential to a proper presentation thereof be forthwith transmitted to the said United States Circuit Court of Appeals, and it is further ordered [fol. 43] that the bond on appeal be fixed at five hundred dollars ($500), the same to act as a bond for the costs on appeal.

George H. Bingham, U. S. Circuit Judge.

In United States District Court

Stipulation re Printing of Record—Filed March 21, 1923

In view of the inability of counsel to agree upon a narrative statement of testimony and of the comparative brevity of the testimony, it is stipulated and agreed by and between counsel for the respective parties, with the consent of the court, that in making up the record on appeal the testimony and depositions offered and received in the United States District Court for the District of Massachusetts, on the final hearing in the above-entitled cause, may be printed in question and answer form in the exact words of the witnesses instead of being reduced to narrative form as required by Equity Rule 75.

Frederick A. Tennant, Solicitor for Plaintiff. Frederick L. Emery, Solicitor for Defendant.

Boston, Massachusetts, March 15, 1923.

Approved: G. H. B.

In United States District Court

Stipulation re Transcript of Record—Filed March 30, 1923

It is stipulated and agreed by and between counsel for the respective parties that the praecipe filed herewith entitled "Praecipe for Transcript of Record Substituted for Plaintiff's Praecipe by Agreement of Counsel" may be substituted for the plaintiff's praecipe upon appeal and that the same may be printed as a part of the transcript of record on appeal.

It is further stipulated and agreed that pages 1 to 13 of the typewritten record of the evidence on final hearing may be omitted and that a list of the exhibits offered in evidence upon such pages may [fol. 44] be substituted together with a statement that following exhibits were duly offered and received in evidence.

Frederick A. Tennant, Counsel for plaintiff. L. E. Varney, Counsel for Defendant.

Approved: George H. Bingham, U. S. Circuit Judge.

In United States District Court

Precipe for Transcript of Record—Filed March 30, 1923

To the Clerk of the Court:

You are hereby respectfully requested to make a transcript of the record in the above-entitled suit to be filed in the United States Circuit Court of Appeals for the First Circuit pursuant to the appeal heretofore allowed and to include in said precipe the following, and no others:

1. Amended bill of complaint.
2. Amended answer.
3. Stipulation filed October 18, 1920, re sale of alleged infringing heels.
4. Testimony and depositions in question and answer form in the exact words of the witnesses.
5. Court's opinion.
6. Final decree entered February 3, 1923.
7. Petition of appeal.
8. Order allowing appeal filed February 23, 1923.
9. Assignment of errors filed February 19, 1923.
10. Praecipe for transcript of record.
11. Citation.
12. Clerk's certificate.

You are further requested to forward to the Circuit Court of Appeals copies or reproductions of plaintiff's paper exhibits,—

No. 13, Shoe Findings of April 1, 1918.
No. 14, Shoe Repair Service.
[fol. 45] No. 1a, Letter, Jones & Rosser to Wendt & Co.
No. 2a, Letter, Essex Rubber Company to Jones & Rosser.
No. 3, Letter, Essex Rubber Company to Wendt & Co.
No. 4, Telegram, Jones & Rosser to Essex Rubber Company.
No. 5, Letter, Jones & Rosser to Essex Rubber Company.
No. 8, File of correspondence produced by Wendt.
No. 9, Another file of correspondence.
No. 10, File of correspondence produced by Urbansky.
No. 11, File of correspondence produced by Hackman.
No. 12, Copy of patent in suit.
No. 19, Certified copy of pleadings and decrees in Jones & Rosser case.
No. 20, Same in Wendt case.
No. 21, Same in Urbansky case.
No. 22, Same in Hackman case.
No. 55, Photographs of Heels.
No. 25, Three letters between Essex Rubber Company and Mr. Wendt.
No. 91, Sanders Patent.
No. 85, Troiano Patent.

And defendant's following paper exhibits:

C, File-wrapper of reissue patent.
D, Original file-wrapper.

E, Book containing prior patents.

You are further requested to forward to the Court of Appeals for the First Circuit with transcript of record herein the following plaintiff's physical exhibits:

No. 1, Defendant's Heels, Series A.
No. 2, Defendant's Heels, Series B.
No. 6, Bunch of heels involved in Wendt suit.
No. 7, Bunch of heels involved in Jones & Rosser suit.
No. 15, Bunch of heels involved in Urbansky case.
No. 46, Cat's-Paw Heel.
No. 49, National Heel.
No. 50, Hill Heel.
No. 47, I. T. S. First Heel.
[fol. 46] No. 40, Plaintiff's Commercial Heels.
No. 42, I. T. S. Heel on Shoe.
No. 52, Essex Heel on Shoe.
No. 71, 54, Boards of Essex Heels.
No. 69, Essex Tite-Edge rubber heel nailed to leather lift.
No. 63, Essex heel section attached to leather lift.
No. 69, Negatives.
No. 57, Heels used in photograph.
No. 90, Beaded Tip Comparison.
No. 95, Plaintiff's heel with straight side edge.
No. 96, Defendant's heel with curved side edge.
No. 27, Flat heel nailed on board.
No. 23, Shoe Repair Service for July, 1921.
No. 24, Shoe Repair Service for March, 1922.

And defendant's following physical exhibits:

A, Present Tite-Edge Heel nailed to board by Slough.
B, Heel marked by witness Slough for identification.
E, Present Tite-Edge Heel.
G, Defendant's mold.

Frederick A. Tennant, Counsel for Plaintiff. L. E. Varney, Counsel for Defendant.

Boston, Massachusetts, March 21, 1923.

Allowed April 14, 1923. G. H. B.

[fol. 47] IN UNITED STATES DISTRICT COURT

TESTIMONY

Before Bingham, J.

Present:

Charles A. Brown, Esq., F. O. Richey, Esq., F. A. Tennant, Esq., for the Plaintiff;

Frederick L. Emery, Esq., Lucius A. Varney, Esq., for the Defendant.

Boston, November 20, 1922.

Evidence for Plaintiff

JOHN G. TUFFORD (sworn).

By Mr. Richey:

Q. 1. Mr. Tufford——

Mr. Varney: Before Mr. Tufford is examined may I ask what the materiality of any evidence from Mr. Tufford is in regard to the issues as we limit them? There is no issue as to anything except what is specifically a file-wrapper defense. I have stated my defense, but it is perfectly apparent from the pleadings that we simply put in the file-wrapper and rely entirely upon that. In view of that, I don't see what Mr. Tufford can offer in the way of testimony which is relevant to any issue in the case as framed by the pleadings.

The Court: I don't know what the issue is.

Mr. Varney: Mr. Richey has stated the issue to the extent of saying that the scope of the patent only was in issue.

Mr. Richey: No; the question of equivalents is the only one in issue.

Mr. Varney: That will be the scope. The question of infringement directly is not in issue. The answer simply cites the file-wrapper as the sole defense which the defendant puts in. If the file-wrapper fails under the limitation of claims as they appear on the face of the patent, then we have no defense. That is one thing for this court to consider. I suggest, before any lengthy testimony [fol. 48] is given, that the court examine the pleadings to ascertain just what the issue is.

Mr. Richey: Do you deny the infringement by Exhibits 1 and 2?

Mr. Varney: We deny infringement, but we do not deny infringement by those exhibits if the court follows the decision in the Sixth Circuit and Judge Brown's decision in Providence. We agree that the heels vary as Exhibits 1 and 2 are infringements under this decision. We put in the file-wrapper to contest the correctness or this decision.

Mr. Richey: You agree those heels do function like the plaintiff's heels?

Mr. Varney: We do not think that is relevant at all. We think the question is whether they function according to the terms of the patent, not according to the heels of the plaintiff.

Mr. Richey: Do you agree to that as a fact, that they do?

Mr. Varney: We do not.

Mr. Richey: There is a question of fact that is in dispute, isn't it?

Mr. Varney: It isn't in issue. The question of the Court of Appeals is whether the heels function according to the terms of the patent, and even that isn't in issue. The Court of Appeals held that it would take the claims as they were and construe them as though they were—specifically, the court said:

"For the purpose of determining the question raised by the motion the defendant concedes that the patent is valid, and there is nothing in the prior art except as stated in the patent, and nothing in the file-wrapper which would limit the plaintiff's terms in the patent."

Our claim is there is something. If not, why then the court, if it follows the decision in the Sixth Circuit and Judge Brown, will hold these heels as infringements.

Mr. Richey: Do you agree it does perform the function?

Mr. Varney: I think I have stated my position, your Honor. Do you think Mr. Tufford can give any——

The Court: I don't know as I understand you. You claim that [fol. 49] the heels they manufacture do not function as they claim in the file-wrapper?

Mr. Varney: I think not, your Honor. We admit that it functions as the Court of Appeals in the Sixth Circuit and as Judge Brown in Providence found the heels to function.

The Court: You say that that is not in accordance with the patent?

Mr. Varney: We say it is a question whether it functions in accordance with the terms of the patent, and that we do not need any outside evidence on. I should think that that might be a matter for rebuttal, if anything. We are here at the present time, the present moment, admitting everything except the file-wrapper defense. If the file-wrapper defense is good, why then we say that the claims of the patent are limited. We haven't put in anything else.

Mr. Richey: D*y* you agree that the defendant's heels infringed in accordance with the decision of Judge Luce?

Mr. Varney: I do not; most assuredly no.

The Court: I didn't get that question.

Mr. Richey: I asked him if he said he agreed his heels infringed in accordance with the plaintiff's heels. I also asked him if he also agreed in accordance with the decision of Judge Luce out in the Chicago district. There seems to be a difference in view here as to what is the issue. We contend that the Court of Appeals, in which your Honor was sitting, determined the scope of the claims, and said that the only question left open was the question whether or not the patent heels and the defendant's heels functioned alike. Mr. Varney takes the position that the question of the scope of the claims was not determined, and that he must invoke the file-wrapper to place a different interpretation upon these claims to what he would have placed upon them. Now, as to whether or not he agrees that the defendant's heels function like the patent heels—I understand he has not committed himself on that.

The Court: Proceed.

Mr. Varney: My exception, please.

[fol. 50] J. G. Tufford (sworn).

By Mr. Richey:

Q. 1. Mr. Tufford, will you state your name, age, residence and occupation?

A. J. G. Tufford; sixty-three years old; residence, Elyria, Ohio; president of The I. T. S. Rubber Company.

Q. 2. How long have you been president of The I. T. S. Rubber Company?

A. Ever since it was organized, 1915; January, 1915.

Q. 3. And what was your occupation prior to that?

A. I was a shoemaker before that.

Q. 4. I hand you one of plaintiff's heels and will ask you to explain certain terms to the court. What is meant by rubber heel lift?

A. A lift of rubber acting as a top piece on the heel; a lift of rubber for a top piece on a rubber heel.

Q. 5. It is not a whole heel, is it?

A. That distinguishes a rubber heel lift from a whole heel. A whole heel is of rubber clear to the bottom.

Q. 6. These heels in controversy here are lifts, are they?

A. Lifts.

Q. 7. But they are colloquially spoken of——

A. As whole heels and half heels.

Q. 8. What is an entire heel?

A. An entire heel of rubber. After the leather lifts are all taken off they put on an entire heel of rubber the same height as the leather.

Q. 9. What is the breast edge?

A. That is the front edge of the heel.

Q. 10. That is what would be the front edge when it was on the heel of the shoe?

A. Yes.

Q. 11. What are the breast corners?

A. The corners of the front edge.

Q. 12. And what is the attaching face?

A. The concave face; the attaching face is the face that goes next to the leather when it is put on the heel.

Q. 13. And what is the tread face?

A. The tread face is the opposite face that they walk on; opposite the top face.

Q. 14. What are the washers?

A. The washers, small washers of iron embedded around the nail [fol. 51] hole to engage the head of the nail and to keep it from pulling through.

Q. 15. Now, what is meant in the shoemaker's trade by suction heels and the suction action?

A. A concavo-convex heel that will seal the seams. Those are referred to as suction heels. We use it sometimes in our window cards—size charts.

Q. 16. Mr. Tufford, I show you a heel marked "Cats-Paw Spanish Heel". Will you tell what it is?

A. This is the heel that was in suit in the Fetzer & Spies case in Cleveland.

Q. 17. And another heel marked "National". Will you state what that is?

A. That is a heel in suit in the suit of the I. T. S. against the National Rubber Company, Cleveland.

Mr. Richey: I offer the Fetzer & Spies heel in evidence as Plaintiff's Exhibit 46, Cat's-Paw Heel, and the National heel in evidence as Plaintiff's Exhibit 49, National Heel.

[The above-described heels are marked respectively "Plaintiff's Exhibit 46, Cat's-Paw Heel", and "Plaintiff's Exhibit 49, National Heel."]

Q. 18. I show you another heel, Mr. Tufford, and ask you to state what that is?
A. This is the Hill heel, the heel in suit, I. T. S. Rubber Company against the Hill Rubber Company, Cleveland.

Mr. Richey: I offer that in evidence as Plaintiff's Exhibit 50, Hill Heel.

[The above-described heel is marked "Plaintiff's Exhibit 50, Hill Heel."]

Q. 19. And I also hand you, Mr. Tufford, a heel marked Usco. Will you state what that is?
A. That is the heel in suit, I. T. S. Rubber Company against the United States Rubber Company, first heel.

[The above-described heel is marked "Plaintiff's Exhibit 47."]

Mr. Richey: That is all, Mr. Varney.
Mr. Varney: No cross-examination.
Mr. Richey. All right, Mr. Tufford.
Mr. Varney: Oh, there is one question I would just like to ask.
[fol. 52] Mr. Richey: Yes.

Cross-examination.

By Mr. Varney:

X Q. 20. That is the Cat's-Paw heel in the Fetzer & Spies case; that was what you called a three-point contact heel, wasn't it?
A. I believe it is; yes, sir; a three-point contact.

Mr. Varney: That is all.

Frank M. Slough (sworn).

By Mr. Richey:

X Q. 1. Please state your name, your age, your residence and your present occupation.
A. Frank M. Slough; thirty-eight years; Elyria, Ohio; patent solicitor and expert; engineer.
X Q. 2. Just state briefly your qualifications.

A. I have had, oh, some seventeen years' experience as an engineer. I have been employed in manufacturing establishments, designing apparatus, testing apparatus, supervising the making of drawings from which apparatus was to be made, and have supervised the making of apparatus from drawings. I have been closely associated with the litigation in which the present patent in suit has been involved and I have become very familiar with the rubber heels involved in the different suits and have become very familiar with the practice in cobbling shops where such rubber heels or rubber heel lifts are attached to shoes. Prior to this I had given expert testimony in a number of other patent suits involving other devices than rubber heels.

Q. 3. I show you a bunch of heels marked "Plaintiff's Exhibit 40". Will you state what they are?

A. These are rubber heels made in accordance with the description in the patent in suit of the particular embodiment of the Tufford invention illustrated and described in the patent.

Mr. Emery: Have they been offered in evidence yet?

Mr. Richey: I will offer them.

The Witness [to the stenographer]: Would you please read the question to me?

[The last question is read by the stenographer.]

[fol. 53] The Witness: That is all.

Mr. Richey: Now I offer these heels in evidence as Plaintiff's Exhibit 40.

Q. 4. Mr. Slough, will you explain the ——

Mr. Emery: Just a moment. What did you say those were?

Mr. Richey: Plaintiff's commercial heels.

The Clerk: Let me mark those.

Mr. Richey: All right, sir; they are Plaintiff's Exhibit 40, Plaintiff's Heels.

The Witness: I believe I didn't mention that they were plaintiff's commercial heels, but they are such.

[The above-described heels are marked "Plaintiff's Exhibit 40."]

Q. 5. Will you explain to the court the mode of operation and results or advantages realized by these heels?

A. These heels when made are made from a single piece of rubber molded to concavo-convex form, the attaching face being concave and the tread face convex, the rubber heel comprising arched portions extending in all directions both longitudinally and transversely, the result being that when the heel is attached to a flat surface such as the flat lower surface of a leather shoe heel and by securing nails passing through the openings provided for the purpose in the heel and which openings are located through the central portion of the heel lift, the heel will be flattened down against the flat surface, and when so flattened it loses its concavo-convex form and

the tread face becomes flat. The flattening of the rubber arches comprising the lift produces a sealing of all of the edges all around the heel. The location of the nail holes and the embedded washers in alignment therewith, which you cannot see but which are located on the interior heel, enables the cobbler who applies this heel to trim away a considerable portion of the heel, thereby enabling him to use fewer sizes of rubber heels to fit all sizes of shoes. The heel, being made entirely of rubber, is soft and resilient, and in use the flattened rubber arches attempting to regain their normal unstressed form cause a continual pressing down at all of the edges, accomplish-
[fol. 54] ing a tight seal at these edges and without the use of cement or similar means.

Q. 6. What, if anything ——

Mr. Emery: That answer I object to, your Honor, unless and until the witness has compared it with the patent in suit. There is nothing to show that these heels at all represent the patent in suit.

The Court: I suppose you propose to offer that. You can go one step at a time.

Mr. Richey: Yes, sir. It seems to me, though, that the comparison to be made between the patent in suit and the heels is one for the court.

Q. 7. Have you compared these heels with the patent in suit?

A. I have. These heels are constructed almost identical to that preferred construction illustrated and described in the patent in suit.

Mr. Emery: The answer I object to as wholly incomplete.

Q. 8. What, if any, effect does the moving of the nail-attaching means and washers to the center of the heel have upon the life of the heel?

A. It very materially increases the life of the heel. Since most of the wear is at the edges it will take a longer time for the wear to reach the nails and the nail-head supporting washers embedded in the lift.

Q. 9. What, if anything, have you to say about the staggered nails—that is, the form that the nails in the rubber heel are within the nails in the leather heel?

A. When leather lifts comprising a shoe heel are nailed on to the shoe heel they are secured together and to the shoe heel by a row of nails very close together all around the edge of the shoe heel. By locating the rubber heel securing nails in the central portion of the heel the cobbler does not have any interference between the sets of nails. That is, if these nails were at the edges they would oftentimes strike the heads of the leather-heel securing nails, be deflected and cause all kinds of trouble and additional work for the cobbler.

Q. 10. I show you a shoe with a heel on it marked "Plaintiff's Exhibit 42, I. T. S. Heel on Shoe." Will you state what this is,
[fol. 55] and explain what you mean by the operation and results with that shoe?

A. This shoe is one to which I had a cobbler affix one of the plaintiff's commercial heels like those of Exhibit 40 in the regular and normal manner by driving nails through the nail holes provided in the central portion of the heel for the purpose and then trimming the rubber lift to fit the shoe heel. This illustrates the condition of the rubber heel and its ability to seal the seam all around the edges resiliently and continually even when the edges are lifted. It immediately restores when in use. It shows also the flattened convex tread face when so secured.

Mr. Richey: I offer this shoe and heel in evidence as Plaintiff's Exhibit No. 42, I. T. S. heel on shoe.

[The above shoe and heel are marked "Plaintiff's Exhibit 42".]

The Court. He means flattening, not flattened.

Q. 11. I now show you Plaintiff's Exhibit No. 1, Defendant's Heel, Series A, and ask you to compare these heels, their function, mode of operation and results with the plaintiff's heels of Exhibits 40 and 42. You may use such shoes and other models as you wish.

A. These heels of Plaintiff's Exhibit 1 comprise heels which, like the plaintiff's heels, are in their condition as made arched in all directions——

The Court: Excuse me; whose heel are you describing now?

The Witness: The Essex Tite-Edge heel, the defendant's heel. It has a convex tread face and it has a concave attaching face. The nail openings are located just as in the plaintiff's heel in the central portion of the lift, being removed from the side edges to permit a large trimming area and to gain the other advantages which I have referred to as accruing from plaintiff's location of these nail-securing openings. When nailed down on to a flat surface these heel lifts secure the other advantages which I have spoken of in connection with plaintiff's heels, such as the sealing of the seam all round continuously during the use of the heel, the flattened arches attempting to unflatten, resiliently holding the seam closed without the use of cement. I have here two shoes which are marked "Plaintiff's Exhibit No. 52," to which are affixed [fol. 56] two of the defendant's Tite-Edge heels which are like those of Plaintiff's Exhibit 1, except perhaps being different in size and color, and which were nailed to the bottom of these shoe heels, which bottom was previously flat, by nails driven through the nail-securing openings provided for the purpose. When so nailed down the tread faces become flattened: the seam is closed all around the edges, just as I have described the seam for the plaintiff's heel. I have here — [pausing while the court examines the heel].

Mr. Richey: Would your Honor like to ask any question?

By the Court:

Q. 12. Of course where the heel is small the position of the nail does not make much difference anyway, does it?

A. Yes, I think it does, your Honor. It is quite an advantage where the heel is small to have the nails located towards the center.

Q. 13. They are bound to be in a small heel, aren't they, more or less ——

A. No ——

Q. 14. —a good deal nearer than they would be in a big one?

A. Oh, yes, they would be nearer, but in proportion they would be about the same, I think.

Q. 15. And then nearer the outer edge?

A. In linear dimensions, yes, your Honor, but I think the same proportions prevail as in larger heels, some of those heels which you have.

Q. 16. Yes, but the difference would be greater in a small heel than in a larger one?

A. Well, the larger heels, I think, are usually thicker, so that it comes out about the same, I believe. There may be a difference in degree; I don't know.

Q. 17. These two heels are the same thickness on the lady's shoe and on the man's shoe, as far as I can see—practically the same?

A. Yes, perhaps they are. There are heels, both defendant's and plaintiff's, though which vary in thickness somewhat and the smaller ones in such cases are the thinner ones.

Q. 18. Have you got any shoes where they have got a big heel of the infringing device nailed on?

A. I believe that is the largest one I have on a shoe. There is a big one here nailed on to a board—a flat surface of a board.

[fol. 57] Q. 19. You don't get the same idea from that that you do from being on a shoe?

A. No.

Mr. Richey: The operation would be the same.

The Court: I am cobbler enough to know that.

The Witness: You would probably get a better idea if you cut it out while it was on there, but it illustrates the same effect and the way that effect is secured.

Mr. Richey: There is one nailed on a piece of leather that is on a board.

The Witness: He meant he could see around better.

Mr. Richey: Yes.

The Witness: I have here two boards marked "Plaintiff's Exhibit Nos. 71" and "54" to which are affixed defendant's heels of different sizes. In the case of Exhibit 54 some of these defendant's heels have been cut in sections so as to show the flattened arches toward the central portion of the heel. On the board marked "54" also is a section of a flat —

The Court: Let me see one of the defendant's; have you got one loose heel?

The Witness: There is one. Also on the board marked "54" there is a portion of a flat heel nailed down showing a different effect, the edges not being closely in contact. Of course when you nail down a flat heel the rubber under the nail is compressed and the portions more removed bulge up. Usually a cobbler attempts to seal that by the use of cement. I have here also a leather heel to which a defendant's Tite-Edge heel has been nailed down and then portions cut away so as to expose the inner portions of the heel. [Referring to Plaintiff's Exhibit 63.] Here also I have a leather shoe heel marked "Plaintiff's Exhibit 69", to which one of defendant's heels has been attached in the regular and normal way employed by a cobbler when affixing such heels to shoes.

Mr. Emery: What is this last number he has been referring to?

Mr. Richey: 69.

Mr. Richey: What does he say that is?

[fol. 58] The Witness: The last one I referred to, Mr. Emery, is 69. It is one of the Tite-Edge heels nailed on to a leather heel.

Mr. Richey: I offer in evidence the two shoes, with the heels on them, referred to by the witness as "Exhibit 52," as Plaintiff's Exhibit 52, Essex Heels on Shoe.

I also offer in evidence one of the boards of heels, together with the heels on it, as Plaintiff's Exhibit No. 71, Board of Essex Heels. The other board is offered in evidence, together with the heels on it, as Plaintiff's Exhibit 54.

[The shoe heel with the rubber lift on it, 69, is offered in evidence as Plaintiff's Exhibit 69, Essex Tite-Edge Rubber Heel Nailed to Leather Heel.

The rubber heel referred to as 63 is offered in evidence as Plaintiff's Exhibit 63, Essex Heel Section Attached to Leather Lift.]

The above exhibits are severally marked as follows:

["Plaintiff's Exhibit 52, Essex Heels on Shoe."

"Plaintiff's Exhibits 71" and "54, Boards of Essex Heels."

"Plaintiff's Exhibit 69, Essex Tite-Edge Rubber Heel Nailed to Leather Heel."

"Plaintiff's Exhibit 63, Essex Heel Section Attached to Leather Lift."]

Mr. Richey: These, Mr. Emery, are the photographs and the negatives and the heels which were in evidence on the motion.

Q. 20. Mr. Slough, I now show you two photographs marked "55," some negatives marked "56" and some heels marked "57." Will you explain these photographs and how they were made, who made them?

A. These photographs—Could I have a glass plate? I could better explain this. I know where one is. [Leaving stand and returning with glass plate.] These photographs illustrate a demonstration of the ability of the heels which your question inquires about to seal the seam all around the edges when the tread face is depressed.

These photographs were made by taking the four heels of Plaintiff's Exhibit Photograph Heels, 57, and by depressing the tread faces causing them to adhere by suction to the glass plate with the edges [fol. 59] in contact. By expressing the air the recovery of the rubber creates a partial vacuum and while these heels were adhering to the glass plate I assisted the photographer in posing the plate with the heels on the opposite side from the camera. We took the second photograph at the bottom of the exhibit first, and then we took the top photograph by turning the glass plate around so as to expose the tread faces on it.

These heels shown in this photograph are the heels of Plaintiff's Exhibit 57, one of them being a United States Usco heel like those held to infringe in the Sixth Circuit, another being one of the so-called beaded tip heels like those involved in the Providence case before Judge Brown, and another being a plaintiff's commercial heel, the last one being one of the defendant's Tite-Edge, like those of Exhibit 1.

The negatives which you have handed me are the original negatives made when photographing the heels and from which the photograph prints were made. I personally took the negatives into the dark room with the photographer and helped him develop the negatives and saw the operation through the printing process of one set of prints.

Mr. Richey: I offer the photographs in evidence as Exhibit 55, the negatives as Exhibit 56 and the heels as Exhibit 57, photograph heels.

[Photographs marked "Plaintiff's Exhibit 55".
Negatives marked "Plaintiff's Exhibit 56".
Heel 2 used in photograph marked "Plaintiff's Exhibit 57, Photograph Heels".]

Q. 21. I show you two built-up sections of heels marked "Essex Beaded Tip Comparison". Will you state just briefly what they are and what they show?

A. These heels were made by cutting down the longitudinal medial line of two heels, one being an Essex Tite-Edge heel like those of Exhibit 57, and the other being a Beaded Tip heel such as those involved in the Providence case, of about the same size,—the two sections of the different heels—that is, half of a Beaded Tip heel and half of the Essex Tite-Edge heel—being glued together.

By the Court:

[fol. 60] Q. 22. What do you mean by Beaded Tip heel?

A. It is the heel of the United Lace & Braid Company, Providence, Rhode Island. It goes under the trade-name——

Mr. Richey: It was the heel in Judge Brown's suit.

The Court: Didn't he have a whole one?

The Witness: Yes, there is a whole one. It is a heel like that. We then cut one of those heels in two and one of the Essex Tite-

Edge heels in two, and then we glued together one of each kind so as to make substantially one heel out of each pair of sections. These sections of the two kinds of heels go together pretty well, well enough to show that the formation of the two are alike so far as any essentials are concerned.

Mr. Richey: I offer these in evidence as Plaintiff's Exhibit 90, Beaded Tip Comparison.

[Heels showing comparison of Beaded Tip heels and Essex Tite-Edge heel marked "Plaintiff's Exhibit 90, Beaded Tip Comparison".]

Q. 23. Mr. Slough, have you nailed down any of the defendant's heels like Plaintiff's Exhibit 2, Series B?

A. Yes; some of the boards which were produced before, I think, show such heels.

Q. 24. I hand you Exhibits 71 and 54. Will you state whether or not any Series B heels are on this board; and, if so, how they operate and how they function and what results are realized?

A. Yes, sir; on the board 54 the tan heel size 5-0 is a series B heel, and on the No. 71 the two heels marked of size triple 0-000-F are Series B heels. They are nailed down on to the board, the arches of the heel flattened and the seams sealed.

Q. 25. State whether or not they realize all of the advantages of the Tufford heel.

A. They do.

Q. 26. Are the defendant's heels of the same thickness throughout?

A. Not quite. There is a slight variation in thickness. The rear edge, I think it is, or the rear part, is a little thicker than some of the other parts. There are little variations throughout.

Q. 27. What, if any, effect does that variation in thickness in the defendant's heels have upon the function and the mode of [fol. 61] operation and the results of the heels?

A. They function just as if they were of the same thickness.

Q. 28. And operate the same?

A. Operate in the same way to produce the same results.

Q. 29. Realize the same advantages.

A. Yes.

Q. 30. What, if any, effect does the variation in the side edge have in the defendant's heels upon the function, mode of operation and results of the heel?

The Court [to the stenographer]: Read the question.

The Witness: The question is not quite clear, Mr. Richey.

Mr. Richey: Well, cancel it, and I will state it over.

Q. 31. The side edges of the plaintiff's heels are curved—what, if any, effect does that variation in form have upon the function, mode, operation and results of the heel?

A. It has no effect, the same function being performed in both in the same way.

Q. 32. The same mode of operation?

A. The same mode of operation, of course.

Q. 33. And the same result?

A. The same result. I believe I said so.

Q. 34. Did you? I beg your pardon.

A. Here I have modified one of plaintiff's heels so as to give it the straight side edge, and I have modified one of the defendant's heels so as to give it a curved side edge. That was, in the case of the defendant heel, accomplished by filing away a little bit of the heel including the side edge at each side. That gives it, you will see, a curved side edge form. By depressing the tread face with the attaching face in contact with the surface of a board the edges are brought into contact therewith all around. It seals the seam all around when applied to a glass plate and pressure aplied, it adheres by suction, showing that it does close the edge all around. You see, the edges are tight [illustrating].

Mr. Emery: Did that adhere then?

The Witness: Sometimes it adheres longer than others.

Mr. Emery: Did it adhere at all?

The Witness: There it is adhering [illustrating].

[fol. 62] Q. 35. That is one you filed off. Did the other one adhere better than that?

A. It does, I guess.

Q. 36. That is, it adheres better with the straight side edges than it does with the curved ones?

A. Yes it does. Probably, I haven't got that edge as smooth as I might.

Mr. Emery: Perhaps you didn't moisten the glass enough at that time.

The Witness: I didn't attempt to do anything of the kind, Mr. Emery, I assure you. Would you like to have me wipe the glass quite dry?

Mr. Emery: I don't care what you do. It is utterly inconsequential, anyway.

The Witness: I didn't think you meant that.

Mr. Richey: I offer exhibit referred to by the witness in evidence as Plaintiff's Exhibit 95, Plaintiff's Heel with Straight Side Edge. I offer Defendant's Exhibit 96, Plaintiff's Heel with Curved Side Edge.

Q. 37. I show you heel marked "51". Just state briefly what that is, so as to identify it.

A. That is a T. P. heel like those involved in the suit of The I. T. S. Rubber Company v. the T. P. Rubber Company; or I guess it is the other way around, the T. P. Rubber Company v. The I. T. S. Rubber Company.

Q. 38. I show you heel marked "48". Will you identify them?

The Court: What are those?

Mr. Richey: That is in the suit of Judge Luce that we are talking about. That is the character of heels he found an infringement on.

The Court: What has this to do with this?

Mr. Richey: I just thought it would help your Honor to understand the decision.

The Court: I am not concerned in that decision. That decision does not interest me. You have to prove your case before me. His finding of fact is one thing, but I am not confining the question of fact depending on how he found it. That is not evidence at all: that is only introduced for the purpose of influencing and prejudicing: that is not competent. You are going to have exhibits [fol. 63] enough without cluttering the records up with all the exhibits in every case in the United States.

Mr. Richey: I think it is competent on the question of comity.

The Court: It isn't competent at all.

Cross-examination.

By Mr. Emery:

X Q. 39. Mr. Slough, you are Mr. Richey's law partner?

A. I am his partner.

X Q. 40. You are not a member of the bar?

A. I am not a member of the bar.

X Q. 41. The firm name is what?

A. Richey, Slough & Watts.

X Q. 42. Do you know whether any member of your firm is a stockholder in the plaintiff company?

A. It is my understanding that Mr. Richey is. I don't know it, but I believe that to be so.

Mr. Richey: Mr. Emery, I own a few shares of stock in The I. T. S. Rubber Company.

X Q. 43. Mr. Slough, you have, in the course of your direct examination, made frequent references to the Tite-Edge heels? Those are heels you understand to have been made by the defendant Company?

A. Yes, so I understand.

X Q. 44. And are such as are now complained of?

A. Yes, so I understand.

X Q. 45. All of those heels referred to by you, those defendant's Tite-Edge heels, have a lift at the breast, have they not, or attaching face?

A. I don't believe I quite understand you, Mr. Emery. I referred to Series A and Series B heels.

X Q. 46. Then I will ask you this question: All of the heels you have referred to as Tite-Edge heels, which you say and understand have been made by the defendant and are complained of, have the lox spot of the cavity or depression at the attaching or top surface located in the rear of the breast edge, have they not?

A. When attached; yes.

X Q. 47. I am asking you now before attaching it.

A. When they are made; the heels as made?

X Q. 48. When turned uppermost with the attaching surface uppermost, as if to be attached, or when attached to the heel the [fol. 64] low spot, or the lowest spot, in that attaching surface is in the rear of the breast edge?

A. No, not all of them.

X Q. 49. Now, will you point out to me the particular heel you have referred to in which that is not true?

A. Those are some [indicating], heel Series B, Plaintiff's Exhibit No. 2. I believe that is not so of those.

X Q. 50. Your testimony is that the Plaintiff's Exhibit No. 2, Defendant's Heels, Series B, the lowest point of depression in the top or attaching surface is not in the rear of the breast edge?

A. I don't just say that.

X Q. 51. Just what do you say?

A. There is no lowest spot. I think there is a little area—probably all in the same plane.

X Q. 52. Just say just exactly what you do testify to. Let me ask you again. Did you testify that in these two heels, Plaintiff's Exhibit No. 2, Defendant's Heels, Series B, that there is no point in the rear of the breast edge, or the attaching surface, that is lower than the breast edge?

A. That is true when the heels are, as made, unattached and held so that the side edges are in a horizontal plane; yes, sir.

X Q. 53. That is to say, these two heels, Plaintiff's Exhibit No. 2, Defendant's Heels, Series A, is held in a position with the side edges purely horizontal?

A. Yes.

X Q. 54. The bottom of the cavity at the breast edge is as low as the bottom of the cavity at any other point?

A. Before flexing the heel; yes.

X Q. 55. Now, which way will you leave it? A. You testified a few moments ago that the lowest point was back of the breast edge.

A. In Series A.

X Q. 56. And Series B the cavity at the breast edge is as low as at any point?

A. As we have described it, under the conditions we have described it.

X Q. 57. Is your testimony based upon accurate measurement, or was it just observation by the eye?

A. Oh, if you carry your measurement very accurately I suppose you will find little variations in these heels.

X Q. 58. If you have anything with you by which to measure it, [fol. 65] will you please make an accurate measurement?

A. I will try to do so, but rubber yields. It is a pretty hard thing to do. How close do you want it?

X Q. 59. I want it accurate.

A. I say that the lowest portion is substantially level. If you want anything more than that, I will try to measure it.

X Q. 60. I would like something more accurate than "substantially."

A. I will do the best I can for you. Here are the best instruments that I have for determining any such thing. These are depth gauges, one comprising a straight edge with a rod at right angles thereto and which may be reciprocated and adjusted to different distances below the straight edge portion. The other is a micrometer depth gauge. Do you just want to know if there is a difference, or the extent of the difference, if any?

X Q. 61. Both.

A. Then I should have to use the micrometer depth gauge.

X Q. 62. I should think that would be good judgment.

A. I don't know how skil-ful I shall be in making these accurate measurements.

[Witness measures heels.]

This heel here, which I will mark with an X in both corners of the tread face, seems to me to be a little higher at the breast edge than to the rear of it. You will see, Mr. Emery, that when I place this at the breast edge you see no daylight between the breast edge and the point of the micrometer as I move it. As I move it back you see a little daylight.

X Q. 63. I confess I don't, if you leave it to me to testify.

A. As I told you before, it is a very little.

[Mr. Emery looks at heel.]

X Q. 64. Yes, I do see it.

A. That is, in this heel the breast edge is just a little higher than the point on the rear. I didn't know that was so before.

X Q. 65. Now, how about the other one?

A. The other one seems to be characterized in the same way.

X Q. 66. Then these two heels, Plaintiff's Exhibit No. 2, Defendant's Heels, Series B——

A. The difference is very small.

[fol. 66] X Q. 66 (continued). —at their top or attaching faces has the breast edge higher than the low point or the depression in the rear?

A. Yes. I can say, however, that Series B heels, some of them, are not just that way.

X Q. 67. I didn't happen to ask that question, but it is all right. Now, Mr. Slough, how did you happen to have produced two of the very smallest of these heels as your specimens of this type? Have you any larger sizes with you?

A. Of that type?

X Q. 68. Yes.

A. I don't believe I have.

X Q. 69. I will ask you if at the noon recess you will get some larger ones and perhaps that will evidence the outlines more conspicuously?

A. I have one nailed down, if that will serve your purpose.

X Q. 70. No.

A. I have a size 10M which is nailed down on a board, which I don't believe has been produced here.

X Q. 71. You can make almost anything appear from a nailed down heel. Did you at any time know, Mr. Slough, of any Tite-Edge heel such as you say is manufactured by the defendant and here complained of that you have testified to that does not have the low point of the top or attaching surface substantially in the rear of the breast edge?

A. All of these Series B heels, the lowest point is an area extending a little ways from the breast edge.

X Q. 72. Then the top edge of the breast is higher in all of these Tite-Edge heels that you have testified to than some point in the rear?

A. I don't think so. Just this, that I have testified to. I would not want to say as to the others.

X Q. 73. Won't you say as to the others, please?

A. I don't believe they are. I am sure that some of them must be as low at the breast edge as anywhere else.

Mr. Emery: That answer I object to and ask that it be stricken out. I ask you to testify as to these.

The Witness: They are nailed down. I cannot tell now. I was not measuring them closely before I nailed them down. As a matter of fact, I didn't measure them at all; I just looked at them, and they are Series B heels.

[fol. 67] X Q. 74. Then the fact is, you are unable to testify?

A. As to whether there was a thousandth up or a thousandth down; yes.

X Q. 75. No, that wasn't my question.

A. I can testify as to substantial differences; yes.

X Q. 76. Are these heels, Plaintiff's Exhibit 2, Defendant's Series B heels, typical of the other Tite-Edge heels that you have testified to at the present moment?

A. They are as to all essentials; yes, sir.

X Q. 77. No; are they in respect to the top or attaching face?

A. You have just called my attention that this breast edge is a thousandth or two higher than the other points of the attaching face. I did not know it before. If you think a thousandth a substantial matter, I don't. But all of these heels are about alike, and I have considered that they all were substantially level at that portion of the heel. It would make no difference in the operation of the heel, however, that way.

X Q. 78. I didn't ask you to make any elaborate explanation; I am asking you to testify as a matter of fact, if you are able to, whether these heels with respect to the top or attaching face and the position of the lowest point on that face with respect to the breast are typical of the other defendant's Tite-Edge heels that you testified to?

A. They are constructed substantially alike, all the Series B that I know anything of. They have substantially the same structure, operated in the same way and accomplish the same results. I would say they are typical.

X Q. 79. Then, so far as you know, and your testimony is based upon your knowledge, all defendant's heels, Tite-Edge heels, that you have testified concerning this morning have the lowest point in the top or attaching surface located in the rear of and below the top of the breast edge?

A. Just referring to heel unstressed; of course if you depress it, it immediately comes into the plane of the other edges.

Mr. Emery: That I move to have stricken out. I would like to have the witness answer my question.

A. These things are made to do the same thing——

[fol. 68] Mr. Emery. Just a minute, please. I would like an answer to my question.

X Q. 80. I asked you a simple statement as to what these other heels are like. I didn't ask you to explain your conception of their function or mode of operation, or anything else. Take these heels just as they are before attaching. I have asked you a simple question. Will you please answer it?

[The last question is read.]

The Court. Answer yes or no, and then explain all you want to, then we will get somewhere.

A. It is hard for me do to that, your Honor. I believe some of the heels had the lowest point at the breast; I know some of them were measured and nailed down and sealed — the edges, and I think these are the ones. I did not know that any of them departed even a few thousandths to the rear, but apparently this did, Series B, Exhibit 2. That is the best answer I can give, your Honor. I wish I could answer it more directly.

X Q. 81. In other words, you cannot answer yes or no?

A. As to any substantial difference, I could.

X Q. 82. Can you answer yes or no is my question?

A. Not at the present moment. No, Mr. Emery, I cannot. Mr. Emery, may I make a statement? I have remeasured one of the heels and I believe it is level all the way. I don't believe it has a depressed portion in the rear of the breast.

X Q. 83. Then you change your testimony given a few minutes ago in that respect?

A. I cannot see the daylight now below the micrometer in the rear of the breast, although I could a while ago. It is a very infinitesimal matter in connection with this heel. I think this is straight all the way.

[Court examines heel with micrometer.]

The Court. Where was he inquiring about?

The Witness. In back somewhere along there [indicating] to the rear of the breast, he said.

The Court. It isn't so deep back here; it comes away around here

The Witness. The measure, your Honor, if you tilt it——

[fol. 69] The Court: I do tilt it every time I move it forward; I can see it. It indicates to me the lowest portion of the depression is up towards the rear.

The Witness: I think it is.

The Court: Of course it is. In this one I find there is a place away back that is the lowest towards the rear.

X Q. 84. That is the lift that a moment ago you said was level?

A. I thought it was level. It is level, except away back here. There is a low point here, and a raised point on the side edge that makes it seem so.

X Q. 85. Your testimony given a few moments ago was to the effect that the lowest point was to the rear of the top breast edge; is that correct?

A. I find now that the side edges are a little rough.

X Q. 86. Won't you please say yes or no? Please don't explain so much.

The Court: He is trying to explain the variations in measurement of them. I guess the outer edge is not even.

The Witness: The outer edge on the top is not even on that one heel.

The Court: That makes a variation in that measurement as you move it forward and back. Doesn't it indicate the point of greatest depression is in the rear of the heel instead of the front?

Mr. Emery: That is the point I want to bring out, your Honor, whether the lowest point is in line with the breast or in the rear of the breast.

The Court: In that one it is towards the rear, according to my observation.

The Witness: It seems to be slightly. I think it is due to the roughness or inequalities of the heel.

X Q. 87. Now, will you please answer the question I last asked of you?

[The last question is read.]

A. I am sure I don't know. I have changed my mind two or three times in the last ten minutes, measuring this thing. The side edges are a little rough, and that being the only point of reference [fol. 70] that I had in making the measurement, I cannot tell. I would not want to swear it was lowest at the rear or lowest at the breast.

X Q. 88. Now, you have given a deposition in this present case, haven't you?

Mr. Richey: It was not offered in evidence, Mr. Emery.

Mr. Emery: Are you going to offer it?

Mr. Richey: No. The witness is here.

The Witness: Shall I answer that question?

Mr. Richey: We object to the question, your Honor—go ahead you can answer it whether you did or not.

The Witness: I did, a long time ago; several years ago.

X Q. 89. Do you remember, in the giving of that deposition, the following question and your answer?

"Q. 8. I show you a bunch of Essex Tite-Edge heel lifts to which there is attached a tag marked 'United States District Court, Northern District of Ohio, Eastern Division, the I. T. S. Rubber Company against the Thomas Urbansky & Sons Company, Plaintiff's Exhibit Defendant's Heels, filed December 4, 1919, B. C. Miller, Clerk, District Court in D. O.' Will you compare those heels and their mode of operation and results with the heels constituting Plaintiff's Exhibit Defendant's Heels, Series A and Series B, in the intent case?

A. These lifts are the same as the ones in the intent case except that some of them are of different sizes and there being, also, variations in color. Upon testing these heels consisting of 'Plaintiff's Exhibit Defendant's Heels in the Urbansky case, I find that they have the same mode of operation and results as the heels in the intent case except perhaps in some cases there may be a difference in degree of operation and result."

Do you recall giving that?

A. Not clearly.

Mr. Richey: Just a moment. I object to the question, your Honor, for this has not been offered in evidence here and the witness has not [fol. 71] been asked regarding these heels or this case in his direct examination, therefore the question is not germane to the direct examination.

The Court: This all relates to Tite-Edge heels, doesn't it?

Mr. Richey: Yes, sir.

The Court: It all relates to Tite-Edge heels, the subject-matter of the inquiry that you put in here?

Mr. Richey: Yes.

The Court: He offers it, I suppose, for contradiction, or something?

Mr. Emery: Yes, your Honor.

The Court: It must be competent.

Mr. Varney: Does your Honor realize this deposition was taken de bene for this particular case, and now counsel does not want to put it in.

The Court: He is not under any obligation to put it in. Anything he testified to in that deposition that was contrary to what he testified to here, you can put in.

Mr. Varney: I wanted to know your Honor's mind was clear that this was taken de bene.

The Court: He is not under any obligation to put that in himself.

A. I think I did so testify. It has been several years. I don't remember, don't have particular recollection of all the parts of the question, but I suppose I did.

X Q. 90. I have placed a copy of that deposition that was furnished defendant's counsel by plaintiff's counsel at the time before you so that you could read your question and answer more deliberately, if you wish.

A. I am quite sure I did so answer that question. That is the best recollection I have.

X Q. 91. Then, to the best of your recollection, you did so testify?

A. Yes.

X Q. 92. Now, Mr. Slough, I call your attention to Plaintiff's Exhibit 54, to which various fragments of heels have been nailed. In the lower left-hand corner is a fragment of a heel marked "flat heel."

A. Yes, I see it.

X Q. 93. Why did you attach that?

A. Merely to illustrate that if a flat heel were to be nailed down [fol. 72] by nails, in looking right at the edges, that points of the rubber from the edges would bow upwardly. That is due to the compression of the rubber, the pulling down of the tread face and the consequent rotation above the point of the nail head.

X Q. 94. Why did you happen to use a fragment of such a heel instead of a whole heel?

A. Because there were fragments of Essex heels on the other, I suppose.

X Q. 95. Don't you know?

A. It is quite a while since I nailed it down.

X Q. 96. You didn't deliberately take a narrow strip cut at the rear close to the nail holes so that you, when you nailed it down, it would tend to kick the breast up?

A. I knew that is what it would do.

X Q. 97. That is why you cut a narrow strip with the edge close to the nail holes?

A. No. I beg your pardon, Mr. Emery. The whole heel will do the same thing.

X Q. 98. Why didn't you show a whole heel?

A. I can do so. Here, Mr. Emery, is a board to which I have nailed an entire flat heel such as the one of which that was a section. You will notice that that has the opening seam due to the same causes that I pointed out.

The Court: It is pretty tight on the breast.

The Witness: At some points it is, your Honor.

The Court: And not so at the rear.

The Witness: I didn't think it was necessary——

The Court: There are more nails at the breast, anyway. I suppose that is so as to make it tighter at the breast.

X Q. 99. But the breast is raised above the board in the fragment flat heel attached to Plaintiff's Exhibit 54 substantially more than at the breast in the full lift that you have just produced, is it not?

A. Yes, it seems to be.

X Q. 100. That is due to the fact that you used a narrow strip and nailed along the rear edge?

A. Perhaps so.

X Q. 101. Then the fragment forming part of Exhibit 54 is not a fair illustration, is it, of the extent to which the breast would lift if the whole breast would have been nailed down?

[fol. 73] A. That is a fair illustration of the flat heel to curl up at the edges, as, for instance, the upper right-hand edge of this board, which is marked "27," that I have handed to you, that curled up at one place and this curled up at another place. I think the breast is open, however, also, in this whole heel. I didn't just pick out that breast edge, Mr. Emery, because it would curl up.

X Q. 102. The breast edge of the fragment is above the board three times as much as the breast edge in the whole heel that you have produced, is it not?

A. Yes, sir; I think it is.

X Q. 103. Now, you have produced a number of heels here that you have referred to as plaintiff's commercial heels. Did you see those particular heels or lifts made?

A. No.

X Q. 104. Do you know what kind of washers they contain surrounding the nail holes, if any?

A. I have seen heels like that made, and I know the kind of washers they put in such heels. I have quite a large number of such heels——

X Q. 105. Won't you answer my question?

A. I don't know these identical heels. No, I don't know, Mr. Emery.

X Q. 106. Now, Mr. Slough, one more question concerning your testimony given in the deposition. When you so testified—that is, question 8 and answer thereto as already called to your attention—did you know that Mr. Tufford, the patentee of the patent in suit, had in a sworn affidavit used in obtaining a preliminary injunction in the Urbanski suit testified, with respect to the Urbanski heels that you compared with defendant's A and B heels, that "the attaching face is curved in all directions and on every line of cross-section"?

A. I don't remember whether I did or not.

X Q. 107. At the time you gave your deposition, question 8 and answer thereto already referred to, did you then know that Mr. Tufford in the same deposition upon the same motion for preliminary injunction in the Urbanski case had said with respect to those Urbanski heels that "the attaching face of the lift is so shaped that there is a somewhat centrally disposed low spot, so that if the upper edges of the lift are put in contact with the horizontal bottom of the heel, as far as may be, without using force to distort the [fol. 74] normal shape of the lift, any contained liquid would be retained in this lowest spot"?

A. I don't recall now anything about that.

X Q. 108. If you had known of such testimony would you still have testified as you did in your deposition, question 8 and answer thereto?

A. What Mr. Tufford may or may not have said would not have modified my answer at all.

X Q. 109. And you do not care to modify your testimony of this morning in view of that previous sworn statement of Mr. Tufford?

A. No.

Mr. Emery: That is all.

Mr. Richey: I offer in evidence the board with the flat heel on it referred to by the witness as "Plaintiff's Exhibit 27, flat heel nailed on board."

[Flat heel nailed on board marked "Plaintiff's Exhibit 27."]

Redirect examination.

By Mr. Richey:

Q. 110. Now, about the washers——

Mr. Richey: If your Honor cares, Mr. Slough can cut open one of those I. T. S. heels on that string and find out what kind of washer is on there.

The Court: A regular circular washer?

Mr. Richey: That is all.

The Court: The same as you see in all these heels?

Mr. Richey: Yes, sir.

The Court: I guess I know what that is.

Mr. Richey: I think you do.

Q. 111. You stated something about the low spot receding in these Exhibit B heels when they were depressed. Will you explain that?

A. What I meant by that was this: That if one of these Exhibit B heels is placed against a flat surface as I now place it and the tread face depressed to flatten the lift, the breast edge comes into the plane of the other edges and the low point with reference to this plane is within the edges to the rear of the breast and additional pressure is required to flatten the arches, and this additional pressure supplies power to tightly close the seam and all of the edges. That is what I meant, Mr. Rickey.

[fol. 75] By the Court:

Q. 112. That is true of your I. T. S. heel only in an intensified way?

A. Yes, it is true of all these heels—that after you press them a little the edges close.

Q. 113. These points, the raised corners and the rear edge being higher, you get an additional pressure in order to drive your heel down to your point of contact? A. No; that is not the point, your Honor, that he was inquiring about.

Q. 114. You get a contraction there all the time; the more you drive it down, the more you have to drive it down, the more force you get and the more resistance to seal the edge?

A. That was not the point he inquired at, your Honor. The point wasn't about the side edges.

Q. 115. No, but it works on the same principle?

A. All the edges are in the same plane, including the breast edge, and the low spot which was originally at the breast recedes, and there is still the low spot here, after you have got all the edges

in contact, and then the additional pressure crushes these arches or flattens them, and these edges being in contact, the result of the pressure is to close the edges. The point is whether or not——

Q. 116. But it does not close the breast edge at all until the side edges are compressed to an extent that will allow that breast edge to come in contact with the heel?

A. Something like that; yes. The side edges expand and the breast edge comes in contact, and then there is a hollow spot in the middle. You press that and the result of that flexure of the arches is communicated to the edges to seal the seam at the breast edge and all around. It won't make any difference whether the low spot starts here or starts a little higher, so far as results are concerned.

By Mr. Richey:

Q. 117. Why won't you in that connection explain the circumstances that are set up in the body of the heel when you press it?

A. When the heel arches are flattened the attaching face surface of the arches is stretched, of course, and the tread face or the portions near the tread face are compressed. That is, there is compression of the tread face and expansion of the other face, and the compression of the tread face is a result of the communication of pressure from one portion of the heel to the other portions; a dis- [fol. 76] tribution of the pressure over the entire heel toward the edges. When the arches are flattened, any of the arches, you get that result. Of course that is true of any beam.

Mr. Richey: That is all the redirect.

Mr. Emery: There are one or two questions, Mr. Richey, that are suggested by your redirect.

Recross-examination.

By Mr. Emery:

X Q. 118. Is it your opinion that a heel that is not concave on every line—that is not concavo-convex on every line of cross-section —may be the substantial equivalent of plaintiff's heels here which you have discussed?

A. Some hypothetical heel, any heel, or are you referring to any particular heel?

X Q. 119. I am asking you that question.

A. You said "a heel." I didn't know whether you meant Series——

X Q. 120. No, no; a hypothetical question.

A. Yes, it may become the full equivalent.

X Q. 121. That is, if there is a line of cross-section that is not concavo-convex, it may still be the substantial equivalent of plaintiff's commercial heels?

A. It may if during the operation it becomes concavo-convex,—certainly.

X Q. 122. Well, if a heel is not concavo-convex on every line of cross-section before it is attached, please explain how it may become such in the procees of attachment.

A. I thought I did that, but I will do so again. If you had a heel on which one of the lines of cross-section was straight, and if before you finally had the heel flattened—that is, after you had flattened it a little—that line became concavo-convex, and then additional pressure was necessary in order to reduce that concavo-convex form to the flattened arch form, then I would say that that heel was the full equivalent by exactly the same mode of operation to accomplish the same result of sealing the edges.

X Q. 123. Now, have you any concrete illustration of such a heel and can you give an illustration of a mode of attachment that would produce what you have last described?

A. I mean any heel, such as the hypothetical one you have described, which during attachment would go through the concavo-[fol. 77] convex form and operate that way.

X Q. 124. Can you give any concrete illustration to explain your answer more clearly?

A. Well, take this heel here; if it were said that this were not concavo-convex——

The Court: Referring to what?

The Witness: One of the heels of Plaintiff's Exhibit B, Defendant's Heels—because there is a line of cross-section down the middle longitudinal line to the center—if it were said that that was not concavo-convex on every line of cross-section as made before attachment because of that straight line, then if this heel when depressed caused that line to become curved or arched or become an arch in connection with the other lines and additional pressure were required to flatten it so that that line of cross-section—that arch at that line of cross-section—would produce pressure at the edges, then that would be the equivalent of a truly concavo-convex heel on every line of cross-section.

X Q. 125. Are you acquainted with the Nerger heel, so-called?

Mr. Richey: We object to that question. That is not germane to the direct examination and is going into the prior art on cross-examination during the prima facie. That is not competent, your Honor.

Mr. Emery: It is perfectly competent to test out what this——

The Court: I don't know what it is going to lead to. You can ask him, I suppose, if he knows the Nerger heel.

A. I have seen heels that purport to be substantial replicas of the Nerger heels. I don't know whether they are or not.

X Q. 126. Could they be so attached or manipulated in the process of attachment to produce the concavo-convex formation that you have referred to in your answer to the last question?

A. Not as I understand the use of the term.

X Q. 127. Why not?

A. Because there is always an opening left at the breast. There is a line of cross-section that is not flattened to produce the sealing at the breast. That is, there are lines of cross-section, arches which

are not so flattened as to produce sealing at the breast. That, I take [fol. 78] it, is the way the term is used.

X Q. 128. The Nerger heel, so called, has no part of the breast line higher than the lowest part of the attaching face; is that your understanding?

A. Would you say that again? I didn't quite get it.

[Question read.]

A. Oh, yes, it has. I would say that the breast corners would be——

Mr. Emery: I think my question is not clear. Strike that out, please, and let me ask you this question:

X Q. 129. In the Nerger heel, so called, the lowest point of the breast line is no higher than the lowest point of the attaching face? Is that your understanding?

A. Well, I have never seen a Nerger heel that I know is a Nerger heel, but if my understanding of the Nerger heel is correct, that is my understanding, that the breast line at the middle of the breast is lower with reference to the horizontal plane of the side edges than other points. I don't know that it is the lowest point but——

X Q. 130. The Nerger heel, so called, is concavo-convex on cross-section, but not on longitudinal sections, all of them?

A. It is my understanding that that is so on at least one line of cross-section.

X Q. 131. Yes, sir, but on the longitudinal median line it is not concavo-convex?

A. So I understand.

X Q. 132. Yes; scoop-shaped, so called, in its upper face?

A. That term requires a lot of definition.

X Q. 133. Well, all right. What I am getting at is this, Mr. Slough: In the process of attaching that heel can you produce that concavo-convex condition which you referred to in your answer a few moments ago?

A. Not in the normal operation of the heel, as I understand it.

X Q. 134. Well, first, could it be done by any method of manipulation?

A. Not in any ordinary way; no, I think not.

X Q. 135. Then you can conceive of no manipulation of the Nerger heel in applying it that would produce the concavo-convex condition that you referred to a few moments ago?

A. Oh, I could conceive that you could distort that heel most any [fol. 79] way, but I mean as applying the heels, the rubber heels, the Nerger heels, on a shoe, it would not take place.

X Q. 136. But it could be done, but you say it would not normally?

A. You can bend them any way you want to.

X Q. 137. Isn't the same true of this series——

A. These, when nailed down in the natural and normal way, do accomplish the results of a concavo-convex heel on every line of

cross-section. The Nerger heel does not according to my understanding of the matter.

X Q. 138. How would you manipulate that heel, one of this Series B, in applying it to produce the condition that you have described?

A. I would drive nails down through these three holes provided for the purpose.

X Q. 139. And your testimony is that even though the heels might not have to lie flat on the attaching face back of the breast line, that it could be thrown into that attaching face in the method or process of attaching it?

A. During the process of flattening the lift; yes, sir.

X Q. 140. Just a transitional——

A. It takes place.

X Q. 141. How would the nails be driven to produce that?

A. Through the nail holes in the heel.

X Q. 142. In any order? In any given order?

A. Why, do it just the way a cobbler would; take them and first place the nails, then drive them down, and then set them, not one at a time but all at about the same time. That is, like when you nail down anyhing you don't drive any one nail all the way down before you drive the other nails; just the regular way that a cobbler does.

X Q. 143. Well, how would the nails be driven in a heel lift that had no concavo-convex section on the longitudinal median line to produce such a cross-section in the process of attaching?

A. Why, you would place this heel on the flat surface of a leather heel and you would take the nails, drive them in these nail holes so that they would hold the heel in position.

X Q. 144. Just a moment. I don't like to have you use that [fol. 80] heel as an illustration, because you have testified that that is not such a heel. I am asking yon now a hypothetical question.

A. You would drive the nails through the nail holes with the hammer. That, of course, would not project the nails in as far as they are to be projected; then you would take a nail set, which is a tool with a rounded end, and you would set these nails by tapping them lightly one at a time until you have them all down substantially at the same time.

X Q. 145. And your testimony is that such a lift that is not normally concavo-convex in the longitudinal median line would become such in the process of nailing it to the heel?

A. Such a heel during the process of nailing it would become arched with the breast edge in contact and the side edges in contact and then additional pressure—that is, setting the nails—would cause it to get down with the edges tightly in contact.

X Q. 146. Now, at what point in the process of attachment would that formation be found?

A. Rather early, I think, in the process; somewhere intermediate.

X Q. 147. And that would be true regardless of the order in which you drove the nails home?

A. I don't know what would have taken place if you might drive the rearmost nail down to the limit first, or one of the corner nails to the limit first; but in the regular normal way, that would take place.

X Q. 148. That is to say, your testimony is that if you drive the nails——

A. In the regular way.

X Q. 149. —serially, a little at a time, until they are all driven home——

A. Yes.

X Q. 150. —that the lift that is not made concavo-convex on every line of cross-section will be made such temporarily during the driving?

A. Well, I would rather put it the other way—that the lift which normally had its lowest point at the breast, such low portion would be inside of the edges toward the end of the operation and leaving arches yet to be flattened; yes, sir.

X Q. 151. I see. Are you familiar with the decisions of the Court of Appeals of the Sixth Circuit in the T. P. Rubber Company suit, so called?

A. I have read it some time ago.

[fol. 81] X Q. 152. You have seen the diagrams that constitute a part of the opinion of the Court of Appeals in that case?

A. Yes, I have seen them.

Q X Q. 153. And you have observed the outline of the T. P. heel there complained of that appears on page 251 of the reported decision in 268 Federal?

A. Just one line of cross-section—yes.

X Q. 154. Now, that line of cross-section you understand to represent the longitudinal median line, do you not?

A. Of the heel as made according to the court's view—yes.

X Q. 155. Yes. Is that such a heel as you say in the process of attaching would become temporarily concavo-convex on every line of cross-section?

A. That diagram is not enough to define the shape of the heel.

X Q. 156. Well, now, let us see.

A. The other arches modify the action very materially.

X Q. 157. Are you familiar with the T. P. heel, so called, there complained of?

A. Yes.

X Q. 158. And you testify that that heel in the process of attaching would not or could not take on the concavo-convex cross-section in every direction that you have been testifying about within fifteen minutes?

A. I think it could.

X Q. 159. You think it could?

A. Yes.

X Q. 160. You know that the court there held such heel not to infringe the patent here in suit, do you not?

A. Yes, it is my understanding that the court held that the transverse arch at the breast was too sharp to be overcome by the longitudinal arches.

X Q. 161. Where did you get that understanding?
A. From reading the decision.
X Q. 162. Do you think you could point out to me the language of the decision that so held?
A. I believe so.
X Q. 163. I ask you to do so.

[Witness examines report of case.]

A. It is quite a little while since I looked at this; I will have to go over it probably for a moment and find it.

The Court. Well, we will come in at two o'clock.

[Noon recess.]

[fol. 82] The Witness. If you will hand me that volume I will point out the section of the T. P. decision referred to.

[Mr. Emery hands volume to witness.]

By Mr. Emery:

X Q. 164. You might read it right into the record.

The Court. What is the volume?
The Witness. Volume 268, Federal Reporter, page 255, in the last paragraph:

"The depth of the transverse arch at the breast [referring to the T. P. heel] is such that when this part of the face is pressed up flat, there is a strong tendency for it to spring down away again and resume the transverse arch form. To resist and overcome this there must be a greater force applied to the longitudinal arch caused by the pressing up of this center. This greater force cannot exist when the transverse arch in its normal shape to which it tries to return is deepest at the breast [unless the effect of this condition is in some way neutralized"].

That is one point where it is referred to in the decision.

X Q. 165. Have you any other point that you know of, or recall?
A. Any other place?
X Q. 166. Yes.
A. It is referred to more generally elsewhere. On page 256, the second paragraph:

"We are satisfied that whether it should be said to be due to the depth of the transverse arch at the breast or to the fact that in its normal form the longitudinal surface does not rise from the center of the breast (which we think is two forms of expression of the same fact) the performance of the T. P. lift with respect to this general theory——"

I guess that is the most of it. I take it from that that the court considered that the T. P.——
X Q. 167. I am not asking you to construe it.

A. I believe that was the original question.

X Q. 168. I just asked you to point out the section of the opinion that you referred to in an earlier answer. Please look at th- heel I [fol. 83] show you marked "Tite-Edge" in raised letters, with an S and a X monogramed thereon, and 7-W, and say whether that heel in the process of attachment would partake at any point, and, if so, at what point, in this longitudinal concavo-convex formation you have referred to.

Mr. Richey. May I object to the question as immaterial. The bill was filed June 17—in June, 1920. This heel bears the patent date July 5, 1911. That is evident therefore that this heel has been made since the bill was filed.

Mr. Emery. It might have been made yesterday, so far as my question is concerned. I am asking this question to test the witness' answer and theory.

Mr. Rickey. My point is it is a heel made by the defendant since the bill was filed, and therefore any evidence regarding it is immaterial.

Mr. Emery. It is only, if your Honor please, to test the theory according to which this testimony is going in that I desire the witness to answer this question.

The Court. That is not in evidence?

Mr. Emery. Not in evidence.

Mr. Varney. Isn't it in evidence, Mr. Richey?

Mr. Richey. You had it marked for identification, but you didn't offer it.

Mr. Varney. I am going to offer it when I have an opportunity, but I thought that the notary had it noted down that it was marked in evidence.

Mr. Richey. Did she? If you say so——

Mr. Varney. This brings up another question which may come up later. The question is whether we can settle all our differences at the present time. This heel, this is the type of heel that the defendant is making, and has been making for some time prior to the filing of the bill of complaint—that particular heel might not have been made at that time, but apparently my brother Richey does not want to settle the differences. I don't understand it has anything to do with this particular question, which, so far as the question goes, it is a hypothetical question.

[fol. 84] Mr. Emery. That the court may understand, before this suit was brought the defendant changed its type of heel and has been making this type ever since, and has not made the type complained of. But wholly apart from that I ask that merely to test the theory advanced by this witness. I want him to explain to the court how, in the process of applying such a heel, this peculiar transformation may be had, and I take that as a convenient instrumentality.

The Court. You may ask the question.

Mr. Richey. May we have an exception, your Honor?

The Court. Yes.

[The last question is read.]

The Witness. I haven't tested any heels like this, Mr. Emery.

X Q. 169. Judging from the heel itself, what is your opinion?

A. I think it might.

X Q. 170. Well, might as an accident, or might as a natural thing to expect?

A. Might as a result of its formation.

Mr. Emery. To identify the heel just referred to by the witness, but not for the purpose of putting it in evidence at all, I merely say that it is marked in the present suit "Exhibit Defendant's Present Tite-Edge Heel."

X Q. 171. Please compare that heel, concerning which you have just answered, with the heel I now show you, and state what if any difference you observe.

Mr. Emery. I will say, there is no trick about this. This is taken from the same mold.

A. You are not referring to the size, four-thousandths of an inch difference, or anything of that sort?

Mr. Richey. We repeat the former objections.

Mr. Emery. I am going to ask him to nail one to a board, and I want him to compare it before he does so, that is all.

Mr. Richey. If your Honor please, may we have a ruling on the objection?

The Court. That is the same heel.

Mr. Richey. Yes, sir.

[fol. 85] The Court: What objection is there to it? Your objection is the same as it was before?

Mr. Richey: Yes.

The Court: I allowed him to ask the question, and you have your exception.

Mr. Richey: Yes, sir.

The Court: I didn't know at first but it might be some different heel, but it seems to be the same thing. Two are alike.

The Witness: These two? I am not sure.

The Court: They are intended to be, then.

The Witness: I think perhaps they are. They look as though they are intended to be the same heel.

Mr. Emery: I say, if your Honor please, so far as we know the two heels were made from one and the same mold.

Mr. Varney: We have the mold here.

Mr. Emery: They are supposed to be the same thing.

The Witness: Let me nail down the other one.

Mr. Emery: If your Honor please, I would be very glad to have the witness nail this one down except that one has been offered in evidence, or may be, and I think it better not to have it nailed.

Mr. Varney: These are numbered. This evidently refers—this is 4-11, 4-16, 4-23. That refers to the series and the row in the mold.

Mr. Emery: Do you find any there marked "Z-30"?

Mr. Varney: That is 2-30.

Mr. Emery: I have no objection to having that nailed to the board; have you?

Mr. Richey: Yes, I object.

The Court: Do you think they number the molds according to the series?

Mr. Emery: Yes. There probably would be 30 or 40 heels in one mold and they are numbered in series. They are supposed to be identical, at least we assumed and understood they were.

Mr. Richey: Did you ask him to nail it down?

Mr. Emery: I am going to.

[fol. 86] X Q. 172. Will you please now nail the heel marked "Defendant's Exhibit——"

The Court: You said you didn't want to nail that one down.

The Emery: I prefer not to, but he wants to.

The Court: Give him that bunch of heels and let him select one out of them that he thinks is smooth, the same as the one he has got.

The Witness: That is not smooth, your Honor.

[Mr. Varney hands witness a bunch of heels.]

X Q. 173. I want you to nail one that is not objectionable.

The Court: Take out one and nail it.

Mr. Richey: We object to the question for the same reasons.

A. Of course there is heavy lettering on the breast side running pretty well on to the breast.

X Q. 174. That is no different from defendant's present Tite-Edge heel, is it?

A. No. I say in all these heels.

X Q. 175. Now, will you pick out one other than that marked by the tag, defendant's present Tite-Edge heel, that you are satisfied with?

A. I am not satisfied with any of them. All the breast edges are irregular. However, that won't make any difference.

X Q. 176. Take one that is most favorable to your contention, if there be such a one.

A. I don't think there is such a one. I am not contending anything.

X Q. 177. Now, I ask you in the presence of the court to nail that heel or lift that you have selected to the board, and point out to the court and state upon the record how you are driving the nails, and point out to the court that stage or period or point in the process of attaching or nailing at which you say the longitudinal concavo-convex formation is had which you liken to or compare with plaintiff's commercial heel.

A. That is going to be a little difficult, because I cannot see under it while I am nailing it, but I will nail it down.

X Q. 178. Does the workman usually see under the heel when he is nailing it?

A. No. Probably he don't, except he knows it is a convex heel [fol. 87] and he nails it down, and if he gets a tight edge that is the result.

X Q. 179. Suppose you do the best you can.

A. This is the way the workman would nail down this heel.

Mr. Emery: Witness drives one nail in the center hole—if I misstate this, you will correct me—to a point where the top of the nail head is substantially flush with the surrounding area of the tread surface of the heel.

Witness now drives a second nail in the upper left-hand hole, standing back of the heel and looking towards the breast, the nail being driven and producing a slight depression in the heel surrounding the nail head.

Witness now drives the center nail a little farther to correspond with the second.

Witness now drives a third nail in the right-hand corner hole next the right-hand breast corner.

X Q. 180. Have you at this point so deformed that heel as to produce the concavo-convex longitudinal formation that you have compared to plaintiff's commercial heel?

A. If this heel is going to conform with that mode of operation I have described, it should be in practice by this time.

X Q. 181. Then if you were to cut that through the middle and examine it we ought to find it now?

A. If you were to cut that through the middle at this time, and such cutting would not cause any release of the pressure so as to destroy it from what it is now, I think you would then find that the breast edge is higher than the portion back here, assuming that is the kind of heel.

X Q. 182. Are you able to say from the top, as it now appears upon the board, and without cutting it open, whether you have attained that structural deformation that you have referred to?

A. I don't know whether I can or not, but I will investigate. I doubt if I have entirely, although there seems to be a cavity to the rear of the breast. The breast edge is not entirely down at all points, although pretty well down.

X Q. 183. Well, has that heel now been deformed to a point or extent to which you say it would substantially resemble plaintiff's [fol. 88] commercial heel?

A. I rather doubt it. It resembles it, yes, in a degree.

X Q. 184. I want you to point out to the court when you get to the point where it is like it, as you have testified.

A. It is hard for me to tell what it is doing underneath there. I cannot see these arches; I cannot tell when it is deformed a certain amount, or whether there is any space under there or not. By pressing it I think there is a little space there, but whether it is more than out here I cannot tell.

X Q. 185. Is the breast of this heel sealed now?

A. No, it is not, with the nails in the condition they are.

X Q. 186. Then, if there be a cavity within the heel contour nothing could be sealed within it?

A. Are you asking me a question?

X Q. 187. Yes.

Mr. Richey: May it be understood that our objections are to be made to all of these questions regarding this heel without repeating them?

Mr. Emery: Suerly. I assume you object to everything.

[The last question is read.]

A. What does that mean, Mr. Emery? I don't understand it.

X Q. 188. There is no sealed cavity within the heel at this stage?

A. Not at this stage; no.

X Q. 189. As I understand you, all points of the breast are not pressed down intensively upon the board?

A. Not all points.

X Q. 190. Now, won't you proceed with the nailing of the heel and call the court's attention if and when you get to a point when the entire edge is compressed intensively?

A. You mean to just continue nailing it down?

X Q. 191. Yes.

A. I will proceed to put in the other nails.

Mr. Emery: Driving now the two nails below the corner ones, the left one first, and now the last or rear nail. Witness now with a nail set sets the upper left-hand nail as driven; now the upper right-hand one; now the upper left-hand one again, then he nails on the back of the heel. Witness now sets all of them a second time. [fol. 89] The Witness: The breast edge of this heel is open slightly. The other edges are all tightly closed.

X Q. 192. That is to say the breast edge has not been put under compression in the act of nailing it to the board with the drivings and the successive settings; is that true?

A. No, it has not been firmly closed.

X Q. 193. Now, will you answer my question, please? The breast edge has not been put under compression?

A. Apparently not, not in that heel. The outer edges are tightly under compression.

X Q. 194. That is, the curve tour and back edges are all under tight compression?

A. Yes, they are.

X Q. 195. I ask you to state to the court whether it is possible to slip a piece of paper under the breast edge of the heel where you have nailed it upon the board.

A. I expect you could at some point, if you are skilful enough. Yes, at several points.

X Q. 196. Almost for the entire length of the width of the breast?

A. In this particular heel that is apparently so.

Mr. Emery: The board carrying the heel lift marked "Tite-Edge" with the monogram S and X, and 7-W, just nailed upon it by the witness, and to which he has testified since the opening of the afternoon session, is offered in evidence, or is marked for identification "Defendant's Exhibit A."

The Witness: May I make a statement?

Mr. Emery: Certainly.

The Witness: It looks to me as though in this heel the line of the—you will note there is no nail in the center between the two front nails. That has been omitted in this heel. It looks to me as though between this line and the breast edge there was some inscription in raised letters, and I have an idea that breast edge is lifted up rotating around these letters. Besides, the breast edge on all of these heels you show me is very rough and shows a number of inequalities. I don't know anything about the imbedded washers. Sometimes these, I find, are tilted in some of the defendant's heels. If you were to nail down or attempt to rotate or straighten them they will lift, or [fol. 90] have a tendency to do it. I don't say that there are such in this heel, but some of them are that way.

X Q. 197. Do you understand that the essential feature of plaintiff's commercial heel is the level or angle at which the washers are put in?

Mr. Richey: I object to that question as immaterial.

The Court. He is only testing the witness. He may answer the question.

A. There is a regular way of putting washers in heels, and I take it the defendant intends to put them in straight, but I just called attention to the fact that sometimes, perhaps inequalities in manufacturing, the washers sometimes do become tilted and that, combined with these raised letters and the other inequalities, may have raised that breast edge. I was a little surprised to see that breast edge open. I thought it would close.

X Q. 198. The raised letters being there constitute a part of the cross-section contour of that heel at its edge surface, do they not?

A. I notice in different heels raised letters are placed at different points on the face. They are not always here; sometimes they are back here [indicating].

X Q. 199. However that may be, if they are present they constitute a part of the contour of the attaching face, do they not?

A. They do in that heel.

X Q. 200. They do in any heel, don't they?

A. If they are there.

X Q. 201. That is my question.

A. Yes.

X Q. 202. You cannot ignore them, can you?

A. No; if they cause a difference in the results.

X Q. 203. I am not saying that they do. My own opinion is they do not. If they are there they are a part of the contour?

A. I have said I don't know very much about that heel only what I have seen. These letters seem to be resting tightly on the board.

X Q. 204. I should expect that to be so. I now show you a heel that has no marks in the shape of raised letters, or anything upon

it, to which is attached a green tag, and ask you to say whether, in [fol. 91] pursuance of your theory, in your opinion that heel has the longitudinally concavo-convex formation that you have referred to, and would, in the course of attaching it or nailing it in position, assume this formation that you have described and which you say is characteristic of the plaintiff's heels?

Mr. Richey: We object to that question because it is immaterial. Manifestly it does not change the issues of this case in here, because if there are others and imperfect heels, that does not embody the invention of the patent in suit.

The Witness: I take it I have been referring to this in connection with heels that are lowest at the breast?

Mr. Richey: I haven't heard anything like that.

The Witness: I don't know what the terms were.

X Q. 205. I am asking you——

The Court: What is this heel that you are asking him about now?

Mr. Emery: This is a heel which I think has a perfectly horizontal part in here.

The Witness: It is deepest back here [indicating].

X Q. 206. I don't care. I am asking you as to the heel as such.

Mr. Ritchey. If your Honor please, an objection.

The Court: Let me see the heel.

[Witness hands heel to court.]

X Q. 207. You may answer the question.

[The last question is read.]

A. I find that this heel has the lowest point on the attaching face with reference to a plane on the side edges at a point to the rear of the breast.

X Q. 208. Yes. You refer now to the central wedge-shaped cavity or to the horseshoe-shaped rim surrounding it?

A. I was referring to the central cavity particularly.

X Q. 209. Now, will you say what that heel exhibits with respect to that surrounding horseshoe-shaped ledge or rim?

A. Apparently there is a point at the forward portion of that rim, but to the rear of the breast, that is lower than the points just in front of it at the breast, and the front part of the rim seems to [fol. 92] be much in the same plane. There are variations. It has an irregular shape itself. It has a projection on the face that is different from anything in the defendant's heels that I know anything of.

X Q. 210. Would this be a substantially accurate description of the heel you are now testifying about, namely: It has a central depression which starts from underneath and grows gradually deeper towards the rear, surrounded by a horseshoe-shaped ledge or rim

which is substantially level except that close to the breast it may be a little lower than the breast?

A. Except that close to the breast the horseshoe portion is lower than just at the breast?

X Q. 211. Yes.

A. That is a pretty accurate description of some portions of that heel.

X Q. 212. Substantially, however, the horseshoe-shaped ledge is level and the central cavity is deeper towards the back?

A. Substantially so; it seems that way.

X Q. 213. Now, I ask you to read, if you will, into the record what appears upon the back of that green tag.

Mr. Richey: I object to that as immaterial.

The Court: I don't know whether it is or not. Perhaps it is a matter of identification.

Mr. Richey: The witness don't know anything about the correctness of the statement on there.

Mr. Emery: I am not asking him to verify it.

The Court: What is the purpose of offering this?

Mr. Emery: I was going to ask this witness, as the next question, your Honor, if when he testified he knew that his Honor Judge Brown, of Providence, had handed down a rescript in which he stated this heel did not infringe the patent here in suit.

The Court: I don't think it is competent.

Mr. Richey: I object to the question.

The Court: That would be like Mr. Richey putting in his heels and some decision, and wanting to follow it up.

Mr. Emery: I would like to get this identified in the records, anyway.

Mr. Richey: I will say, further, there are claims involved in this [fol. 93] case that were not involved in that case. I object to the question as immaterial and incompetent.

The Court: As a matter of testing the witness that is one thing, but you are offering it now for another purpose.

Mr. Emery: I want to get it identified on the record, to test the witness anyway, and to show what it is about, and later on we can go into it more deeply.

Mr. Richey: You cannot identify that by that witness. He don't know whether that statement is correct, or not.

Mr. Emery: I would like, if your Honor please, the witness to read into the record what the facts are upon the back face of that tag.

The Court: I will exclude that.

X Q. 214. Won't you scratch your initials on the back of that so we may have some means of identifying the things you have testified about?

Mr. Richey: I object to any further questionings on that heel.

The Court: He can put his initials on it.

[Witness marks heel with lead pencil.]

Mr. Emery: I ask that this be marked for identification "Defendant's Exhibit B", the heel marked with witness' initials.

The Court: Tag excluded.

Mr. Emery: Tag excluded. That is all.

[Heel with witness' initials marked "Defendant's Exhibit B".]

Redirect examination.

By Mr. Richey:

Q. 215. Mr. Slough, referring to the heel which you have just marked with your initials, would the cavity in the horseshoe-shaped part of the attaching face be flattened out when the heel was nailed down?

A. No.

Q. 216. Will you state what, if any, advantages of the Tufford heel are realized by this heel which you nailed to the board, and which has been marked "Exhibit A"?

A. This heel would realize the advantages of the nails being located near the center, a wide trimming area, the tight extensive [fol. 94] sealing of the side and rear edges, the soft resilient purposes of the rubber giving the cushion—what you call the cushion effect. It realizes a certain degree of sealing in the breast although this particular heel does not seal the breast perfectly—rather, it seals it imperfectly.

Mr. Richey: That is all.

Recross-examination.

By Mr. Emery:

X Q. 217. Upon Plaintiff's Exhibit 54 appears a large sized Tite-Edge heel. Is that the kind of heel you understand is here complained of?

A. Yes, sir.

X Q. 218. That is the kind of heel here complained of?

A. Yes, I understand that it is.

X Q. 219. I show you a flat heel lift marked "O'Sullivan's Safety Cushion Heel" which I state to you, for what it may be worth, was bought here in the city in the open market. Won't you please state upon the record how much farther in from the side and back edges of the heel the nail holes on the Tite-Edge lift I have just asked you about are than the corresponding nail holes of the O'Sullivan flat lift?

A. You know, Mr. Emery, those heels are attached by cobblers not only by nails, but they cement them on to the leather lift. That isn't true of these heels.

X Q. 220. Now, Mr. Slough, will you be good enough to answer my question?

A. I was afraid the answer might be misleading. The cobblers always cement these heels on. I know that, because I have had them put on my own shoes.

X Q. 221. Now, won't you answer my question, please?

A. Surely. There seems to be about three thirty-seconds of an inch difference between the two, the Tite-Edge Essex heels being that much nearer the center hole. They were that much farther removed from the side edges.

X Q. 222. Three thirty-seconds from the edge into the hole?

A. Yes.

X Q. 223. How far in from the hole on the O'Sullivan?

A. About one-half inch.

X Q. 224. Just give it to me exactly, if you will.

A. They vary just a little, but the variation seems to be alike in both heels.

The Court: These are all made up by uniform setting machines, aren't they—these O'Sullivan heels?

[fol. 95] Mr. Emery: I didn't suppose they were.

The Court: I expect you will find so.

Mr. Emery: I supposed they were made by attaching by cobblers.

The Court: I guess you will find they are all fixed to a set.

The Witness: Measuring from the edge or the center of the nail hole?

X Q. 225. The center of the nail hole.

A. Well, from the center of the nail hole I will take.

The Court: You mean this testimony in another case I had?

The Witness: I believe you are right, your Honor.

Mr. Emery: Your Honor does not mean to imply they are only used on the machines?

The Court: Oh, no.

The Witness: The nail—this hole to this [indicating]—I want to point out first that in the O'Sullivan heel the center with the nails—there are three nails on the breast line, whereas with this Essex heel there are only two, so that measuring from the middle of the breast inward there is a very considerable difference between the Tite-Edge heel and the O'Sullivan or from anything else. Say the side edges, measuring the distances from the side edge, the O'Sullivan seems to be about seventeen thirty-seconds.

X Q. 226. Can you leave out your about and give me a real measurement?

A. That is as near as I can tell it.

X Q. 227. That is all right, if you will say it is as near as you can measure it.

A. That is what I mean, Mr. Emery. On the Essex heel they simply nail the heel—

X Q. 228. I have only asked you as to the O'Sullivan.

A. The answer don't mean much.

The Court: It don't mean anything unless you get it entirely.

Mr. Emery: He has already stated the Essex was three thirty-seconds farther in.

The Witness: That is true.

X Q. 229. I asked you to measure the O'Sullivan as a basis of comparison.

A. With the Essex heel it is something over twenty thirty-seconds, or five-eighths.

[fol. 96] X Q. 230. Measured to the center of the hole in each instance?

A. Yes.

X Q. 231. One other question; you have given considerable testimony concerning what you have called the Essex Tite-Edge heels.

A. Yes, sir.

X Q. 232. Do you know that those heels were made by the defendant herein?

A. I do not.

Mr. Emery: Therefore, I object to all that testimony, if your Honor please, as not founded upon anything within the witness' personal knowledge.

The Court: What is that?

Mr. Emery: I now enter an objection to his testimony with reference to various Essex Tite-Edge heels on the ground that it is pure hearsay. It has not been shown that these are the defendant's heels. I presume Mr. Richey may prove it by other witnesses.

The Court: Which heels do you mean?

Mr. Emery: These numerous samples that he has produced.

The Court: Of course that does not prove that those are Essex Tite-Edge heels.

Mr. Emery: That is all.

Redirect examination.

By Mr. Richey:

Q. 233. Have you compared the Essex Tite-Edge heels which you have attached to the boards and shoes which have been offered in evidence and including Plaintiff's Exhibit 52 and Plaintiff's Exhibit 71? Did you say that they were the same as the others?

A. I think that I said that all these heels were alike except the differences in size and color. I may be mistaken. If I didn't say it I want to say it now.

Q. 234. Well, all these heels; which ones do you mean?

A. That I have nailed down on these boards and shoes and that I have been testifying to as Series A and Series B heels.

Q. 235. That is, you mean the heels in Exhibits 52, 71, 54, 69 and 63? Will you compare with those heels before they were attached the heels constituting Plaintiff's Exhibits 1 and 2?

A. They were the same.

[fol. 97] Mr. Richey: That is all.

Mr. Emery: That is all.

Mr. Richey: The plaintiff offers in evidence as Plaintiff's Exhibit 25 three letters which passed between the Essex Rubber Company

and Mr. Wendt. It is agreed that these are true copies of the letters which passed between these parties at about the dates of the copies. Is that right, Mr. Varney?

Mr. Varney: Are those the copies I sent you?

Mr. Richey: Yes.

Mr. Varney: Yes, I agree.

[Three letters between Essex Rubber Company and Mr. Wendt marked "Plaintiff's Exhibit 25."]

Mr. Richey: The plaintiff offers in evidence as Plaintiff's Exhibit 91 a copy of the Sanders patent 1,383,763, which illustrates and describes the defendant's heel, Series A.

[Sanders patent marked "Plaintiff's Exhibit 91."]

Mr. Richey: This Troiano patent is owned by the Essex Rubber Company, isn't it?

Mr. Varney: Yes.

Mr. Richey: We also offer in evidence a copy of the Troiano patent, 1,291,269, as Plaintiff's Exhibit 85.

Mr. Varney: Mr. Richey, you may add there, if you like, that our present heels are made under that patent.

[Troiano patent marked "Plaintiff's Exhibit 85."]

Mr. Richey: Now the plaintiff rests, your Honor.

Mr. Varney: May I inquire, Mr. Richey—you asked me for some correspondence that passed between the jobbers, or rather between the defendant company and its counsel, and I objected to giving Mr. Richey this correspondence, first on the ground that it was privileged. Then he wanted me to stipulate that I had withheld it, and I told him rather than to stipulate that I was keeping anything back I would give him the whole thing if he would put all of it in. I don't want parts of it in. And I have that correspondence here if Mr. Richey wants it.

Mr. Richey. I would like to look it over and see whether I want to put it in or not.

[fol. 98] Mr. Varney: No.

The Court: If he takes it he has to put it all in.

Mr. Varney: It is all private matter. My point was, Judge Bingham, that——

The Court: Well, that is an old rule; you don't need to discuss it. If he takes it he has to put it all in.

Mr. Richey: Does your Honor hold that I must put it all in if I inspect it?

The Court: Yes.

Mr. Varney: I shall not give it to you unless you put it all in.

The Court: You can't get it on any other terms. I won't order it given to you on any other terms.

Mr. Richey: Well, we won't inspect it, then, Mr. Varney.

Mr. Varney: Now, there was one other thing that you asked me to stipulate, and that is that we were notified of the patents before

you brought suit. If you have got a letter notifying us which you could not find, I will stipulate it, but otherwise I don't want to stipulate it.

Mr. Richey: Well, I forgot to prove by Mr. Tufford that these Tufford heels have been marked with the number and the date of patent since the beginning. Do you agree to that?

Mr. Varney: I don't know that they have.

J. G. Tufford (recalled).

By Mr. Richey:

Q. 21. Mr. Tufford, I show you Plaintiff's Exhibit 40, plaintiff's heels, and call your attention to the fact that these heels are marked "Pat. Jan. 11, 16". That is the date of the patent in suit, isn't it?

A. Yes, sir.

Q. 22. When did you first begin to mark your commercial heels with that legend, and how long have you continued to do so?

A. Ever since that date. We marked it just as soon as we could after that date.

Q. 23. And have you continued——

A. We have continued to do so ever since.

Mr. Richey: That is all. Do you want to examine him?

Mr. Varney: No.

[fol. 99] Mr. Richey: All right, Mr. Tufford. The plaintiff rests.

Mr. Varney [handing paper to Mr. Richey]: Will you admit that you wrote this letter?

Mr. Richey: Do you want me to admit that I wrote this letter?

Mr. Varney: Yes.

Mr. Richey: Yes.

Argument of Counsel

Opening Statement on Behalf of the Defendant by Lucius E. Varney, Esq.

If the court please, I will make a very short statement of our defense. As your Honor recalls, Judge Anderson decided in this court that the Series A and B heels, which are now Exhibits 1 and 2 of plaintiff, were not infringements on the face of the patent, and the Court of Appeals on appeal from his decision decided that, giving the claims the broadest interpretation on the theory that they had so to be taken upon that motion, and giving them the interpretation that they would have if there were nothing in the prior art or nothing in the file-wrapper—nothing, in other words, except what was shown on the face of the patent itself to anticipate, that it could not be said that the Exhibit Heels, Series A and B, were clearly outside of the claims. Now we are here again

and we are going to show the court that there is something in the file-wrapper which so restricts the claims that they are not entitled to any range of equivalence whatever, that they must be taken exactly in accordance with the literal meaning of their terms. We are going to show, in other words, that when the plaintiff or when the plaintiff's assignor, Tufford, went into the Patent Office he asked for something considerably broader, something which the Court of Appeals in the Sixth Circuit and which Judge Brown in Providence has found to be the essence of his invention; that is, the thing that he contributed over and above the nearest prior art patent which they thought was Nerger. He went in and asked for that, but he came out with that limited to his specific form. I say came out with that limited—he went in and asked for, as we shall show you, a type of heel which is concavo-
[fol. 100] convex, and he said his invention was that type of heel if it were concavo-convex on all cross-sections. That is what he wanted to get and that seems to be, according to the opinions in the other courts, what he has invented over Nerger, if anything. In other words, when Tufford is subtracted from Nerger that is what you have got.

Now that is what he asked for, we shall show you. He came out with claims which called for a concavo-convex heel, concavo-convex on every line of cross-section, when and only when he had limited that by a clause which appears in every one of these claims—claims 5 to 9 are the claims sued on—which called for a specific limitation to the form shown in the drawing. That will be our sole defense. There is, of course, the question of res judicata, which I have not any testimony to offer regarding in the case, and I shall take it up later on in my argument. And so all I shall do is to put in first a certified copy of the file-wrapper of the reissue patent in suit. I offer that as Exhibit C.

Mr. Richey: If your Honor please, we object to the file-wrapper on two grounds. First, on the ground that the Circuit Court of Appeals in this circuit has already found that the language of the claims is clear and unambiguous, and has limited the scope of this inquiry to that fact, equivalency. Here we have a written instrument, a contract signed and sealed, which constitutes the final memorial of the intentions of the parties and found to be so by the Court of Appeals in this circuit, and the defendant coming in and asking the court to go into the preliminary proceedings to vary the terms of that instrument which are clear and unambiguous, and not only not shown to be otherwise, but found by the court to be so. Our second objection is that this defendant has had its day in court on the question of the file-wrapper; that it has contended in the other proceeding that the file-wrapper was incompetent and should not be considered—not upon the proposition that that contention was made for the sake of the motion, but upon the general proposition. If I may read just a few lines from their brief upon this subject:

[fol. 101] "We did not suppose that excursions could be made outside of the patent to enlarge claims or to substantially change them

for any purpose whatever. We submit that if this court holds that evidence of this sort can be resorted to and should be resorted to in the present instance to construe the claims which when read with the specification are perfectly clear, then it is flatly against the rule implied by this court in the Tufford mold case, namely, that the specification is the most that can be looked to when a patentee would read something into a claim which the ordinary meaning of its language does not necessarily import."

There is an admission that this document, this contract, is clear; and yet the proposition is that we should go into the preliminary proceedings to vary the clear meaning of the terms of the contract.

The Court: What are you reading from now?

Mr. Richey: The brief of the defendant-appellee filed in the Court of Appeals in this circuit on the appeal from the dismissal of the case on the motion. This is the brief that was filed in connection with the hearing on which the last decision was made by this court. Your Honor wrote the decision.

The Court: Yes, but I didn't see what your language had reference to in that case, that is all.

Mr. Richey: We find—I won't take the time to read, but I will assert, and my brother may correct me if it is wrong—that in the hearing in the court below he even criticized—he even condemned Judge Brown and the Court of Appeals in the Sixth Circuit for going into the file-wrapper, on the grounds that they had gone outside the contract to interpret the terms of the contract, which defendant's counsel then declared could not be done. Now I say, admitting that that the file-wrapper should not be in and going to issue in that point, he has had his day in court and the file-wrapper should not be admitted now.

The Court: Well, I will admit it. You may have an exception and we will move along.

[File-wrapper of reissue patent marked "Defendant's Exhibit C."]

[fol. 102] Mr. Varney: The file-wrapper of the reissue patent refers to the file-wrapper of the original patent, and I offer the file-wrapper of the original patent in connection with the file-wrapper of the reissue, so that some of the papers in the reissue file-wrapper will be clear.

Mr. Richey: We make the same objections.

The Court: The same ruling.

Mr. Richey: And the same exception.

Mr. Varney: Exhibit D, that is.

The Clerk: D is the original file-wrapper?

Mr. Varney: D is the original.

[Original file-wrapper marked "Defendant's Exhibit D."]

Mr. Varney: Then I offer this book of prior patents. There are only those patents which are referred to in the file-wrapper, with the exception of one patent, the patent to O'Sullivan in 1899. I offer these patents not so much to show the prior art as to interpret the

file-wrapper. I don't care anything about them as a prior art defense, I mean. I simply want to show that this is what the Patent Office Examiner during the prosecution of the Tufford patents says is old. I don't care whether it is old or not; I want to show these patents simply to show what he said were old and what they acquiesced in when they amended their claims as being in the prior art.

Mr. Richey: We make the same objection.

The Court: Very well.

Mr. Varney: They are not certified. I assume you make no objection?

Mr. Richey: No, not on that ground.

[Book containing prior patents marked "Defendant's Exhibit E."]

Mr. Varney: There is a heel here which I had identified during the examination or cross-examination of one of the plaintiff's witnesses.

The Court: Today?

Mr. Varney: During a deposition taken de bene. It is marked [fol. 103] for identification "Defendant's Exhibit Present Tite-Edge Heel." I offer that in evidence now as Exhibit F.

[Defendant's present Tite-Edge heel marked "Defendant's Exhibit F."]

Mr. Varney: Then I likewise identified the mold in which heels of that type are made by the defendant, and that was identified by the same witness at the same time as defendant's mold. I offer that as Exhibit G.

Mr. Richey: We object to that, your Honor. Here is a great big piece of iron. It isn't anything to do with the case. If we charged infringement of the heels made in that mold, why manifestly the mold has nothing to do with it; the heels themselves are the important thing. The mold is here; the heels may be different in shape from the mold.

Mr. Varney: I quite agree with Mr. Richey. In an ordinary case I should not think of introducing the mold. But there have been some very fine lines drawn in this litigation so far. When you read the T. P. decision, if you have not already read it, the court differentiated between infringement and non-infringement by a hair line. Now, inasmuch as these heels are of soft rubber and may easily become distorted, it occurred to me that if the court was to make a fine distinction as to what was an infringement and what was not, it had better have the mold. If it were in doubt as to whether the heels were over the line or under the line, perhaps the mold might help some. And that is why I offer the mold in this case.

Mr. Richey: Why, the mold would just add to confusion. You admit that the heel may differ from the mold.

Mr. Varney: No, I don't admit it.

Mr. Richey: Or you admit we would find it was something different from the mold.

Mr. Varney: I only offer the mold in case the court finds it convenient to go back to the mold. I don't know as the court will.

The Court: I will admit it. You may have your exception.

[Defendant's mold marked "Defendant's Exhibit G."]

Mr. Varney: Then I offer this letter which my brother Richey [fol. 104] has just identified, this letter written to the defendant January 16, 1920, about five months before the suit was brought.

The Court: A letter from what?

Mr. Varney: A letter from the plaintiff's attorney to the defendant in reference to the litigation generally.

Mr. Richey: What is the purpose of offering that?

Mr. Varney: I shall argue as one of my defenses that if this court finds infringement in some of the old heels that we gave up making before the suit was brought, that an injunction ought not to issue. If the court finds that we stopped infringement in good faith—there are facts which show that in this case already—two months or a substantial time before the suit was brought, and that was more than two years ago, and have never made any of those heels that infringed since, we shall ask the court not to issue an injunction, and I shall use this letter to show how prior injunctions obtained against defendant jobbers have been used or how they were threatened to be used by the plaintiff to injure us greatly. I can show that they have injured us greatly and I would show by such a letter as this that an injunction would do the plaintiff no good and it might be used to do us a great deal of harm under those circumstances. It would be simply a part of the evidence that I should use in that case.

Mr. Richey: I object to it as immaterial.

The Court: Show him the letter and let him see what it is.

Mr. Varney: He has seen the letter.

The Court, Oh, he has?

Mr. Varney: I asked him to identify it so I would not have to call him.

Mr. Richey: You understand there is no claim in this case by the defendant against the plaintiff for having brought any suits or threatened to bring any suits against the jobbers. As a matter of fact, no more suits were brought after this suit was brought. After you would not come out to the Sixth Circuit we came down here and sued you, and since that I don't think we have sued anybody else and I don't think we have threatened anybody else.

[fol. 105] Mr. Varney: Well, this letter simply shows your method of procedure and the method that you followed.

Mr. Richey: That letter, of course——

The Court: Well, is it anything that is competent for me to receive?

Mr. Varney: Certainly.

The Court: In your judgment?

Mr. Varney: Of course it is.

The Court: What is the issue it bears on? According to your statement I don't see any issue it bears on here before me.

Mr. Varney: If I should ask your Honor to withhold an injunction——

The Court: Well, that is one thing.

Mr. Varney: —then I should want to show that it might be used to injure us.

The Court: No; if you can show that on notification from them you stopped making what they alleged to infringe here, if I should find it to be an infringing article, long prior to the beginning of this suit, there would not be much occasion to issue an injunction. But I don't see as this letter has anything to do with that.

Mr. Varney: This letter does not go to that line of cases; this letter would tend to substantiate my proposition under another line of cases. Oftentimes a defendant ceases to manufacture during a suit and it asks the court to withhold an injunction. The court considers whether an injunction would injure a defendant substantially or whether it would—the court balances that off against the adavantage that the plaintiff might gain by such an injunction. That is a legitimate inquiry in such cases. Of course our main contention is that we stopped before the suit was commenced and we stopped just as soon as we got any light on what the patent meant. That meant we commenced to change our molds just as soon as the Court of Appeals in the Sixth Circuit——

The Court: How long will it take you to read the letter?

Mr. Varney: All I want to do is to read one paragraph.

The Court: Well.

Mr. Varney: Before we were sued the suits were brought against [fol. 106] the jobbers in the Sixth Circuit. This is a part of the correspondence relating to that.

The Court: Yes.

Mr. Varney: And we were very anxious to be sued in the East and not in the Sixth Circuit, where we thought the courts had virtually decided against us, and Mr. Richey wrote this letter. I will read it all.

The Court: Well, if it is going to take very long I don't want you to; I am going home pretty quick.

Mr. Varney: It is just this:

"F. O. Richey. F. M. Slough. E. D. Fales

Richey, Slough & Fales,

Attorneys and Counselors at Law

Patent and Trade-mark Causes

Elyria, O., January 16, 1920.

C. H. Oakley, Pres. & Gen. Mgr. Essex Rubber Co., Trenton, N. J.:

Dear Sir: Mr. Tufford tells me that you recently advised him to tell me to bring suit for your infringement of the Tufford patents in New Jersey.

We brought the suits in Cleveland against H. H. Hackman & Co. and the Thomas Urbanski Sons Co. for selling your heels, because the Court in Cleveland and the Court of Appeals at Cincinnati are educated in this rubber heel litigation, and can undoubtedly dispose of it expeditiously and economically, and because they are not so crowded with work as the Courts in New Jersey, who, I understand are a year or two years behind.

As you have permitted both the Hackman and the Urbanski suits to go by default, there seems nothing else for us to do except notify all the jobbers and others in the trade of your infringement and your failure to defend suits brought against jobbers for selling your heels, but that you have defaulted, permitting them to be enjoined [fol. 107] from selling all infringing heels, and then proceeding against such as cease to infringe as a result of such information.

This we will proceed shortly to do.

Yours very truly, The I. T. S. Rubber Company, by F. O. Richey Its Attorney."

In other words, we were threatened there that if we had defaulted or had not gone out and defended our jobbers, why, they were going to notify everybody in the trade and then all of those who did not stop upon such notification, they were going to notify them that they were going after them and stop them, too. Now it seems to me that is very unfair, and it seems to me a plaintiff who will pursue such a course as that will use an injunction now if your Honor finds that something we stopped two years ago never have continued, that as the evidence shows we have spent $5,000 to change our molds, and we had that all done even before this suit was begun, while they were going to pick out our jobbers——

The Court: Well, I will exclude that letter and you may have an exception.

Mr. Varney: Yes, sir.

The Court: We will adjourn now till tomorrow morning at ten o'clock.

[Adjourned until ten o'clock a. m., Tuesday, November 21, 1922.]

Offers in Evidence

[Memo.—The following is a list of exhibits which were duly offered and received in evidence:]

Plaintiff's No. 1, certified copy of patent in suit.
Plaintiff's No. 1, defendant's heels, Series A.
Plaintiff's No. 2, defendant's heels, Series B.
Plaintiff's No. 13, Shoe Findings of April 1, 1918.
Plaintiff's No. 14, Shoe Repair Service.
Plaintiff's No. 1a, letter, Jones & Rosser to Wendt & Co.
Plaintiff's No. 2a, letter, Essex Rubber Company to Jones & Rosser.

[fol. 108] Plaintiff's No. 3, letter, Essex Rubber Company to Wendt & Co.

Plaintiff's No. 4, telegram, Jones & Rosser to Essex Rubber Company.

Plaintiff's No. 5, letter, Jones & Rosser to Essex Rubber Company.

Plaintiff's No. 6, bunch of heels involved in Wendt suit.

Plaintiff's No. 7, bunch of heels involved in Jones & Rosser suit.

Plaintiff's No. 8, file of correspondence produced by Wendt.

Plaintiff's No. 9, another file of correspondence.

Plaintiff's 10, file of correspondence produced by Urbansky.

Plaintiff's No. 11, file of correspondence produced by Hackman.

Plaintiff's No. 15, bunch of heels involved in Urbansky case.

Plaintiff's No. 19, certified copy of pleadings and decrees in Jones & Rosser case.

Plaintiff's No. 20, certified copy of pleadings and decrees in Wendt case.

Plaintiff's No. 21, certified copy of pleadings and decrees in Urbansky case.

Plaintiff's No. 22, certified copy of pleadings and decrees in Hackman case.

Plaintiff's No. 23, Shoe Repair Service for July, 1921.

Plaintiff's No. 24, Shoe Repair Service for March, 1922.

Plaintiff's No. 46, Cats'-Paw heel.

Plaintiff's No. 49, National heel.

Plaintiff's No. 50, Hill heel.

Plaintiff's No. 47, I. T. S. first heel.

Plaintiff's No. 40, Plaintiff's commercial heels.

Plaintiff's No. 42, I. T. S. heel on shoe.

Plaintiff's No. 52, Essex heels on shoe.

Plaintiff's Nos. 71, 54, boards of Essex heels.

Plaintiff's No. 69, Essex Tite-Edge rubber heel nailed to leather heel.

Plaintiff's No. 63, Essex heel section attached to leather lift.

Plaintiff's No. 55, photographs of heels.

Plaintiff's No. 56, negatives.

Plaintiff's No. 57, heels used in photograph.

[fol. 109] Plaintiff's No. 90, beaded tip comparison.

Plaintiff's No. 95, Plaintiff's heel with straight side edge.

Plaintiff's No. 96, Defendant's heel with curved side edge.

Plaintiff's No. 27, flat heel nailed on board.

Plaintiff's No. 25, 3 letters between Essex Rubber Company and Mr. Wendt.

Plaintiff's No. 91, Sanders patent.

Plaintiff's No. 85, Troiano patent.

Defendant's Exhibit A.

Defendant's Exhibit B for identification, heel marked by witness Slough.

Defendant's Exhibit C, file-wrapper of reissue patent.

Defendant's Exhibit D, original file-wrapper.

Defendant's Exhibit E, book containing prior patents.

Defendant's Exhibit F, present Tite-Edge heel.

Defendant's Exhibit G, Defendant's mold.

Boston, November 21, 1922.

Mr. Varney: If your Honor please, we were offering in evidence certain exhibits at the close of yesterday's session. There was one exhibit which was marked for identification during the cross-examination of the plaintiff's expert witness. It was the heel which was nailed down to the board; I have forgotten how it was identified. I think it is Exhibit B.

The Clerk. Exhibit B.

Mr. Varney. We offer that now in evidence. I might say that Exhibit A, which was marked for identification, we will not yet offer in evidence, because we are waiting to get permission of the counsel who furnished that to us. We may later on offer it.

I will now ask Mr. Livermore to take the stand.

Mr. Richey. We want to object to the introduction of the Exhibit B for the same reason that we objected to the testimony regarding it,—that the heel has been made since the bill was filed.

The Court. Which one was that? Is that the one you have offered in evidence?

[fol. 110] Mr. Varney: That was one of our heels that we submitted to the——

The Court: That is the one attached to the board?

Mr. Varney: Nailed to the board by the expert.

The Clerk: Is that admitted?

The Court: Admitted. They have their exception.

[Heel attached to board, previously marked "B" for identification, is now admitted in evidence as "Defendant's Exhibit B."]

Mr. Varney: I presume Mr. Livermore's qualifications are conceded.

Mr. Richey: Yes.

JOSEPH P. LIVERMORE (sworn).

By Mr. Varney:

Q. 1. Have you read the Letters Patent in suit, Mr. Livermore?

A. I have.

Q. 2. Will you explain to the court how the various functions mentioned in Letters Patent are performed, and in making that explanation you may give your reasons and make any comparisons you desire with anything in the case?

A. The character of the heel, the general character of the heel, shown in the Tufford patent sued upon is, I think, pretty well understood. In the broadest aspect it is a concave, or concavo-convex, rubber heel lift to be used on the heel of a shoe in the place of two or three of the outermost layers or lifts of leather that would be in the regular leather heel. Flat heel lifts had been used for a great many years prior to the time of the Tufford patent, and I think that for the most part they were used quite largely as repair jobs.

After a leather heel had worn out, or worn down, the partially worn lift would be removed and a flat rubber heel put on in place. As the use of rubber heels became more extensive, and perhaps more popular, it was quite common to have rubber heel lifts put on when a new pair of shoes was bought. The person who sold the shoes would have the rubber heels put on if they were asked for, and it is only recently, I think, that the rubber heels have been quite extensively put out with new shoes.

[fol. 111] The advantage, the general advantage, of a concave heel as compared with the flat heel, is when it is used for repair jobs, or to be put out in place of a leather heel that has already been on the shoe, and I think it is of little, if any, advantage if the heel is applied to the shoes as they come from the manufacturer. The advantage, generally speaking, of a concave heel when used for repair jobs, is that in applying the rubber heel to the leather shoe heel it is flattened down from the convex shape to the flat shape, and in doing that the rubber is stressed around the edges against the leather to which it is fastened, and consequently it remains exerting an actual pressure towards the leather around the outer edge where the heel is exposed, and makes a tight, close joint with the leather, such setting being more effective than where a flat heel is used, and not requiring any cement such as commonly used where a flat heel is used.

The patent sued upon recognizes that the concave heel for such general functions was held—at least, the statement is:

"I am aware that it has been proposed to employ a cushion lift having a concave upper surface to be applied to the under face of the shoe heel proper, but I do not believe that up to the present time any practical and satisfactory means has been discovered and employed for attaching such a lift so that its connection with the shoe heel will be to any extent permanent."

Then it goes on to describe the usual methods of attachment, and so on. Then it points out the advantages or functions that the heel of the patent performs, as contrasted with these earlier ones that he recognizes had been in vogue.

Before referring, however, to those functions, to those purposes, I will state that the conspicuous, principal difference between the Tufford concavo-convex heel lift and the prior art, such as was recognized by him, is that the Tufford heel is concavo-convex on four sections. That is, it crowns out from the—when it is unstressed it crowns out from the shoe heel transversely, but also crowns out longitudinally; or, to state it another way, when it is applied to the [fol. 112] heel of a shoe—I will speak always of its being applied to the heel of a shoe when the shoe is bottom up, that is the way the shoe makers look at it, so that the attaching face of the lift is down—when so applied all of the edges, all of the surfaces, of this Tufford concavo-convex lift curve or incline towards the heel surface. In the old form the lift was, strictly speaking, concavo-convex only on the transverse section. It arched or curved down to-

wards the heel on which it rested only around the convex edge of the heel and not across the front or breast.

Now, the Tufford patent describes two or three advantages to that concavo-convex in all directions form and to other features which he included in his lift. One of these is that, as he says:

"One aim of the present invention is to provide a cushion lift so constructed that when applied to a shoe heel its edge portions will not be forced to project beyond the sides of the heel when pressure is applied, and to so arrange the attaching means for the lift that the lift may wear to the maximum extent without exposing such fastening means."

There are really two aims referred to. The second one—attaching the lift so that it will wear to the maximum extent without exposing the fastening means—described in the patent, is quite a trivial matter and I will dispose of it at once. In all rubber heels, practically, it is common to embed in the heel, in the manufacture, certain washers or anchor plates for the nail heads—the nails or screws, or whatever you use to fasten the rubber heel on the heel of the shoe. If an ordinary nail with a not very large head was simply driven into the rubber, the rubber might stretch and pull off over the head of the nail. Consequently, in manufacturing the heel lift in the mold certain washers, or I might call then anchor pieces, are placed in the mold in a definite position, in connection with standards or something that also molds in the heel a hole for the nails. Those washers are thus secured tightly in the body of the rubber, and when the nail is driven in the head of the nail rests against the washer, and the washer against a broader support, so that [fol. 113] there is no danger of the rubber pulling off. In pulling off an old heel it would not be likely to strip it off the head of the nails and leave the nails in the shoe, but you pull the nails out with the heel.

Now, this feature of so arranging the attaching means that the lift may wear to the maximum extent, consisted merely of making those little washers sort of half-moon shape instead of using a circular washer. Nearly half of the circle was clipped off. It shows in Fig. 5 of the Tufford patent. And those washers were put in the mold with the straight side towards the margin and thus projected that much less towards the margin than a flat, round washer would, and consequently the rubber would have to wear away that much farther before it exposed any of those washers. That, I think, is rather a trivial matter. I don't know whether it is still embodied in the commercial heels made under the Tufford patent or not. I do not think it has been of any importance in any of the litigations in reference to the Tufford patent.

Then the specification says:

"Another aim of the invention is to so arrange the attaching means that they will be located relatively remote from the edge of the heel lift, whereby the lift may wear to the maximum extent without exposing the same."

That aim, I think, is nothing that is characteristic of the Tufford construction. It is characteristic of any concavo-convex heel, including the old heels that Tufford recognizes had been composed before—that the fastening devices may be farther in from the edge than on a flat heel. If a single fastening was driven down in the middle of a concavo-convex heel it would hold practically the whole of the rubber heel firmly against the shoe heel because of the stress of the rubber itself. With a flat heel, of course, if it were fastened merely at the middle there would be nothing to directly hold the marginal parts against the heel of the shoe, and consequently the rubber heel would pull up away from the shoe heel and it would appear to be very insecurely fastened. Dirt would probably work in under it and it would be completey separated. Consequently, flat heels are al- [fol. 114] most always fastened by a number of nails distributed around the margin, and not very far in from the outer edge of the heel. Concave heels, or concavo-convex heels, however, are commonly fastened by a group of nails, some of them directly in the middle and the others distributed around, and possibly farther from the margin than those that are used in a flat heel. So far as that feature is concerned, I do not understand that there was anything distinctive in the Tufford patent as contrasted with other concavo-convex heels.

The Court: The distinction as between the concavo-convex heels and the flat heels was only one thirty-second of an inch.

The Witness: I think it is entirely unimportant as they are applied today, and I think undoubtedly in a concavo-convex heel they can be left a great deal farther from the margin and work satisfactorily than they could in the flat one. The patent speaks two or three times—one or two passages I have read referred to it, and then it is referred to again—in this way:

"The invention has another object, to so form the concave upper side of the cushion lift that when the lift is subjected to pressure any tendency for the edge portion of the lift to crowd beyond the sides of the shoe heel will be counteracted, and there will be equally as great a tendency for the material of the lift to crowd or compress towards the center thereof."

In the opening statement in the specification it says in substance that a flat heel will under the pressure which I understand is the pressure incident to wear—the weight of the foot—tend to spread or squash out beyond the heel to which it is attached. It says: "As a consequence, after the elastic or cushion lift"—that is the flat one—"has been applied and the shoe has been worn for a short time, the pressure to which the cushion lift is subjected will result in its edge portions being projected or spread to a greater or less degree beyond the sides of the shoe heel, proper, presenting an unsightly appearance," etc. That is a phenomenon that I have never been able to find myself in any flat heel. I can conceive of one that was poorly [fol. 115] made, a kind of soft, half-baked dough, that did not get to the proper condition of rubber, which might perhaps gradually squeeze out or squash out beyond the sides of the shoe heel, but I

never saw it happen. At any rate, the way in which the Tufford patent describes that he overcomes such objection, or one way, he says: "The result last mentioned"—that is, of preventing such phenomenon—"is accomplished in part by forming the concave side of the lift with a number of separate and distinct concave areas which, in fact, constitute a plurality of suction cups co-operating with the under side of the shoe heel when pressure is applied, and inasmuch as these concave areas are separated from each other, the expansion or spreading of the portion of the lift of which they constitute the surfaces will be accommodated so as to secure the result aimed at." That is, this function of preventing the spreading, the squashing out of the edge of the rubber beyond the edge of the leather part of the heel, he says is attained by that little grooving that appears on the inner surface of the heel, well shown in Figure 4 of the patent.

The Court: Let me see what you mean.

The Witness: What?

The Court: Let me see what grooving you mean. I don't know as I recall. I didn't know there was any grooving [examining heel]. Oh, that thread?

The Witness: That one there.

The Court: You don't believe that, do you?

The Witness: What?

The Court: I say, you don't believe that, do you?

The Witness: No; certainly not.

The Court: I don't.

The Witness: I think it is just about as much poppy-cock as the rest of the things they say about this heel.

The Court: That is an overstatement.

The Witness: What the patent describes, however, is that that spreading is prevented in part at least—and that is the only way in which he describes it later in his specifications—by that grooving [fol. 116] which he says divides that face up into a number of separate sections, then when there is any tendency of the surface to spread under pressure the spreading in each of those areas will be toward all its edges; consequently, instead of getting the whole spread carried clear to the margin, to the edge of the heel, part of it goes inward and is taken up by those little grooves. That is, they are like——

By the Court:

Q. 3. It is the retractive force of the rubber that holds it in place, isn't it, keeps the edges from spreading?

A. Yes; it is simply because it is a solid and there is not pressure enough to make it really flow.

Q. 4. Well, in its form, its form is such as to cause it to draw in?

A. No, I don't think that—

Q. 5. When the pressure is released? The pressure would tend to push it out; when it is released it tends to draw it back?

A. Yes, I suppose a concave one if it could work up and down as it came up from the surface,—if it could do that it would draw in. But when it is on the heel of course there is no working of that up and down from the concave to the flat shape. It is held right down permanently flat on the heel.

Q. 6. But the stress of the rubber is that way, isn't it? The stress of the rubber is inward?

A. The stress of the rubber is principally transversely—that is, towards the face of the heel, and in flattening it the inner surface is to some extent under tension and tends to contract in resuming its shape, and the outer surface is put under compression and tends to expand. But, I was going to say, these little grooves as he describes them are like what they call expansion joints when they are laying a concrete pavement, for instance; in order to prevent the expansion from running a long distance and consequently bulging the pavement up, they make it in separate blocks with just a slight space, perhaps a quarter of an inch, between them; then the expansion of each block simply goes into that little space and they don't crowd against one another and lift up. That was the old theory in laying railway rails too, that you had to leave a little space between the heads of each rail so in hot weather they would not buckle and lift, [fol. 117] and apparently that was the theory on which that particular function was claimed in this Tufford patent.

The Court: I saw an example of that last summer. They were repairing the street railway in the city of Manchester and they took it all out but the rails, and they had very intensely hot weather come along and it buckled those rails and threw them straight up—great big rails.

The Witness: Yes. Well, of course if there were anything to it the mere size of those little rings in there is not so absurd, because they are about all that would be needed for expansion joints of that kind. Their depth is not enough to amount to much; they are merely superficial, a scratch, so to speak, and if there were anything to it they would want to go pretty well up into the body of the rubber, I should think. But I don't think that either that or the shape of the washer is of any consequence at all, although it is described in the patent as of as much importance as anything else, apparently, or as extensively as anything else. It is possible that this non-spreading function we have just been considering may depend to some extent, at any rate, on the special concavo-convex in all directions shape of the Tufford heel. By reason of that shape, when the Tufford heel is applied to a shoe heel and pressed down it first bears on the shoe heel only at the extreme rear or convex edge and at the two breast corners. Then after it is pressed down quite a little way it bears all along the curved edge of the heel, the contact gradually extending from the two points on each side that originally contacted along the entire length of the side.

By the Court:

Q. 7. At that stage it doesn't contact with the breast, does it?

A. It doesn't contact with the breast until after the contact has been complete around the sides.

Q. 8. When the sides contact does the breast always contact at that instant?

A. No; not until after. In gradually pressing it down it first touches at the three points, then the contact gradually extends from the convex edge around to the outer edge of the breast, and by the time that is completed the breast is still open. Then a little further compression will close across the breast, and then further compres-
[fol. 118] sion will compress all of the edge against the side of the heel—all the edge of the lift, including the breast. Now, owing to the fact that you get the three-point contact first and you don't get the complete contact along the side until the convexity is partially flattened out, there is less of that transverse spreading of the inner surface across the face of the heel towards the sides than there is in a heel which is concavo-convex only in the transverse direction. Those heels that are concavo-convex only in the transverse—that is, the old shape, the old scoop shape I will call it, because that has been recognized as distinguishing the two types—in the old scoop shape the entire edge, the entire convex edge, rests against the edge of the leather at the start before there is any distorting compression at all; and consequently when the distorting compressing begins——

Q. 9. You mean the entire concave edge?

A. The entire convex periphery, I meant to say, the outer periphery of the heel. I was not speaking of the face. The entire convex periphery, excluding the part that goes across the breast.

By Mr. Emery:

Q. 10. You mean the upper side edge? Is that what you mean?

A. The upper side edge or the outline of the contacting face is perhaps best—the outline of the contacting face is all in contact with the rubber and consequently when the distorting pressure begins that inner face begins to spread immediately and there is considerably more spreading or crowding out beyond the face of the heel than there is in the Tufford shape which is concavo-convex in all directions. That, I think, is apparent simply on squeezing them down. There is as much expansion or outward projection of the edges in the Tufford or saucer shape as there is in the scoop shape, assuming an equal amount of convexity in flattening either one; but in the Tufford or saucer shape a considerable portion of that expansion is done before it gets in contact with the face of the heel, and consequently the amount of spreading actually on the face of the heel itself, or over the edges of it if its is a little larger, is considerably less with the saucer shape than it is with the scoop shape.

Another function that is indicated in the Tufford patent is that
[fol. 119] of effecting a suction between the lift and the surface to which it is applied, and I think that it probably is inherent in the same feature that gives that suction that there is also given a more uniform pressure, a more equal pressure, of the rubber lift against the heel entirely around the periphery, including the breast edge. And that function, especially that of giving pressure across the breast edge, is, I think, what has been regarded as most important

in the litigation that there has been with reference to these rubber heels.

In the lift of the Tufford patent, by reason of its being concavo-convex in all directions—that is, in the longitudinal direction as well as transverse—when the heel is flattened out by pressure the breast edge gets to the surface against which it is compressed before the flattening is completed, and consequently as the flattening goes on and is completed that edge is more or less sealed, but the air being trapped under the convex part is crowded out and the seal remaining secure all around the edge of the lift, when the pressure is removed the air cannot get back and consequently the lift is kept down by atmospheric pressure or sucked down against the surface. That is a very characteristic phenomenon in connection with the saucer-shaped heel which originated with the Tufford patent and is very apparent when it is applied to a flat, smooth surface. I never have seen one stuck to a surface such as would be on the actual heel when one of these was applied by a cobbler, and I don't believe it could be, because the surface is too rough and uneven to make an effective air sealing; but it is a very pretty experiment to try on a piece of plate glass or on a smooth top desk or anything of that kind.

Now, the scoop-shape form does not exhibit that sealing effect, or, if so, it is only very slightly. There being no true concavo-convex in the longitudinal direction, or at *at* any rate the breast edge being completely arched up away from the surface to which it is pressed, the breast edge does not get pressed firmly against the surface in the act of flattetning out the heel. It really makes contact with the surface only by the time the heel is completely flattened out or very nearly so, and in the final complete flattening there is [fol. 120] practically no intensifying of the pressure of the lift towards the heel across the breast edge.

By the Court:

Q. 11. The breast edge bears substantially the same relation to the heel that the flat heel does?

A. Just about the same as a flat heel. I don't think there is any practical difference at all, so far as what you might call breast sealing is concerned, between a flat heel and the ordinary scoop-shaped heel or any heel that does not have a special raised part along the breast face raised higher than the part back of it. Consequently that breast sealing or intensifying of pressure across the breast is due to the shaping of the Tufford heel, concavo-convex in all directions, as contrasted with those which are concavo-convex only transversely and are not completely so in the longitudinal direction.

Perhaps I probably might add that I understand that that distinction has been regarded as an important one functionally between the two shapes—the saucer shape and the scoop shape—that is, that the saucer shape does seal across the breast intensively or to a greater extent than a flat heel would, while the scoop shape does not seal across the breast. I might add further, if it is not objectionable, that I understand that while these various shapes may run into one another as you might have more or less longitudinal

convexity, the line has been drawn between what is concavo-convex in all directions, that is the saucer shape or characteristic Tufford shape, and that which is not concavo-convex in all directions, or the scoop shape, by ascertaining whether or not when the upper edge or upper points of line of contact of the heel are horizontal, as it would be if the heel were applied to a horizontal leather heel, the distance when it is applied and is unstressed, the distance from the horizontal surface to which this is applied to the middle of the breast is greater than the distance from the horizontal surface to any point in the concave surface back of the breast. In that case it is true scoop-shaped and there is no material sealing. On the other hand, if the distance to the middle of the breast is a little less, or is less than the distance to any point in the concave surface of the rear end [fol. 121] the heel is to that extent saucer shaped and does embody the concavo-convex form in all directions to that extent. That is simply used to draw the line. Of course, there would be practically very little difference when one was a thousandth of an inch higher or lower at a point back of *say* thirty-seconds of an inch, at a point back of the middle of the breast. But I understand that it has been practically held or found that if it is higher it is not the Tufford patent—that is, if it is lowest at the middle of the breast and higher at every point back of that, even by only a very small fraction of an inch, it is not the Tufford form. On the other hand, if it is higher at the middle of the breast than at some point back of it, even by only a very small amount, that is Tufford, because to that extent, it has the breast function.

Q. 12. If it were perfectly level, would you call it scoop shape or saucer shape?

A. I shouldn't call it either; I should call that flat.

Mr. Brown: If the court please, I should like to interrupt the answer of the witness, and I should submit it is not material for him to testify in regard to the decisions of the court and the positions of the court in various preceding cases.

The Court: He stated it favorably to you, didn't he?

Mr. Brown: I really didn't notice, your Honor.

Mr. Varney: I think Mr. Livermore always gives the other side any benefit of the doubt in his mind.

By Mr. Varney:

Q. 13. You have referred, Mr. Livermore, to the functions stated in the Tufford patent in suit of not crowding beyond the sides of the heel. Is there any single feature of the heel, the Tufford heel, to which that is due, with the exception of the little scratches or rises in the upper face?

A. None, so far as I can find out. There is nothing else described. The only other features along that referred to would be that action which I described of there being less distortion of the rubber after the sides have made contact with the leather with the saucer shape than there is with the scoop shape.

Q. 14. That single feature is called in the patent being con-
[fol. 122] cavo-convex on either line of cross-section?

A. Yes, that is what I understand saucer shape means.

Q. 15. I referred to that, because my friend, Mr. Brown, does not wish "saucer shape" and "scoop shape" to be used. They were used by the court.

A. All right. I say, I only use "saucer" as an abbreviation for concavo-convex.

Q. 16. You also referred to the function of suction. What is that? Is there any single feature in the Tufford patent to which that is due to?

A. That might be answered either yes or no. It is a single feature to the extent that it does depend on one matter of form, distinct matter of form, namely, the curving up at the breast edge.

Q. 17. That is what the patent also calls concavo-convex on either line of cross-section?

A. That is part of it. Of course, it is due to the entire concavo-convex form, which means not only curls up towards the breast but curls up all around, but that particular sealing action is due to the fact that it curls up towards the breast whereas the others only curl up towards the rim of the periphery.

Q. 18. In respect to the function of uniform sealing pressure around the entire margin which this patent speaks of, to what is that function due?

A. Due to the same thing, concavo-convex in all directions, and irregularly to that part of it which means curling up towards the breast edge.

Q. 19. If I understand you rightly, these functions that you have been talking about are the result of that concavo-convex form on either line of cross-section?

A. Yes.

Q. 20. They do come from that?

A. They do come from that; yes.

Q. 21. If they were taken away why, then, they would all go?

A. Yes.

Q. 22. I show you the exhibit marked "F, Defendant's Present Heel," and I will ask you if you are able to demonstrate to the court what the marginal pressures are upon that heel when it is deformed or flattened out?

The Court: Let me get what the exhibit is.

[fol. 123] The Witness: It is defendant's present Tite-Edge heel.

Mr. Brown: I desire, if the court please, to record an objection to that testimony as we recorded heretofore, that being one of the heels which is not involved in the case, and recently manufactured by the defendant.

The Court: You don't complain of this heel?

Mr. Brown: It is not involved here in the case at all.

The Court: It is used in illustration, I suppose.

Mr. Varney: I should like to say something about that, your Honor. I was going to refer to it later in my argument, but we

think whether or not it is pertinent on account of being charged as an infringement or not being charged as an infringement, it is certainly pertinent to another branch of the case. This identical heel might not have been made until yesterday, as Mr. Emery says, but it is the form of heel that we have been manufacturing since before this suit was commenced. I don't care whether you take this particular heel or some other heel which has a perfectly flat upper surface parallel with the plane.

The Court: You think if you had to go into an accounting they might cause you to account for the manufacturing of this heel?

Mr. Varney: No, your Honor. Here is our point: They don't want to settle their entire score with us; they don't want to contest this phase of the situation. We would like to compel them to do that, but we come into court with this evidence that has not been brought to your attention yet. In 1919, October, the Court of Appeals handed down, in the Sixth Circuit, a decision in the case of United States Rubber Company. Before that time the defendant had been manufacturing such heels as you see in Plaintiff's Exhibits 1 and 2 of A and B series heels.

The Court: Yes.

Mr. Varney: At that time the defendant thought if it made the upper side edges in a single plane it was outside of the patent. That is what Judge Anderson thought in this court, and indeed the court in the Sixth Circuit said that that question was a serious one. It actually said that.

[fol. 124] The Court: They didn't construe the claims very closely.

Mr. Varney: Nevertheless, it said it was a serious question, and Judge Anderson perhaps might not have been correct; but, however, he thought the defendant's position was correct. The point is that the defendant's good faith—we think that that illustrates that the defendant could have thought that—could have taken that position in perfectly good faith, that is, it didn't want to be an infringement. Directly after that decision was handed down, the defendant, as the evidence shows, concluded that that heel was not a safe one to make. It did just what any other defendant who was acting in good faith would do; it commenced to change its molds right there and then, and it had its molds all changed long before this suit was commenced. It never afterwards made any molds which were capable of putting out any other heels on any other form than this form, and that is the situation from that time, prior to this suit, down to today.

Now, if my friends on the other side don't want to contest that phase of the infringement, then why are we here? Has the plaintiff any right to come into this court of equity and ask for injunctive relief? Is it any case for injunction when that is the situation? I don't mean that when a defendant ceases to infringe he thereby takes away a case for an injunction. The cases say he must do more; he must, after he discovers that he is within the patent, or has reason to believe he is within the patent, he must change, and he must do so in good faith. But if he does that in good faith and

he is not infringing at the time after he has ceased his infringement, and there is evidence that that stopping is done in good faith, then the court says there is no cause of action in equity.

Now, then, what I would like to show, I would like to argue that question—in fact, I presented all the arguments I have, but I would like to leave a brief of authorities on it with your Honor before the end of this case. I don't want to go into this evidence on my later argument, but in order to make out my case I have to show that this heel that we are now making is outside of the patent. If I show [fol. 125] that, I have made out my case. In other words, this objection that is now put in is that the plaintiff does charge this heel as an infringement, and we cannot draw it in and have it adjudicated. Now, if I assume that the court, therefore, could not consider whether or not it was an infringement because it was not so charged in the bill, why, I should still assert that the court has a right to consider whether or not this is an infringement in order to determine whether or not our contention that we are not infringing when this bill was brought is true or false, and for that reason I would like the court to consider this as part of this case.

I might add that the same question came up before Judge Brown in the Providence case, and Judge Brown said that the court was not so impotent as to be unable to pass upon a device which the defendant brought in, and he thought it ought to be done, and he did it.

The Court: Your contention amounts to this: On the question of injunction, at the time the bill was brought and they asked for an injunction, you were not manufacturing the article they charged you with infringing, but manufacturing another article infringed?

Mr Varney: Absolutely no. Not only that, your Honor, but we didn't have anything in our shop with which to manufacture it, and we had spent $25,000 for new molds, and we never had a mold to mold these heels with that they now bring in to us and say are infringing heels and are concavo-convex on every line of cross-section. We have only made heels that are within the decision of the Sixth Circuit, passed down in October, 1919, when we commenced to change these heels around concavo-convex on every line of cross-section. We would like to have that question settled, and we insist if the plaintiff does not want to settle it in this case he should not be here; that is, he cannot come into equity.

Mr. Brown: If the court please, I don't care to argue the matter at any length upon the present state of the record. If Mr. Varney has more testimony to put in upon this point it would seem to me it would be proper to take up the argument upon that question after the testimony is in, but I want to reserve our rights in this matter. [fol. 126] It obviously is not proper proceeding for the defendant to bring in a special heel. We do not know anything about its make; we haven't any information about it at this time, and for him to attempt to have that adjudicated when we haven't had any opportunity to examine it, I don't know whether we would contend it is infringement, or not, or whether it is the only kind of heel that they have made, so that we desire simply to record our objec-

tion to that on that ground. We have found the heels which the defendant manufactured, and until now we had supposed that they were continuing to manufacture. At any rate, the delay since the time when we put in these heels has been due to matters over which we had no control, and we must, I submit, continue this case upon the status that existed at the time when the bill was filed.

Mr. Varney: I should like to correct one thing Mr. Brown has said. That heel that Mr. Livingston has is marked as an exhibit to a deposition taken two months ago. That heel was put in at the time of taking that deposition of your own witness, and Mr. Richey asked me if I would give him duplicates of them and I did, and he took them away with him.

Mr. Brown: When Mr. Tucker was examined?

Mr. Varney: Yes.

Mr. Brown: That is something I did not know about. I never have seen the heel before yesterday.

The Court: Well, proceed with your cross-examination, and I will give you an exception.

A. Defendant's present Tite-Edge heel is one that I should describe as being functionally like the scoop-shape heels that have been considered. Actually it is very slightly convex on the outer tread surface, and it is flat on the inner surface across the major portion of the inner surface, but surrounded by an inclined ridge that makes the heel thicker around the curve margin than it is at the edge of the flat-bearing part. Functionally that amounts to the same thing as being concave transversely, and I should say that the heel was properly enough described as concavo-convex in the transverse direction, but not in the longitudinal direction. In the longitudinal [fol. 127] direction it runs out absolutely straight at the breast, and is practically the same as a flat heel so far as any breast heel pressure is concerned, and practically so far as any matter of form is concerned.

To show where the pressure comes I have placed it against a heavy plate glass plate, and have applied to the outer tread face a plunger or die having a number of studs that correspond to the nail holes, and go through the nail holes of the rubber and engage the washers inside of the rubber as the nails would, so that when that pressure plate is forcibly pressed towards the rubber it as nearly as possible simulates the distortion of pressure that you get from the nail heads, and I have a clamp screw to tighten it up and the pressure is applied. I have dampened the rubber a little. The curved part of the margin evidently shows contact when flattened out. Now, it is flattened down so that the points underneath the washers indicate that there is some little bearing, but our cross heel part, there is practically no pressure, and it still is open. There is some contact in the middle which shows across there [indicating]. That is down as tight as it could be. There is certainly, in that construction, no provision for breast sealing, whatever, and it is practically on a par with the ordinary flat heel so far as any sealing across the breast is concerned.

Q. 23. Will you similarly demonstrate to the court with an I. T. S. heel—with a plaintiff's heel?

A. That does not fit the nail holes in the I. T. S. heel that I have here—it fits four of them.

Q. 24. I will get another heel here?

A. It would not effect the operation, at any rate, at the heel end. The pressure plate which I have here to go with the I. T. S. heel has no stud for the nail hole on the convex end.

I did the same thing with the I. T. S. heel, defendant's commerical heel. The pressure head which I have does not have a stud corresponding to the nail in the convex end of the heel. That I don't think affects the showing as to the way in which the pressure is applied. Very slight pressure entirely around and across breast as well as other places that goes on, and still even when down tight it is right around the edges and then through the middle under the washers. The only difference would be, if this plate had the ad- [fol. 128] ditional pressure, the contact spot would show up in the convex end. That is practically down tight, and the same contemplated pressure upon the extreme edge, including the breast edge.

Q. 25. Will you compare these tests with those shown in Plaintiff's Exhibit No. 55, Photograph?

A. I understand that this photograph is intended to illustrate the same kind of a test that I have made, and on the I. T. S. heel the layer of contact does not appear to be so distinct. The U. S. Co. heel shows a line of contact entirely around the margin, including across the breast. The Essex heel also shows that, but it is to be observed that that Essex heel is not like the one I tested a short time ago, because it has a raised part across the breast to obtain that sealing effect. The other figure on the drawing shows what is called the braided tip, or Providence heel. That also reflects contact entirely across the breast, and that had on the face a raised portion across the breast so that, as shown in this exhibit, the Essex heel and the braided tip or Providence heel were both concavo-convex in all directions. That is, they were just as much concavo-convex in the longitudinal direction as they were in the transverse direction, and to that extent differ from the exhibit defendant's present Tite-Edge heel.

Q. 26. Can you produce any diagram showing a comparative difference between any heels which you have compared and considered in connection with preparing for this case [handing witness a diagram]?

A. This diagram shows merely as illustrative outlines several different characters of longitudinal curvatures of the attaching face of the heel. One make, Tufford, shows distinctly a marked concavity in the lengthwise direction, and shows the attaching surface rising towards the upper dotted line which represents the horizontal surface of the heel to which it is applied. It rises clear up to the level of the heel at the toe end and rises quite a way towards it at the breast end. I should say the biggest end rises clear to it at the convex end, and approximately closer to it at the breast end.

The Nerger heel—the outline marked "Nerger" shows one that is not concavo-convex in the longitudinal direction. It simply [fol. 129] rises or curves up towards the line of contact at the convex end of the heel, but is practically fully open at the breast end.

The one marked "U. S. Co." is one that shows a very slight concavity in the longitudinal direction. That is, it shows towards the surface at the convex end just the same as the Tufford, but at the breast it rises only very slightly. It is simply, practically, that it does rise, but to the extent that it rises at all it is like Tufford and unlike Nerger. Nerger does not rise at all, and U. S. Co., as shown on this drawing, does.

The next to the right is the one marked "T. P." and that is not concavo-convex in the longitudinal direction. That rises to the level of the heel surface at the convex end, but falls away all the way from the convex end towards the breast end, and being farthest away at the breast end.

Nerger, perhaps, as shown here, is no farther away at the breast end than it is at the middle, but it does not approach the breast end any. T. P. does not, only approach it, but practically recedes all the way towards the breast end, being farthest away at the breast end.

The one at the extreme left of the diagram is marked "Essex No. 1", and that shows flat with a bevel at both ends, and that is a polygonal shape which is functionally equivalent to a curved shape, and functionally I should say it is the same as the Tufford shape; that is, it shows concavo-convex. It rises clear to the level of the heel at the convex end and rises quite appreciably towards the heel at the breast end.

Q. 27. Not towards the heel?

A. Towards the heel surface, yes, to which it is applied.

Essex No. 2 is not concavo-convex. That is practically straight entirely along the heel except at the convex end. There it rises to a level of the heel to which it is applied. Now, that is angular shape compared with a curve shape and is functional the same as the Nerger.

Going out to the other end of the diagram, the last but one towards the right is marked "United L. & B. No. 1." And that, as I understand, refers, so far as it is material to this matter of [fol. 130] function, the character of outline of the heel of the United Lace & Braid, which was in controversy in Providence before Judge Brown—I was in that case and happen to know about it in that way personally.

The Court: Which is that?

The Witness: L. & B. That is concavo-convex and, so far as straight lines, there is a polygonal function the same as a curve, why that compares favorably with the Tufford construction. In the same way it rises clear up to level at the convex end, and rises quite a distance towards it at the breast end.

The Court: Quite as much as the Tufford does?

A. Practially the same, I think, as far as the breast end is con-

cerned, they operate the same as the Tufford. I think Essex No. 1 does too.

The next is "United L. & B. No. 2." That represents an outline which is not concavo-convex, but simply rises towards the convex end, and does not rise at all toward the rear. That would compare functionally with Nerger, and give no appreciable breast heave.

Mr. Varney: I offer illustrated chart just referred to by Mr. Livingston as Defendant's Exhibit J.

[Illustrated chart referred to by witness marked "Defendant's Exhibit J."]

Mr. Varney: I will ask the court to have the glass plate, clamp and the two studded dies marked for identification as "Exhibit H."

[Glass plate, clamp and two studded dies marked "Defendant's Exhibit H."]

Mr. Varney: That is all.

Cross-examination.

By Mr. Brown:

X Q. 28. Referring to the diagram which you have last referred to, I will ask whether you have examined or considered the second United States Company rubber heels?

A. I have seen that, but I have not considered it in connection with this case at all.

X Q. 29. Do you know what the longitudinal central line would [fol. 131] show on that heel?

A. What I am saying now is hardly what I would call real testimony. It is my impression. I have considered that heel more or less, and I have some impressions about it. If you want them, I am perfectly willing to give them.

X Q. 30. I am simply asking about the central longitudinal line.

A. As I should say, I think there is some question about that. There is some controversy. I doubt if it is agreed by all parties as to what that longitudinal line does represent. That is my impression about it.

The Court: Has that been inquired of?

Mr. Brown: Yes, your Honor. In direct, of this witness?

The Court: What you are asking about, has it been inquired of at all?

Mr. Brown: No, except as to the heels that he has considered, and I am asking about this other heel which he has not included in that chart. He says he has considered it, but not fully.

Mr. Emery: It seems to me that is as far as it ought to go, as long as he does not have any definite idea.

The Court: I don't know. I don't want to try too many cases here. I think we will shut that out.

X Q. 31. You consider the test that you have made there with the plate, glass and the clamp a test which fairly shows the operation of the heel, do you, under compression?

A. I think that that shows about as well as you can show what the action is, that is, the general nature of the action. It does not give any quantitative effect at all, but I think that shows what the result would be, normally, when the heel was nailed to a flat surface, so far as pressure on the heel against that flat surface was concerned.

X Q. 32. If the breast edge is shown in contact while still there is an area back of that breast edge which is not in contact, there would then be sealing of the breast edge, would there not?

A. Do you want my own judgment about that? I don't think that that follows.

Mr. Emery: Just let the witness answer.

Mr. Brown: I think he has answered.

X Q. 33. Have you tried other heels of the defendant than the [fol. 132] one which you submitted here with your test?

A. Yes, I think I have.

X Q. 34. Did you try any which show a contact with the breast edge?

A. No; didn't find any.

X Q. 35. What size heels did you use?

A. I think probably the same size as this exhibit because I used the same plate to represent the nail pressure.

X Q. 36. Do you know the defendant makes heels of different sizes?

A. Certainly. I think that I didn't make any special mental note of this to testify to, but my own impression is I have handled a number of different sizes and tested them out by my fingers, pushing them down and so on, and I am perfectly satisfied in my own mind that there is no sealing pressure in the regular defendant's heels.

X Q. 37. Did you try the heels which are in evidence?

A. No, I don't think I did,—this exhibit.

X Q. 38. You took the heels that were submitted to you, did you, for this test?

A. In a sense, yes, but we sent out to a supply shop here in town and got two or three pairs. I wanted to see what they were like on the market. They were not selected with reference to this test at all, or to any test.

X Q. 39. But the only ones that I understand you to say you submitted to this test were the No. 7-W size?

A. I think they were the only ones I tried with a clamp and a glass plate. My only reason for that is, I say, that was the only plate we had. I might have had a larger plate and tried a larger one, but I don't recollect it.

X Q. 40. What causes a concavo-convex to adhere to the glass plate, as you have stated it does?

A. It is not adherent; it is really air pressure. With any surface, if you can exclude the air from between them, why, the air pressure will hold them together. Take two flat plates, like that plate of glass, if they are very accurately made, and rub them together so that the air is excluded, it will take quite a force to pull them apart, probably more than in this case here, because there is nearer a perfect vacuum. The reason some heels stick easily and others do not [fol. 133] depends largely on the accuracy of them sealing around the edge, that is, accuracy and completeness. The I. T. S. sticks very easily. You can almost hardly press them to the surface at all. They don't stick to it. That has a smooth surface; that is because the entire margin presses quite uniformly against the surface, and when you carry on the pressure the air will crowd out, and when you relieve the pressure and the air tries to get back it is dammed out all around the edge.

The Court: Even in that heel, it depends upon the age of the rubber and the size of the heel, somewhat?

The Witness: Sometimes it depends somewhat, but the I. T. S. heel almost always will do it. The scoop shape, you can make them, if you want them to do it, but if you don't want them to do it it is pretty hard to make them.

X Q. 41. What does that indicate?

A. It indicates that there is not a complete sealing around the edge, that there is a weak spot where the air very easily gets in, and it may be that even if they were sealed the pressure of the air holding that down, even if you have a perfect vacuum—it is only 15 pounds to the square inch, and then you have a small area near the edge, if the pressure back of it does not hold it out the air pressure may be less than the resistance of the lighter air so it won't come out anyway.

X Q. 42. Referring again to the heels that you have examined and of which you show the longitudinal central lines on your chart, are you able to say from your tests that a heel, rubber heel with a low point at the breast edge, at the center only, but with the points everywhere else except at the center of the breast edge higher, would operate as the Tufford heel which you have referred to?

Mr. Emery: I object to that question. No such heel is in the case. I don't see how it is illuminating.

The Court: I don't know, unless he is trying to state the Nerger heel. Perhaps I don't get the question.

Mr. Brown: He has shown a number of heels that he has tested in connection with this, and has shown the longitudinal central line. I am asking him as to the mode of operation of the heel which has [fol. 134] the low point at the exact center of the breast edge and, in every other part of the heel the surface back of the breast edge is lower than at the breast edge. I am asking him whether that would have the mode of operation of the Tufford heel.

The Court: From every point back of the breast edge is lower than the breast edge center point?

Mr. Brown: No. At the center point there is one low point, but at every other spot the breast edge is higher than at the back.

The Court: That is so in the Nerger mold.

Mr. Brown: No, your Honor.

The Court: Where it rises on the sides?

Mr. Emery: If Mr. Brown will point out any heel in the case that embodies that, I think it would be illuminating.

The Court: You mean any point here straight back [indicating]?

Mr. Brown: Yes, your Honor.

The Court: These points are higher?

Mr. Brown: All higher except at the exact center and single line. You see his diagram simply gives longitudinal line there. Now, I am asking him whether with a low point at the precise center of that breast edge it is sufficient to take it out of the operation of the Tufford heel.

The Court: Do you want him to con-true the patent to that extent?

Mr. Brown: It is a question of mode of operation.

The Court: You mean whether it will work one way or work the other?

M. Brown: Yes.

The Court: You may ask him that.

Mr. Brown: That is what I intended to confine the question to, the mode of operation.

A. As I understand, the question means something like this: Suppose the heel right at the middle of its width did not rise at all towards the breast, but at every other point across the width of the breast it did rise towards it, that is, it would be like defend-[fol. 135] ant's present heel if made with a rising edge across the breast, like that, except just at the middle there was a little notch or low spot like the whole breast edge in the actual exhibit; such a one, if the test were holding water for instance, would not hold it because it would run out of a notch just as easy as over the whole lip.

X Q. 43. You remember that I said it was a line?

A. I understand.

X Q. 44. And a point?

A. I understand that.

X Q. 45. Would water run——

The Court: Let him answer his question.

Mr. Brown: All right.

A. I was only trying to get at what the thing is.

The Court: Trying to find out what you are going to answer?

The Witness: Yes. I understand it means that right in the middle the tread face or the attaching face is not built up to the breast at all except at the middle end towards the sides it is built up, so to speak, or rises about the general concavity back of it. I should say, so far as the breast sealing, or as making an extenuated pressure across the breast as compared with a flat heel, that that did embody the Tufford function or mode of operation because it would embody practically that for almost the entire length of the heel breast, and the

fact that it was just a small space at the middle where there was not any extenuated pressure, I should say was not very material. That is, as a matter of terms it would not have uniform pressure all around, or intensive pressure all around, which is what I think possibly the Tufford patent indicates, but it would have it all except at a very small place in the middle of the heel, and unless there was some reason that it could be shown by making that small rise, I should say the two perhaps are, and get that intensive pressure all around.

X Q. 46. Then when you have referred to the form of the heel by reference to the central longitudinal line you really have in mind, have you not, that it is after all the mode of operation which is the controlling factor and also the result of sealing?

A. That is what I had in mind when I was discussing the diagram all along; yes.

[fol. 136] X Q. 47. So that there may be immaterial changes in form so long as the mode of operation characteristic of the Tufford heel and the result of that heel is secured then that would realize that mode of operation and result. Is that correct?

A. It seems to me that is sort of a statement of fact. If it does have the same result it amounts to the same thing. If it has the same mode of operation and the same result, I would say it was practically the same thing.

X Q. 48. As the Tufford heel?

A. Yes.

X Q. 49. Notwithstanding some changes in form?

A. Oh, yes. I should never question, for instance, any difference due to the fact that one was a curve and the other was polygonal shape, that is, made up of a number of short straight lines, as long as the polygonal shape was evidently designed to get the same effect as a curve, and did get the same effect, I should not say the difference was material.

By the Court:

X Q. 50. The character of heel that you are undertaking to define in answering his question was a heel more like one of the defendant's that they complain of as infringing, with a small notch at the center of the breast?

A. Yes. If I can take one of those I could show what I meant.

X Q. 51. I only wanted to get it into the record to show what you meant?

A. Yes.

X Q. 52. That is what I understood you to mean?

A. Yes. This exhibit, the present Tite-Edge heel, had an inclined flange across the breast, similar to the one around the curved part.

X Q. 53. Yes.

A. But just at the middle of the breast it was omitted or left out and leads down to a flat surface. That, I understand, is what he is inquiring about.

By Mr. Brown:

X Q. 54. You have referred to the Nerger heel which you have examined. Is the Nerger heel one in which there is a low point simply at the central medial line at the breast edge, or does that low point extend transversely—that area? Is it a line on the breast edge or a point?

A. The Nerger heel has been a matter of a good deal of controversy, [fol. 137] too, I think, and I don't know what you mean. The only thing I have referred to is what was shown on that diagram as Nerger heel.

X Q. 55. But that only shows——

A. That only shows the central section. I have seen the Nerger patent which I suppose is the only basis we have to go by as to what the Nerger heel was, and that, I should say, was that the breast was as low as at any point at the rear of it all the way across; that is, if you took parallel fore and aft lines anywhere across the width, take first one in the middle, there is no place back of the breast that is any lower than the breast, and the same would be true of every one of these lines; there would be no place back—in other words, there is no dipping back at all from the breast towards the middle of the heel.

X Q. 56. And the Nerger heel that you refer to as having seen had a plate, had it?

A. I didn't refer to having seen any Nerger heel.

X Q. 57. I understood that you had examined the Nerger heel and that this diagram showed——

A. No; I simply read from the diagram. That says "Nerger" and I said what the diagram was. I have seen heels that I should say were Nerger heels; I have seen them with plates in them and without plates in them, heels that I should be perfectly content to identify as being substantially the heels shown in that Nerger patent. I think that very one there, that heel there, is, as far as I can see, practically the heel in the Nerger patent, although I think it has not a plate in it.

X Q. 58. That is, you are referring simply to the form of the Nerger heel?

A. No—well—I think form is all there is to it, as far as that is concerned; that is, substantial form, the concavo-convex form, the transverse shape, so as to give the tight-edge fit.

X Q. 59. Do you think the form is the only thing there is in the heel of the Tufford patent?

A. Practically so. It is those characteristics of form that give that action.

X Q. 60. And wouldn't you say that the material also is an important factor?

A. Oh, of course they are all rubber heels to that extent and they are all presumably not hard rubber; they are flexible rubber.

X Q. 61. Then you say that the material is a factor in the con- [fol. 138] struction of the heel?

A. Why, of course it is. That is, it is not a rubber heel unless it is a rubber heel.

X Q. 62. Then a heel which is made of leather, but exactly of the form of the heel of the Tufford patent, would not embody the invention, would not have the mode of operation and result of the Tufford heel, would it?

A. I don't know about that. That brings in still another question as to the equivalence of material. Leather might work the same as rubber does. I don't understand that it is limited necessarily to rubber or any particular composition of rubber, but something that has the same nature that rubber does and responds to these actions, is flexible and elastic, holds its elasticity.

X Q. 63. Something that has the same mode of operation and secures the same result?

A. Yes, so far as the result from straightening out a curved thing.

X Q. 64. Just as the differences in form may not take it outside?

A. Certainly.

Mr. Brown: That is all.

By the Court:

Q. 65. You have got to have the general form in order to get the function, haven't you?

A. Yes, I should say that form is essential to the extent that is a concavo-convex form; that is, it is a form that curves or inclines or trends up towards the margin of the heel from the middle part. But I mean whether it is one curvature or another, whether it is curved or polygon, I think if you take the word "trend," it comes perhaps as near as anything. It is on a definite specific form as long as it has that general characteristic of form.

Redirect examination.

By Mr. Varney:

Q. 66. Will you state whether you have examined the exhibit Defendant's Mold? It is Exhibit G.

A. I have simply looked at it here in court.

Q. 67. You have not measured it to see whether——

A. No, I have not measured it. I only looked to see what seemed to be the construction of it.

Mr. Varney: That is all. The defendant rests.

[fol. 139] **Evidence for Plaintiff in Rebuttal**

J. G. Tufford (recalled).

By Mr. Richey:

Q. 24. Mr. Tufford, I show you an O'Sullivan heel that was shown to Mr. Slough yesterday and concerning which he was examined.

Will you state if this is the kind of O'Sullivan heel that was being made before your heel was placed on the market?

A. When my heel came on the market the nails were up close to the edge on all O'Sullivan heels and all flat heels. There appears to be a little margin around this heel. The O'Sullivan heels when mine came on the market were flat and for a year or two afterwards were flat, with the nails just as close to the edge as they could get. But I understand that the factories give them certain nail arrangements to comply with now, in order to attach them.

Q. 25. Cement is used with this heel?

A. Cement is used with this heel; yes.

Q. 26. Mr. Tufford, what is the effect of a metal plate in a rubber heel?

A. A metal plate shortens the life of the heel; it is not so resilient, and if the heel is caught or bent up it opens up the seam permanently; you can't get it back again; you can't hammer it back with a piece of rubber in under it unless you would remove the heel and take the kink out or put in a new one. Plate heels have never been a success. There have been several on the market, but they never have amounted to anything.

Q. 27. What effect does the plate have upon the hardness of the heel?

A. It makes the heel more solid; it is not as resilient; no cushion; not as much cushion as it would be without it.

Q. 28. Is it very much improvement over a leather heel?

A. Well, not greatly; no. It is quite stiff from the plate running all through it.

Q. 29. How does it affect the trimming area?

A. The plates that I have seen come very close to the edge and would not leave very much trimming edge.

Mr. Varney: May the court please, is this evidence material?

[fol. 140] The Court: What?

Mr. Varney: Is this evidence material? We have not questioned the practicability of the Tufford rights; we don't question the validity. We have not put in any prior art. We have simply introduced the file-wrapper.

Mr. Brown: You introduced the Nerger patent.

Mr. Varney: No; we simply introduced the file-wrapper. We don't care whether Nerger was made use of or not—whether there was an successful industry based on it.

Mr. Richey: That is all I have to ask this witness.

The Court: That ought to be satisfactory then.

Mr. Richey: Do you want to ask him any questions?

Mr. Varney: No.

R. GRIFFITH (sworn).

By Mr. Richey:

Q. 1. Please state your name, age, residence and present occupation.

A. R. Griffith; age, forty-six; residence, Akron, Ohio; general factory superintendent, Miller Rubber Company.

Q. 2. How long have you been engaged in the manufacture of molded rubber goods?

A. About twenty-two or twenty-three years.

Q. 3. Does the rubber article cast in a mold always conform to the shape of the mold cavity after it is removed?

A. The rubber shrinks to some extent and varies a little from the shape of the mold, although it substantially has the size and shape of the mold.

Q. 4. Is the shrinkage uniform?

A. That depends on the compound of rubber used and the manipulation of rubber throughout the fatory. It varies to some extent.

Q. 5. Did you go on the street yesterday afternoon and buy some Essex Tite-Edge heels?

A. I did.

Q. 6. From whom did you buy them?

A. I will have to refer to my notes. [Referring to a paper.] S. Perkins & Brothers, 101 Union Street; Ranno-Speirs Company—I haven't the address; it is the same street; Samuel Lebow Company, 16 Washington Street.

[fol. 141] Q. 7. What did you do with them?

A. I delivered them to Mr. Slough.

Mr. Richey: That is all.

Mr. Varney: No cross-examination.

Mr. Emery: Just a moment. Where are the heels?

Mr. Richey: He says he gave them to Mr. Slough.

Mr. Emery: Can't he get them back?

The Witness: Well, Mr. Slough took charge of them; I don't know what he did with them.

Mr. Emery: Well, just one question.

Cross-examination.

By Mr. Emery:

X Q. 8. What did you inquire for, Mr. Griffith?

A. Tite-Edge heels.

X Q. 9. Is that all?

A. Manufactured by the Essex Rubber Company.

X Q. 10. Is that all you asked for?

A. I asked if I could look at the heels; asked them if I could look at the stock and select what I wanted, and I found heels of all sizes and I brought them in.

X Q. 11. How many did you examine?

A. I should say four or five dozen in each place.

X Q. 12. Yes; and how many did you select?

A. Oh, I guess I brought home two or three dozen; two or three dozen.

X Q. 13. And how many did you give to Mr. Slough?

A. Two or three dozen.

Mr. Emery: I see.
Mr. Richey: Is that all?
Mr. Emery: Yes.

FRANK M. SLOUGH (recalled).

By Mr. Richey:

Q. 236. Mr. Griffith delivered to you last night some Tite-Edge heels, did he not?
A. He did.
Q. 237. You have brought some of them here with you?
A. Yes, here are some of them.
Q. 238. Did you nail any of them on boards?
A. I did.
Q. 239. Will you produce those you nailed on boards, with the [fol. 142] boards?
A. I have the boards with the heels nailed on them [producing same].
Q. 240. Did they seal the seam all round?
A. They did and they do.
Q. 241. Will you produce the heels like those you nailed on the boards?
A. Here are the mates of the heels in the original boxes.
Q. 242. Supposing you just explain in your own language the heels and what is shown on the board.
A. May I have the boards and the heels?
Q. 243. Yes. [Boards and heels handed to witness.]
A. These heels are of sizes, ladies' sizes O-F, 4-O, W-C; and men's sizes, 10M and 5M. The ladies' size heels are on one of the boards and the men's sizes on the other board, these five heels with the companion heels forming pairs among themselves delivered to me by Mr. Griffith. The normal form of them before nailing them down can be told by the companions not nailed down. It will be seen that the 10M heel and the 5M heel constituting two of the men's sizes of heels are similar to the 7-W heel handed to me yesterday on the witness stand, but it don't have the raised letters close to the breast in the manner that that heel did. These heels were nailed down on the boards the regular and normal way employed by a cobbler when nailing heels on shoes, just as I nailed or attempted to nail down the 7-W heel on the stand yesterday.
Q. 244. Did you find any of the B type heels among the heels Mr. Griffith brought to you?
A. Yes, I did; quite a number of them.
Q. 245. Can you produce any of them?
A. These heels nailed on the board—you mean the kind like those of Exhibit —.
Q. 246. B?
A. Two, I think it is.
Q. 247. Yes, two.

A. These loose heels in boxes, the 4-O heel—that is a B type heel. This is a B type heel.

Q. 248. Can you tell by the feel of the heel whether they were made recently or not?

A. There are others here. Well, they seem to me to be fairly new heels. They certainly are not very old.

[fol. 143] Q. 249. Now just tell the court what success you had in nailing down the heels that were brought to you?

A. Well, I merely took the nails and a hammer and placed the nails in the nail-receiving openings and nailed them down flat, and I find that these seal the seams all around, including the breast edge, and very well, too; a tight seam all around. The flattened arches are maintained, the edges closed all around, including the breast edges, the side edges, the rear edges.

Mr. Emery: I enter objection at this point, your Honor, to all exhibits used in this fashion that were prepared by plaintiff alone, not in the presence of defendant's counsel.

The Witness: I can nail some of them down now if you wish.

Mr. Emery: I haven't asked you to. I object to these that you nailed in the privacy of your own room.

Mr. Richey: Of course the purpose is to show how they behave after they are nailed down.

Mr. Emery: Of course I understand the purpose. A good deal depends on the way they were nailed.

Mr. Richey: You concede that when nailed they will seal?

Mr. Emery: I don't concede anything.

The Witness: Some of them will and some of them won't. If there are rough edges and if the heels are defective in material, like the one size—that one size, 7–W, was a particularly bad kind to nail down—the raised letters close to the breast. I doubt if one of the Tufford heels could seal the breast at the middle point with raised letters applied so closely to the breast in front of the nails. That is the worst possible size to get a sealing at the breast of any of the sizes that I examined.

Q. 250. Did you find any of the A type or of the type of Plaintiff's Exhibit No. 1 among the heels Mr. Griffith brought to you?

A. Yes, there are a number of them. Here are some of them. Here is one of the A type heels. It has the low point in the middle, the flange all around rising to the edges, including the breast.

Mr. Richey: I offer in evidence the two boards with the heels on them as Plaintiff's Exhibits 100 and 101, and the five heels [fol. 144] identified as corresponding to the heels on the board as Plaintiff's Exhibit 102, and the pair of heels the witness identified as B heels as Plaintiff's Exhibit 103.

[The above exhibits are marked as follows:

Two boards with heels on them, "Plaintiff's Exhibits 100" and "101."

Heels corresponding to heels on boards, "Plaintiff's Exhibit 102."

Pair of B heels identified by Mr. Slough, "Plaintiff's Exhibit 103."]

Mr. Richey: That is all.

The Witness: May I make a statement?

Mr. Richey: Yes.

The Witness: With regard to that question you asked me about the heels and the quality of the rubber and how long they were made, I would just like to state that here, for instance, is a pair of B heels in a box, marked with patent date July 5, 1921. I would say that certainly that pair of heels is not very old.

Mr. Emery: The offer of the exhibits is objected to upon the ground stated.

The Court: The exhibits are received; exception noted.

Cross-examination.

By Mr. Varney:

X Q. 251. What do you call the A heels and the B heels?

A. The A heels are like those of Plaintiff's Exhibit 1; the B heels are like those of Plaintiff's Exhibit 2.

X Q. 252. Yes.

A. I mean, they may differ in size and in color, but——

X Q. 253. Will you look at the A heels, take one of them, one of your samples of the A heels, please?

A. That were purchased yesterday?

X Q. 254. Yes.

A. Here is one.

X Q. 255. What does it say on the top, if anything?

A. "Tite-Edge Essex Rubber Company."

X Q. 256. No; on the other side, the attaching face.

A. "Patents pending

[fol. 145] X Q. 257. "Patents pending"?

A. Yes.

X Q. 258. Now will you look at the B heels and see what it says on the B heels, the same side?

A. "Patented January 14, 19."

X Q. 259. You have expressed an opinion as to whether these heels were recently manufactured or not, on observation. Would the difference in the legends on two series convey anything to your mind in that respect?

A. They are manufactured or supposed to be manufactured under the same patents, or same patent application which later resulted in a patent; I would say that the one marked "Patent pending" might have been made before the one marked "Patented." But still the mold might have been used later, of course. You might make a mold and mark it "Patent pending" and then use it forever, if you wanted to.

X Q. 260. Yes; but we probably would not put "Patent pending" on something that we finally had a patent on? On all the A heels you find "Patent pending," do you?

A. That is so.

X Q. 261. And on all the B heels you find the patent dated 1919, do you?

A. I haven't examined them all, but I will if you want me to.

Mr. Varney: I will say here I think I ought to qualify the admission that I gave you yesterday as to that Troiano patent. Mr. Richey put in the Troiano patent and I conceded that we manufactured under the patent. That is dated 1919. I ought to say that we purchased that patent.

Mr. Brown: When?

Mr. Varney: Well, it does not appear and I cannot say here, but my judgment is about January, 1920. We negotiated for it just as soon as the decision came down in the Sixth Circuit. So I should like to have this noted in connection with my admission that we manufactured under it—namely, this, that we bought it after the patent issued and that as soon as we bought if of course we commenced to mark our heels. So that is all that patent date indicates. It does not indicate that we marked them in 1919 or that we marked them in 1920 or any particular date, but simply that we marked the patent date upon them as soon as we acquired the patent, and we [fol. 146] did not acquire the patent until after October, 1919. So that should be taken in connection with what I have already stated.

X Q. 262. On these heels that you have just produced will you state how the so-called A heels differ from the so-called B heels?

Mr. Richey: It seems to me the heels are the best evidence of that.

A. In form, mode of operation, or how?

X Q. 263. No; in form.

A. In normal——

X Q. 264. Yes.

A. —unattached form. The A heels purchased seem to be—I believe they are of one size, 4-0 women's heels.

Mr. Emery: All white?

The Witness: No; I think *think* there is only one white pair.

X 265. Will you state how many heels Mr. Griffith brought to you?

A. Why, I would say that about—I don't know; there were more than this.

X 266. Well, can't you give some estimate?

A. Oh, I would say he brought about—let's see—I think I could probably. It might have been three dozen.

X Q. 267. Three dozen?

A. I think perhaps so.

X Q. 268. Three dozen out of all that he purchased? I understand he purchased——

A. I think he purchased three dozen——

X Q. 269. Do you understand that he gave you all that he brought back?

A. Yes, he did; I know he did. That is, I am satisfied he did.
X Q. 270. How many have you picked out and brought here?
A. I have picked out two, four—[counting] 34 heels.
X Q. 271. Thirty-four heels?
A. Yes; seventeen pair.
X Q. 272. Seventeen pair?
A. Seventeen pair. I was talking in pairs before.
X Q. 273. Seventeen pairs?
A. Seventeen pairs out of three dozen or four dozen or whatever they were.
X Q. 274. Pairs?
A. Yes.
X Q. 275. Three dozen pairs?
A. I have brought seventeen pairs out of perhaps three dozen pairs.
[fol. 117] X Q. 276. So you have brought half of them—is that it?
A. Whatever it was; I don't know.
X Q. 277. Where are the other heels? Could you bring the rest of them—bring them all in and let us see them all?
A. I think I could.
X Q. 278. Were the others all the same, or why didn't you produce them? Were these selected ones?
A. Well, I didn't want to bring them all——
X Q. 279. I asked you whether they were all the same?
A. I think these are the best specimens.
X Q. 280. For your case?
A. They are better made, they are more perfectly made; they have smoother edges. They are of good rubber and they perform the function more—to a greater extent—of sealing the seam all round.
X Q. 281. To a greater extent than the others would have performed it?
A. Than some of the others. There may be some there that would do just as well as these.

Mr. Varney: All right; that is all.
The Witness: There were some 7-W's there also, just like that one you showed yesterday. I didn't bring any of those today.
Mr. Emery: I would like to ask Mr. Griffith a question or two as to those heels
The Witness: Do you want to ask me?
Mr. Emery: Yes; pardon.

By Mr. Emery:

X Q. 282. As to these B heels which you have referred to and some of which you have nailed to boards, do you desire to be understood that those illustrate in shape and function the characteristics of the Tufford heels made under the patent in suit?
A. They do.
X Q. 283. In what respect?
A. When nailed down the arches—rubber arches—distorted from

their present form flatten out and, the securing means being at the center, the edges all around in the case of these heels seal the seam.

X Q. 284. Now, take the one of those B heels that is unattached to the wood.

A. Yes.

X Q. 285. And which you say resembles the ones that are at-[fol. 148] tached to the wood. Say whether or not the bottom of the cavity or depression is parallel with the perimeter of the curved side and back and edges.

A. I will test it and find out. [Examining heel with a gauge.] As I said yesterday, this is a very painstaking operation to determine with some of these heels. This particular heel here which you handed me and which is size W-C Tite-Edge heel, seems to have its lowermost portion of the attaching face with reference to a horizontal plane, including the side edges, to the rear of the breast line.

X Q. 286. How far to the rear?

A. About a quarter of an inch, and extending perhaps pretty close to the center of the heel—or it may be to the rear of that.

X Q. 287. And how much lower than the breast line?

A. So that I can see daylight under this gauge.

X Q. 288. Just enough so you can barely see daylight under it?

A. I believe I could give you that in linear dimensions pretty closely if you wanted me to.

X Q. 289. Well, I would like a fair statement.

A. Well, I could still see daylight if there were less space there. Perhaps it is a sixty-fourth of an inch, Mr. Emery; is that near enough?

The Court: How much?

The Witness: Perhaps it is a sixty-fourth of an inch.

X Q. 290. Now, in view of your last answer I think I will ask you to take the micrometer and give me the exact distance.

A. I think that will be better. [Measuring heel.] I have adjusted this depth gauge so that it shows the depth at the center of the breast——

X Q. 291. Don't you think, Mr. Slough, that this micrometer would be rather more accurate?

A. I have one.

X Q. 292. Oh, you have one; pardon me.

A. Yes, but it is difficult to get this micrometer at the breast because of the width here, and I am just setting this and then I am going to measure this and set it below and measure it again and take the difference. I think that is perhaps the most accurate way I can do.

X Q. 293. Have you tried using the other in the first instance?

A. I will try if you prefer that.

[fol. 149] Mr. Emery: Too much mathematics.

The Witness. Just subtraction. [Applying micrometer to heel.] Somehow or other this shows a greater difference than the other gauge. I don't know just why that should be. It may be an optical illusion.

Mr. Emery: Just, Mr. Slough, confine your remarks to a such as you want to go on the record, and then give them so we can hear.

The Witness: Excuse me, I forgot.

Mr. Emery: Thank you.

The Witness: I have now adjusted the micrometer gauge so that the point—the measuring, projecting point—touches the breast edge with the straight edge in contact with the side edges close to the breast. I now place the gauge to the rear of the breast with that point about—oh, a half inch or a little more to the rear of the breast, and turn down the—no, first I will take the indication shown on the gauge. It now shows 117 thousandths. Will you please check me, Mr. Emery?

Mr. Emery: I could not; I don't know enough about those devices to be able to. I will accept your testimony. How much lower do you find it to be, if any?

The Witness: His Honor has the heel just now. [The court examines the heel and returns it to the witness.] I now readjust the gauge to show the depth to the rear of the breast at the point I mentioned, as near as I can, and it shows something—it shows about, as near as I can tell, 137 thousandths, making a difference of 20 thousandths or two hundredths of an inch—about a fiftieth of an inch. My guess of one sixty-fourth was not so far off.

By Mr. Emery:

X Q. 294. How is it still farther back?

A. Why, generally, just a little further, I think it is just a little deeper; but the raised letters of the date, July 5, 1921, interfere with my making any accurate measurements. But I find points to the rear that seem to be a little deeper, not much. I will give you an estimate if you like.

X Q. 295. Does that heel that you just examined indicate to your mind the deliberate purpose on the part of the maker to pro- [fol. 150] vide a depression deeper in the rear of the breast than at the breast?

Mr. Richey: We object to that.

A. I don't know anything about their purpose.

X Q. 296. I am asking what it indicates to your mind—whether it indicates a deliberate design or a chance formation?

A. I think they are trying to get as close to the Tufford patent as they can and still argue that they have not.

X Q. 297. Now, will you please answer my question?

A. You are asking for my opinion.

X Q. 298. You haven't any opinion?

A. Just what I have told you.

X Q. 299. Now, you are very famliar with rubber heels?

A. Yes.

X Q. 300. Handled a good many, have you?

A. Quite a number.

X Q. 301. And you know, do you not, that almost any rubber heel if flexed in the hand or in the box or otherwise and so held for a

few moments will retain its deformed condition for a considerable period, don't you?

A. It don't take very long for it to come back.

X Q. 302. Well, will you answer my question, please?

A. What do you mean by considerable?

X Q. 303. Well, a few hours.

A. I doubt it; not to speak of; not a heel as small as that. I'll bet you—excuse me—if you deform this heel now and I measure it in fifteen minutes from now, I believe that the dimensions that I have just given you will very nearly apply.

X Q. 304. If that were held deformed for an hour or two it would chain it for a good part of an hour, wouldn't it?

A. I never did any such feat; I don't know.

X Q. 305. Now, Mr. Slough, I understand you to testify that you consider the depression formed of straight surfaces to be substantially the same as a depression formed of a continuously curved surface?

A. Yes, it may be.

X Q. 306. For the purposes of this case do I understand you to [fol. 151] so testify?

A. In the case of the defendant's heels here involved; yes, sir.

X Q. 307. Yes, sir. And while it might be more liberally described as plano-convex, you regard it as the equivalent of the concavo-convex?

A. As to mode of operation it certainly is.

X Q. 308. And the fact that the longitudinal elements or lines are straight and form parts of planes does not distinguish it from corresponding elements if parts of a curved surface?

A. In these defendant's heels it don't prevent the heel from accomplishing the same result as the Tufford heel, sealing the breast, or any openings.

X Q. 309. You are familiar with the Nerger heel of the Nerger patent, so-called?

A. I don't believe there is any such thing.

X Q. 310. Well, you are familiar with the Nerger patent, then?

A. Yes, sir.

X Q. 311. Did you ever testify in the suit entitled United States Rubber Company against The I. T. S. Rubber Company?

A. I did.

X Q. 312. Did you say——

Mr. Brown: We object to the introduction of this, if the court please, as immaterial.

The Court: I don't know whether it is or not.

Mr. Brown: It is not germane to anything asked the witness on direct.

The Court: It may be something to discredit his testimony, for all I know.

X Q. 313. I ask you if you recall giving testimony in that case; I quote from page 116 of what purports to be the record of evidence in that suit:

"If the Tufford heel were cylindrical in the forward portion or entirely cylindrical and it were depressed, the longitudinal elements being straight, there would be no tight sealing at the breast. The fact that both kinds of curvature are present in this Tufford heel, longitudinal as well as transverse, give the attaching face of the heel a concavity, a true concavity or depression."

[fol. 152] Do you recall giving that testimony?

A. No, I don't recall it just now.

X Q. 314. Do you testify that you did not so testify?

A. No.

X Q. 315. I ask you to look at this copy of the record which I have read, to refresh your mind, and say whether with that before you you can testify whether or not you did so define and characterize the Tufford heel?

A. [Reading:]

"If the Tufford heel were cylindrical in the forward portion or entirely cylindrical and it were depressed, the longitudinal elements being straight, there would be no tight sealing at the breast."

Well, I think that is so anyhow. If you had an entirely cylindrical heel I don't think you would get the same effect that you do with the Tufford heel; that is, the same degree of sealing.

X Q. 316. Now, be kind enough to answer my question. With that record before you did you so testify as I read into the record?

A. Well, the record, of course will speak for itself; I haven't any independent recollection of it.

X Q. 317. You wish to have it appear that you did not so testify?

A. No. I was on the stand for quite a while in that case.

X Q. 318. As a matter of fact, Mr. Slough, isn't it perfectly plain to your mind that you did so testify, after having looked?

A. I do not doubt it.

X Q. 319. You do not doubt it?

A. No.

X Q. 320. All right. And you affirm the testimony you then gave at the present moment, do you?

A. Yes; if you had an entirely cylindrical heel and nailed it down I don't believe it would create the sealing of the Tufford.

X Q. 321. Now, your evidence that I quoted was not limited to an entirely cylindrical heel. Your evidence was:

"If the Tufford heel were cylindrical in the forward portion or entirely cylindrical."

Now with that phrase before you do you still say that that testimony was true according to your ideas and opinion?

A. Well, I wouldn't want to say that that would always be true.

[fol. 153] X Q. 322. Then you now——

A. I think it is a little broader than I would have meant it to be if I were to say that over.

X Q. 323. Then, now, for the purposes of the present case you would like to modify your opinion then expressed?

A. No, I don't want to modify it. The heel I visualized at the time—that statement would be true.

Mr. Brown: I submit, if the court please, that in order to get this matter fairly in the deposition referred to be completely offered in evidence.

Mr. Varney: Well, that you may do if you wish. I am merely calling the attention of the witness to this particular part.

The Court: I guess we won't put in depositions in other cases. He is asking as to a specific thing.

Mr. Brown: It may be very unfair.

The Witness: I think the intention of that answer was to consider an entirely cylindrical heel. That is what I think.

Mr. Varney: I don't ask your intention. I move that that be stricken from the record.

The Witness: I wonder if that is not what I said originally? That is a transcript.

Mr. Varney: Well, I don't know as we are called upon to discuss what you wonder. It is in the record and we will let the record appear for what it may be worth.

X Q. 324. Now, Mr. Slough, I ask you whether at the same time and in the same case you testified as follows; I quote from page 129 of the same bound record of testimony in that suit:

"The Nerger patent heel must, as I have before explained, be cylindrical in the forward portion, that is, from the breast rearwardly towards the center. Being cylindrical and having straight elements only extending longitudinally of the heel there could be no such flattening of longitudinal arches such as occurs in the United States heels to which you have referred. The United States heels are curved all the way from the breast rearwardly to the rear part of the heel. The Nerger heels are not so curved. They are merely in their forward portion sections of cylinders, there being a rearward [fol. 154] curvature in the rear part of the heel. When one flattens a heel of this Nerger type by depressing it in the middle, the transverse arches in the forward portion, all being of the same radii and parallel, the same curvature, all act alike, just as simple beams would do and seal more or less the edges but do not produce that intensive sealing such as one would have with the United States heels."

I ask you if you recall that you so testified?

A. Yes, I did; but I also said in there that—a lot of that testimony was given under an assumption that the Nerger patent showed such a thing. I also said that I didn't take any definite position as to what the Nerger patent did show. I only for the sake of argument there considered that certain things were so and then argued from that or testified from that. But that is a different proposition than defendant's heel here. These lines are not parallel towards the front.

X Q. 325. I further read from the same page 129 of that record:

"The Court: In the Nerger patent is there any tendency for the sealing of the breast edge?

A. No, there is none. * * *"

Do you recall giving that testimony in answer to the court's question?

A. I seem to recall some of it. I can't recall it all as you read it.

X Q. 326. Won't you please now look at the record itself and see whether you are able to remember more clearly and definitely?

A. Well, I think it is so, anyhow, whether or not I remember it.

X Q. 327. Whether or not you then testified to it, you now affirm the truth of that statement?

A. Yes.

X Q. 328. And that expresses your opinion?

A. Yes.

X Q. 329. And you think the next time you testify you won't want to vary it?

A. That testimony is true if you read it all, Mr. Emery. You might draw a wrong inference from a part of it, but——

X Q. 330. It is not true in part but only, you think, in its entire?

A. No, I wouldn't want to say that. The testimony is true.

[fol. 155] By Mr. Varney:

X Q. 331. Would you take this glass and this studded die that we have used in connection with our tests and see what that will demonstrate, using as the heel the 5-W heel which you have just produced and the mate to the one that you have nailed down?

A. [Doing as requested.] You distort the heel if you make it fit. You are going to force that down through openings that that don't align with.

X Q. 332. See if it aligns with the front openings.

A. If you are going to do that, let us not do anything with that.

X Q. 333. Just examine the heels and see if they are not all in?

A. No, they are not all in.

X Q. 334. Will you show that to the court, please, and let the court see?

A. I will nail it down for you.

X Q. 335. No; I want it before it is nailed down.

The Witness: Your Honor, they don't align; some or them rest on the top.

Mr. Varney: You will get that down in on the washer.

The Witness: It will distort them.

Mr. Varney: No, you won't.

The Court: You may get your pressure on the front end and have them brought nearly in alignment. It wouldn't do any harm to try it anyway.

The Witness: No.

The Court: That is all you can do with the instrument you have got.

The Witness: I can't help that.

Mr. Brown: Is that in the center?

Mr. Varney: If you will show the court now—there is a little uncut rubber on there; do you want to press it up?

The Witness: I don't want to do anything with it unless you want me to.

Mr. Varney: I asked you if you would.

The Witness: I will press it up if you want me to, if you will tell me when to stop.

Mr. Varney: I want to see if you can seal the edge. Just go as far as you can.

[fol. 156] [The court examines the appliances.]

The Court: Let us see how much muscle you have put into it. Well, nothing on that breast except that little rough edge there.

The Witness: Not now.

The Court: Now, I have got it way down.

The Witness: Yes.

The Court: You get it way down hard. You can't push it any more to save your soul.

The Witness: You can overdrive nails. The harder you press, probably the worse it will be. You can get a tremendous power with a screw-press like that.

The Court: Yes; I put it clear down as far as it would go.

Mr. Varney: Counsel for defendant notes that the wrench was applied so as to press the heel down as far as it would go and that the exhibit showed a very distinct sealing of the side edges and nothing apparently but the rough fin of rubber on the breast edge.

Mr. Emery: Jagged, isn't it?

Mr. Varney: Yes, just jagged.

The Witness: I will nail it down and seal it.

Mr. Varney: Well, you can't seal it when you nail it down.

Mr. Emery: Have you identified the heel?

Mr. Varney: The heel was identified as the mate to the heel on the board; the mate to the heel produced and numberd 5-M.

Mr. Emery: Identified by the witness?

Mr. Varney: Yes.

The Witness: This heel is distorted by making the openings enter the rubber heel openings with which they are not in alignment.

Mr. Varney: I am sorry I have not one of those templets that would exactly fit. If you will bring one that would fit——

The Witness: Well, I can drive nails through it.

X Q. 336. You would probably find a great many of those that would fit the templet outside if you tried?

A. I can drive nails through it now.

Mr. Emery: I would like to ask one or two more questions of this witness.

[fol. 157] By Mr. Emery:

X Q. 337. Mr. Slough, will you please refer to the chart, Defendant's Exhibit J, produced by Mr. Livermore, and state whether or not the line under the title "Nerger" correctly represents what

you understand to be the longitudinal median line of the attaching face of the heel shown in the Nerger patent?

Mr. Richey: We object to this. He has not been asked about this chart.

Mr. Emery: He is now being asked about it, Mr. Richey.

Mr. Richey: Not in direct examination. We asked him about heels, not about drawings and theories.

The Court: Oh, yes; but this is all relative to the same matter.

The Witness: I think the Nerger patent may show such a heel. It does not clearly disclose any particular form of heel.

X Q. 338. Would the heel you describe in the testimony I have called your attention to, given by you in the United States case as to the Nerger heel presenting longitudinal median line at the attaching face, suggest that under that title "Nerger" upon this diagram?

A. I think it might; it is not clearly disclosed.

X Q. 339. No, but, Mr.——

A. I so said in that case.

X Q. 340. Well, now, let me again——

Mr. Emery: Would the court prefer to take a recess?

The Court: If you are going to enlarge on this.

Mr. Emery: It is likely to take ten or fifteen minutes, I think.

The Witness: I can enlarge on this——

[Recess until 2 p. m.]

X Q. 341. Mr. Slough, when we took the noon recess I was about to call your attention to your testimony, referred to at the morning session, given by you in the I. T. S. v. United States Rubber suit, appearing at page 129, where you said:

"The Nerger patent heel must, as I have before explained, be cylindrical in the forward portion; that is from the breast rearwardly towards the center" and so forth.

Now I ask you to refer to the diagram produced by Mr. Livermore and marked "Defendant's Exhibit J," and particularly to the outline cut under the title "Nerger", and say whether that diagram cut cor-[fol. 158] rectly illustrates the longitudinal median top line of such a heel as you described in the testimony quoted to you?

A. I think that that line, so far as it goes, would represent what is the most probable explanation of what is shown, of what the Nerger heel was.

X Q. 342. Now, I am not asking you as to the "probable explanation of what was shown", to use your language; I am asking you whether that represents one of the elements—we will say the longitudinal median element—of the top surface of what you there describe as the Nerger patent heel; that is to say, one that is "cylindrical in the forward portion; that is, from the breast rearwardly towards the center?"

A. So far as it goes I think that it would indicate one of the longitudinal median lines.

X Q. 343. Are you able to say that it does or does not illustrate?

A. So far as it goes.

X Q. 344. Such as you have described.

A. I presume you mean, for instance, that the line from the center of the breast straight down through the longitudinal median to the center of the rear portion.

X Q. 345. That is what I mean by "longitudinal median."

A. Along the attaching face, say.

X Q. 346. Yes.

A. I think that is probably what I had in mind.

X Q. 347. Well, does it correctly illustrate what you there described?

A. Yes, sir.

X Q. 348. It does?

A. Yes, sir. Let me read it, will you please?

X Q. 349. Yes, certainly. At the top of the page [handing volume to witness].

A. Yes, I think that is so.

X Q. 350. Now, please refer to the diagrammatic cut appearing beneath the title "Essex No. 2," and say whether that similarly is a correct delineation of the longitudinal median line at the attaching face of one of the Essex Tite-Edge heels, such as is now being made by the defendant, and heretofore referred to by you; such a heel, for example, as Defendant's Exhibit Present Tite-Edge Heel.

A. So far as that line is concerned and this particular heel is concerned, I think substantially, sir. That line is a little longer than this here [indicating].

[fol. 159] X Q. 351. Which line?

A. This one here [indicating].

X Q. 352. The proportion is about the same between the horizontal part and the forwardly inclined rear part?

A. There does not seem to be a great deal of difference so far as that one line is concerned.

X Q. 353. The diagram is really a correct illustration of the corresponding line of the heel before you?

A. So far as being a diagram is concerned: as to the exact dimensions I couldn't say.

X Q. 354. Now, please explain to the court how, if at all, in the process of flattening the surfaces of those two heels, the Essex No. 2 and the Nerger would differ in action, having reference to your testimony, "Being cylindrical and having straight elements only extending longitudinally of the heel, there could be no such flattening of longitudinal arches such as occurs in the United States heel to which you have referred", and so forth. Do you understand my question?

A. I do not, Mr. Emery.

X Q. 355. Well, both heels being composed of longitudinal, parallel elements, as you have described, reaching from the breast

rearwardly toward the center, how, if at all, in the process of flattening would they act differently one from the other?

A. All the Nerger heels that I have seen have flattened, as by nailing them down, bulged outwardly at the breast, leaving a large opening at the breast.

X Q. 356. Now, I refer particularly to the flattening——

A. That is not so in these heels, of the type described, which are nailed down.

Mr. Richey: That is, of the defendant's heels?

The Witness: Of the defendant's heels.

X Q. 357. You, in the United States suit, said:

"When one flattens a heel of this Nerger type by depressing it in the middle, the transverse arches in the forward portion all being of the same radii and parallel, the same curvature, all act alike, just as simple beams would do, and seal more or less the edges, but do not produce the intensive sealing such as one would have with the United States heels."

[fol. 160] A. Yes, that is so.

X Q. 358. Now, I ask you how, having reference to that action, defendant's heel illustrated by the cut Exhibit No. 2 would differ from that of the Nerger heel?

A. The Nerger heel is quite a different heel from this. The Nerger heel did not depend on the power of the Tufford rubber arches to seal the breast edge. There was a plate embedded in the Nerger heel, and when that heel was nailed down by holes passing through the plate, the plate would bend downwardly under the nails and outwardly at a point remote from the nails, and the plate being the dominating feature of the heel would give a lifting action to the heel at points remote from the nails. Not only that, but there was no live or unflattened arch portion strong enough in the Nerger heel to overcome that tendency to lift up at the breast edges. In these heels——

Mr. Richey: That is, in the defendant's heels?

The Witness: The defendant's heels, like Exhibit 2——

Mr. Richey: 100 and 101, isn't it?

The Witness: 100 and 101. There is a strong enough arched portion, when flattened by the nails in the regular, ordinary method of attaching heels to shoes, to overcome whatever dead portion there might be to the heels. And the compressive stresses nearer the tread portion of the heel are communicated through to the breast edge and hold the breast edge down.

The Court: There is nothing in the Nerger heel or the Nerger patent to limit it to the plate rather than a washer?

The Witness: Well, I don't know as to the limitation of the claims, your Honor; but that is the kind of a heel that was illustrated and described there.

The Court: I am talking about the specification.

The Witness: It refers to the transversely arched spring plate holding the edges down—the specification does.

X Q. 359. I observe in your testimony given at the point in question, that you made no mention of any steel or metal plate in the Nerger patent heel.

A. In my testimony in the United States case?

X Q. 360. Yes.

A. You will find I did very often.

[fol. 161] X Q. 361. In the question at the bottom of page 128 you were asked to compare the heels shown in the Nerger patent 661,129 with defendant's heels.

A. Yes.

X Q. 362. Defendant's heels had no steel plate in them?

A. No.

X Q. 363. Now, will you please refer to your answer to that question and tell me whether, in making the differentiation there called for you relied then as strongly upon this contained steel plate as you seem now to?

A. Which answer was that, Mr. Emery?

X Q. 364. The one I am referring to, beginning at the top of page 130.

Mr. Richey: I submit, if your Honor please, that the witness can refer to the testimony all along that line there. He should not be confined to one particular question.

The Court: If there is anything that he is interrogated about that is covered by other portions of the testimony, of course he has an opportunity to explain.

The Witness: The question just before went into the plate feature, and the next question related to form, I think, more particularly. You will find that the question at the bottom of page 127 is very descriptive of the plate, just the same explanation that I just gave here, only, perhaps, a little more complete. And I say in the short answer just before this question: "The plate dominates the action." That is very clear.

X Q. 365. Now, will you please answer the question I put to you?

A. You said I did not mention the plate, Mr. Emery.

X Q. 366. I ask you to refer to the answer to which I called your attention and say whether you there emphasized the plate as a distinguishing feature or differentiating feature?

A. I certainly had it in mind. I may not have mentioned it particularly. I did not.

X Q. 367. Just omit, if you please, what you may have had in mind, and so forth, and answer my question.

A. I did not say anything about the plate in that particular answer.

X Q. 368. Now, having reference to the distinction you drew in that particular answer to which I call your attention, will you say [fol. 162] how the defendant's heel like Essex No. 2 would differ in action from that of the Nerger; that is to say, omitting the reference to the steel plate?

A. They seal the seams all around, including the breast edge.

X Q. 369. That is, Essex No. 2 would?

A. Oh, you mean this diagram? I thought you were talking about the heels of the plaintiff's exhibit.

Mr. Richey: Plaintiff's Exhibits 100 and 101.

X Q. 370. Are the heels like the cut Essex No. 2, on Defendant's Exhibit J?

A. I wonder if I have said anything that would not be responsive to your question, because I have been thinking about the heels of plaintiff's exhibits, and not defendant's heels, when you said "Defendant's heel like No. 2," for some little time past.

X Q. 371. I think you have. But in order that there may be no question I will repeat the question. In order that there may be no doubt I will repeat the question again. I am asking you to compare a heel having a longitudinal median top line like cut Essex No. 2, Defendant's Exhibit J, with a heel described by you on page 129 of The I. T. S.-United States record before you, and illustrated by the cut entitled "Nerger" on the same Exhibit J, and say how the action of one in flattening would differ from the other, omitting all reference to the steel plate, as you did in that answer.

A. That is quite a question. These are merely lines; they do not show anything more than a single line. Obviously, if a heel were made composed of a single line, of no thickness—I can't imagine such a heel.

X Q. 372. Well, but, Mr. Slough, you have testified that the cut entitled "Essex No. 2" was a correct delineation of the longitudinal median top line of defendant's heel such as now made, and illustrated by defendant's present Tite-Edge heel exhibit, have you not?

A. Are you referring to this exhibit in particular? Yes.

X Q. 373. And you have also testified that the cut entitled "Nerger" was correctly illustrative of the longitudinal median top line of the heel you described as a Nerger heel at page 129 of the United States case record?

A. Yes, that is right.

[fol. 163] X Q. 374. Very well. Now, will you take those two heels so characterized, and explain as you did on page 129 of that record how the flattening action of one differs from the other?

A. If this heel is like the one I nailed down yesterday on cross-examination——

X Q. 375. Please do not bring in something that is not called for by the question.

A. I don't know. I would have to test them.

X Q. 376. You are unable to express an opinion?

A. Am I too include the lettering on this heel as a part of the attaching face, as you asked me to do yesterday?

X Q. 377. What is that?

A. Is that lettering here to be considered as a part of the attaching face? You said it was a part of the face yesterday.

X Q. 378. Well, I think it is, but to my mind the substantial line

of the face remains unchanged, so that you may disregard the lettering if you wish.

A. I am rather of the opinion that if this heel were a perfectly made heel, without any lettering, raised lettering on the attaching face, and it were to be nailed down through the nail holes provided for the purpose, that this heel might get the Tufford sealing at the breast. I have not tried it under those circumstances and I do not know, but I think it would. I think the arched portion here is sharp enough and there is enough of it to overcome the flat part, and if that were true, it being entirely composed of rubber, and nothing to hinder the compressive stresses, I think that might be accomplished. In the Nerger heel that could not be accomplished; the plate would prevent the compressive effect——

X Q. 379. I wish you would disregard the plate.

A. Well, it is difficult for me to speak of the compression of the Nerger heel without considering the plate, because that was an essential part of it.

X Q. 380. Then you do not now regard the fact that the two heels have straight elements only extending longitudinally of the heel as determinative?

A. Other factors might come in to modify that. You might have a heel having straight elements extending to the breast, and I know [fol. 1 4] you can, which would have other features so related that you would get the Tufford effect—in fact, you would have a Tufford heel.

Redirect examination.

By Mr. Richey:

Q. 381. Mr. Slough, will you compare the operation of the heel by the use of the template as you were asked to do here, and as Mr. Livermore did, with the natural and normal attachment by the use of nails?

A. It will be found that this plate comprises a body portion with protruding studs extending from the face, all a rigid, non-resilient structure. Now, in this plate the template is used to flatten the heel, as was done by Mr. Livermore, and as Mr. Emery compelled me to do. The rigidity of the structure when the studs are placed in the nail holes and the ends protruding through the washers prevent any expansion of that heel. Now, the washers are very near the attaching face. I have previously testified, as did Mr. Livermore, that in these concavo-convex heels the arches in flattening stretch the attaching face portion and the tread face portion compresses. These studs all being rigidly connected together, and being immovable, would prevent any such expansion and compression action being communicated from one portion of the heel, such as an arched portion, to another portion where it is less arched.

The Court: You get an equal distribution of force, don't you, with the use of that, whereas you could not with the hammer and the nail?

The Witness: Well, with the hammer and the nail you place your

nails and you flatten your lift gradually, and the lift has a chance to expand on the attaching face and to compress here, and the stresses may be equalized and communicated from an arched portion to a portion less arched. But when you have these studs, for instance, holding the front nail holes through their entire extent and the rear nail holes to an exact dimension, there is no chance to expand; there is no chance for any compressive stresses to communicate from one portion of the heel to the other. Also when this was used with a set of nail holes that did not coincide with the arrangement of studs, [fol. 165] there was a stretching or a pulling effect not had in the normal and natural way of attaching such heels to shoes. I would not think this would be a fair way of attachment at all. The heel could not operate as it would if it were nailed down to a shoe as a cobbler would nail it.

Mr Richey: Now, I offer in evidence the entire deposition of Mr. Slough, together with——

The Court: If there is anything that you want to call attention to, you may call attention to it, and I will take the whole deposition.

Mr. Richey: It is not very long, your Honor.

The Court: Anything in there you may call attention to, and we will have it put in the record.

Mr. Richey: We will have to read it over.

The Court: We will give you an opportunity. I had rather you would do it than to read it myself.

Mr. Richey: If it please the court, may I ask that a copy of this deposition together with the exhibits referred to in the deposition be marked for identification? May I do that? It will take some time to read it through.

The Court: That is, you want to put it all in, you mean?

Mr. Richey: Yes.

The Court: I think you can have time enough to call to my attention whatever you want to, and we will put it into the case in that way. I know what is in now, and then counsel on the other side will know, and you will. The other way there won't any of us know that.

Mr. Richey: We can do that later, can we?

The Court: Surely.

Mr. Richey: All right, sir.

Mr. Varney: I have one more question. The witness carefully explained to the court that because these pins were rigidly connected to the same plate that the two breast holding pins were connected that that made the test unfair. I want to ask the witness to use this [fol. 166] here by placing the two breast pins in the breast holes, the others coming here, and see if he can make the breast seal.

The Witness: Just with the two nails?

By Mr. Varney:

X Q. 382. Yes, just as it is. That will, it seems to me, establish whether you are correct or not. Put a little water on it, so you can see it.

A. This is the same you handed me yesterday, the 7–W, with the raised letters? No use to try it.

Mr. Varney: Read the former question.

The Court: He asked you to do some things. Go ahead and do it, and say what you mean to say about it afterwards.

[Witness measures heel.]

A. I know that the point in contact is—I know there is no pressure at all at the rear edge.

X Q. 383. Now see if you can seal the breast that way.

A. I have cut off the—

X Q. 384. You can cut it off this way if you put your clamp around where you can see it.

A. I don't think I can seal that breast of that heel under any conditions.

X Q. 385. Your point was, as I understand it—

A. The test is unfair; it is unfair anyhow.

X Q. 386. I am certainly limiting the unfairness you suggested by the other test.

The Court: Let me see it.

[Witness hands plate and heel to the court.]

X Q. 387. There is no pressure under the breast edge, but plenty along the side.

A. Right between the nails where the lettering is. The rear edge is quite loose, if you will notice, your Honor.

The Court: Yes, I see that.

The Witness: No longitudinal arches distorted there at all, just the one transverse arch in line with those nail holes is distorted.

Mr. Varney: That is all.

Mr. Richey: That is all.

Mr Varney: I should like to ask Mr. Livermore one question.

[fol. 167] **Additional Evidence for Defendant**

JOSEPH P. LIVERMORE (recalled).

Redirect examination.

By Mr. Varney:

Q. 68. Will you state what you have found by measuring the exhibit mold, Exhibit G?

Mr. Brown: Let us record an objection to that and to all the questions relating to the mold.

The Court: He can give the measurements of it. That is the mold, you mean, from which these heels are made?

Mr. Varney: Defendant's present heels like Exhibit F.

A. The mold is made so as to make—there is a gang of molds all carried in a large plate—there are thirty-two of these heels molded at once. One plate contains a number of dies that correspond to the tread face of each heel, another plate carries a corresponding group of dies that correspond to the attaching face, and there is a die between the two that forms the periphery of the heel. The die that forms the concave attaching face has a number of projections on it which just fit the concavity in the face of the heel. I have measured those, and as near as I can ascertain at all they are practically level on the flat portion, which makes the flat portion of the heel. That is, they are not higher at the breast edge than at the back point or any other place. Further than that, the die itself shows that the carrying plate for the gang of dies shows that these individual dies that make the individual heels are placed in that plate and then the plate face is evidently planed by a planing action that runs lengthwise to the gang, and lengthwise to each heel, and naturally that is bound to cut straight and level, from one end to the other of that flat surface so that there is no part of the flat surface of the die that makes the flat surface of the attaching face of the heel that is any higher than any other part. Perhaps I better show that to the court.

[Witness indicates on mold to the court.]

There is a series of projections. This gang is numbered—apparently the whole set is numbered, and it is 1, 2, 3, 4, 5, 6, 7, 8 up to 32, and this apparently is fitted on to here, right under the letter-[fol. 168] ing. If you will look across that you can see the marks of the planes in this direction, and this [indicating] runs right along through the whole line. Of course in ordinary machine training operations that would necessarily make this surface straight in this way, at any rate, whatever they might be, in that [indicating]; longitudinally the flat surface is the same height, and makes the flat surface of the heel the same depth throughout. I notice that the lettering on this is apparently struck in by a die. It is not cut out, but dies are driven into it, and that roughens the surface a little bit.

Mr. Varney: That is all.

Recross-examination.

By Mr. Ritchey:

X Q. 69. Mr. Livermore, what happens if the plate warps?

A. That brings it more or less out of line, but the whole board was made of three plates. The next plate has just a series of holes through it. The third one is like this except in place of this convex projection it has concave projections. Now, the whole three together go together, and these pins line them up and then they are put in a press in the vulcanizing operations, and these molds are put together and under very heavy pressure. I think a slight warping would not strain it. But I don't think any warping would make any material difference in the individual molds.

X Q. 70. You don't think if some are tilted one way and some the other way, a little bit out of tilt, that it would make any difference in the shape of the heels?

A. Nothing to be of any consequence.

X Q. 71. Still there would be a difference?

A. Oh, I daresay you could find out if there had been a distortion of the molds.

X Q. 72. In other words, these breast edges ought to be in the same plane if you are going to get the same kind of a heel from each cavity? That is right, isn't it?

A. The same plane transversely?

X Q. 73. Yes; and longitudinally, too.

A. Well, I don't know as it would be particularly necessary.

X Q. 74. Well, if one or two of them was higher than the other [fol. 169] you would get a thinner heel at that point, wouldn't you?

A. If it is tilted relative to the other plate it might make some difference. If the upper plate tilted in one direction and the lower plate in the other you would get a little thicker heel in front than it ought to be.

X Q. 75. In the meantime, the bottom plane horizontally, if some of these tilted more than others your heels would be correspondingly thicker or thinner?

A. Yes.

X Q. 76. And if they are out of line that would happen?

A. Yes.

X Q. 77. If any of these breast edges are out of plane with the others you get that same result because you have it tilted?

A. I don't say that.

X Q. 78. You have a horizontal plane on your bottom?

A. Yes.

X Q. 79. That is horizontal. Now, if these are in line—they ought to be the same distance from this plate here and about the same distance from the bottom plate, and if there is any variation in the distance there would be a difference in the heels, wouldn't there?

A. That heel would be thicker than the others.

X Q. 80. Yes. Of course, if this points down in the same line there would be a change?

A. Yes; one might be a little thicker.

X Q. 81. Might tilt up or tilt down?

A. If there were any such thing, that may be done.

X Q. 82. Let us look at this. Here is a straight edge.

[Witness measures mold.]

Mr. Emery: Your Honor, I brought this over to show you, but I don't think it is worth keeping here. I will take it back out of the way.

A. I think they are in line except possibly a slight little bulge that the lettering has made.

X Q. 83. That is about one out of a dozen measurements, wasn't it?
A. In nearly every measurement the middle part would come slightly raised.
X Q. 84. Do you have one there, as you claim, out of a dozen measurements you made that you claim is in line? Is that right?
A. No; I don't claim any of them are in line, in that way. I am [fol. 170] trying to get at the trueness of it. What I found first was the thing seemed to rock every time. That would make every one higher than the other one. If it rocked on these two, that would necessarily indicate that one was higher than this. Then put it on this one and that naturally would be lower, but it would not rock. I found it was rocking every time. For that reason it seemed to me as if there must be some little depression that I hadn't seen that made it do that.
X Q. 85. That would simply mean that the middle part of the mold was some higher than the engaging parts on the end?
A. I suppose it would mean that the point, that the middle was touching it lower than the point that the two ends were touching; no doubt about that. I found that on nearly all of them it makes every one of them higher than every other one, or what I think indicates there was a little high spot that the mold happened to touch. Probably the whole rocking is only a very small amount.
X Q. 86. These plates are subjected to great heat, aren't they?
A. Quite considerable heat. I shouldn't call it great heat for metal because—it is great heat for your hands, considerably more than boiling water, but not over 250 degrees Fahrenheit.

Mr. Emery: How much pressure are they subjected to when they are together?
The Witness: I don't know what it is, but quite heavy pressure.
Mr. Emery: Hydraulic pressure?
The Witness: Hydraulic pressure.
Mr. Richey: That is all we have, your Honor.
Mr. Varney: Our case.
The Court: The case is closed? Are you ready to go on and argue the case now?
Mr. Varney: I should prefer to go on.
Mr. Brown: What is your Honor's preference?
The Court: I would want to get away from here in a half hour from now in order to get my train, otherwise you can go on for half an hour.
Mr. Brown: It seems to me perhaps it is better to wait until morning.
[fol. 171] The Court: You can do just as you see fit.
Mr. Brown: I suggest we adjourn until the morning.
Mr. Varney: Would defendant proceed or the plaintiff?
Mr. Brown: I assume that the plaintiff, as regular, in the opening and closing.
The Court: I suppose he would close. I suppose the defendants have to go ahead and the plaintiff closes.

Mr. Emery: Then we will open in the morning.
The Court: Or you can go ahead tonight.
Mr. Varney: I think I would prefer to use the half hour.

OFFERS IN EVIDENCE

[MEMO.—The following is a list of exhibits which were duly offered and received in evidence:]
Plaintiff's Exhibits No. 100, 101, Tite-Edge heels on boards.
Plaintiff's Exhibit No. 102, heels corresponding to heels on boards.
Plaintiff's Exhibit No. 103, pair of B Tite-Edge heels.
Defendant's Exhibit B, heel previously marked for identification. Admitted.
Defendant's Exhibit J, illustrated chart.
Defendant's Exhibit H, glass plate, clamp and two studded dies.

[fol. 172] PLAINTIFF'S EXHIBIT No. 1a

Dec. 29. 9.

Wendt & Co., 911 Canton Ave., Detroit, Mich.

GENTLEMEN: We are just in receipt of a letter of which the enclosed is a copy.

We are not familiar with the situation regarding the patents covering rubber heels, and are therefor not in a position to pass upon the validity of the Tufford patent, or whether the heels manufactured by you are an infringement.

You will appreciate the fact that we have no desire to be placed in the position of defending a suit for damages, and would ask that you inform us immediately as to what position you intend taking in the matter.

Should we continue the sale of your heels we must ask that you give us suitable indemnity against any loss, costs or damages resulting therefrom. In other words we want to be protected in the event of our continuing the sale of your heels.

Very truly your, Jones & Roser, per —— ——.

RSJ/K.

PLAINTIFF'S EXHIBIT No. 2a

[On Printed Letterhead of Essex Rubber Company, Incorporated]

Main Office and Factory Trenton, N. J.

Shoe Findings Department

Trenton, N. J., Jan. 5, 1920.

Jones & Roser, 128 Gratiot Ave., Detroit, Mich.:

GENTLEMEN: Your letter of December 29th has been referred to us, and in reply we beg to advise that the I. T. S. Company claims that our Tite-Edge heel is an infringement, but has not brought suit against us in order to have this matter determined by the court. There is no way we can compel them to sue us, and until [fol. 173] they do we can only answer such statements as they make about our heel.

We have never believed that the I. T. S. patents covered our heel, but in fairness to the I. T. S. people, and in fairness to the trade we acknowledge the fact that the courts have given the patents a very broad interpretation, one which we do not think the patents are entitled to, and which various patent lawyers, including our own, do not believe can be sustained. Having made this acknowledgment, we think that fairness on the part of the I. T. S. Company requires prompt suit against us to have the status of our Tite-Edge heel determined definitely, and as far the trade is concerned, we think that our frank statement will inspire confidence that we are ready to meet the situation fairly and squarely.

When we placed our present Tite-Edge heel on the market we did not stop there, satisfied that it was the last word in heel construction, but continued to investigate and experiment, adding improvements from time to time, until some time ago we felt that we had achieved everything to be desired along this line of construction, but hesitated to abandon our present mould equipment and assume the expenses of putting out improved Tite-Edge heels as finally developed until we could do so economically and conveniently.

However, in view of the situation which has arisen surrounding the entire concave-convex type of heel, we will, to meet the broad interpretation, which the courts have given the I. T. S. patent, get into production on the improved Tite-Edge heel, and supply same to our trade as soon as possible in place of our present Tite-Edge heel, until the status of the latter has been determined by the courts.

We are very anxious to send you a sample of this improved heel, for we want you to see how it preserves the appearance of the Tite-Edge heel, to which your trade has become so accustomed, and at the same time incorporates improvements that all shoe repairers will instantly appreciate and willingly concede entitled it preference over all others.

[fol. 174] In the meantime we hope that you will co-operate with

us as heretofore, in return for which we guarantee you against any loss whatsoever, so that you will be running no risk, notwithstanding that the matter may be otherwise represented to you. This whole matter, as you know, is one between the Essex Rubber Company and the I. T. S. Rubber Company, and we are assuming all the responsibility; you are in no way involved.

In making this statement we have not attempted to make claims we cannot substantiate, such as many of the claims that are now being circulated in the trade, and what we have said is a complete answer to the charges that are being made.

Trusting this letter will serve to reassure you, and with kindest regards, and best wishes, we are

Very truly yours, Essex Rubber Company. C. C. Tucker, Sales Mgr. Shoe Findings Dept.

CCT/MP.

PLAINTIFF'S EXHIBIT No. 3

[On Printed Letterhead of Essex Rubber Company, Incorporated]

Trenton, N. J., April 10, 1920.

Wendt & Company, 911 Canton Ave., Detroit, Mich.:

GENTLEMEN: We wish to advise you that the I. T. S. Company claims that any concavo-convex heel, including among many others our Tite-Edge heel, is an infringement, but has not brought suit against us in order to have this matter determined by the court. There is no way we can compel them to sue us, and until they do we can only answer such statements as they make about our heel.

We have never believed that the I. T. S. patents covered our heel, but in fairness to the I. T. S. people, and in fairness to the trade, we acknowledge the fact that the courts have given the patents a very broad interpretation, one which we do not think the patents are entitled to, and which various patent lawyers, including our own, do not believe can be sustained. Having made this acknowledg- [fol. 175] ment, we think that fairness on the part of the I. T. S. Company requires prompt suit against us to have the status of our Tite-Edge heel determined definitely, and as fas as the trade is concerned, we think that our frank statement will inspire confidence that we are ready to meet the situation fairly and squarely.

When we placed our present Tite-Edge heel on the market, we did not stop there, satisfied that it was the last word in heel construction, but continued to investigate and experiment, adding improvements from time to time, until some time ago we felt that we had achieved everything to be desired along this line of construction, but hesitated to abandon our present mould equipment and assume the expense of putting out the improved Tite-Edge heel as finally developed, until we could do so economically and conveniently.

However, in view of the situation which has arisen surrounding the entire concave-convex type of heel, we will, to meet the broad interpretation, which the courts have given the I. T. S. patent, get into production on the improved Tite-Edge heel, and supply same to our trade as soon as possible in place of our present Tite-Edge heel, until the status of the latter has been determined by the court.

We are very anxious to send you a sample of this improved heel, for we want you to see how it preserves the appearance of the Tite-Edge heel to which your trade has become so accustomed, and at the same time incorporates improvements that all shoe repairers will instantly appreciate and willingly concede entitles it preference over all others.

In the meantime we hope that you will co-operate with us as heretofore, in return for which we guarantee you against any loss whatsoever, so that you will be running no risk, notwithstanding that the matter may be otherwise represented to you. This whole matter, as you know, is one between the Essex Rubber Company and the I. T. S. Rubber Company and we are assuming all of the responsibility; you are in no way involved.

In making this statement we have not attempted to make claims we cannot substantiate, such as many of the claims that are now [fol. 176] being circulated in the trade, and what we have said is a complete answer to the charges that are being made. Please advise us immediately if you are threatened or in any way interfered with and much oblige.

Trusting this letter will serve to reassure you, and with best wishes, we are,

Very truly yours, Essex Rubber Company. C. C. Tucker, Sales Mgr. Shoe Findings Dept.

CCT/MP.

PLAINTIFF'S EXHIBIT NO. 4

[On Western Union Telegram Blank]

April 12th, 1920.

To Essex Rubber Company, Street and No.: Trenton, New Jersey:

The I. T. S. Rubber Company have commenced suit against us in Federal Court here claiming infringement on Tufford Patent because of sales by us of your tite-edge heel. Order to show cause why temporary injunction should not issue is returnable April 19. Under date January fifth your Mr. C. C. Tucker guaranteed us against any loss and assuming all responsibility growing out of the sale of your heels. Please advise immediately what action you desire taken.

Collect. Jones & Roser.

PLAINTIFF'S EXHIBIT No. 5

[On Western Union Telegram Blank]

4/16, 1920.

To Essex Rubber Co., Street and No.: Trenton, N. J.:

No letter received regarding I. T. S. case. Wire instructions.

Jones & Roser.

[fol. 177] PLAINTIFF'S EXHIBIT No. 8

[On Western Union Telegram Blank]

1920, Apr. 7—p.m. 1.33.

A188P 169 Blue 1/70 Trenton NJ 120 1P 7.
Telephone No. Mel 442 Mrs. Wrptd 208 pm F Bx To be Mail-.
Duplicate of Telephoned Telegram Inspector 14 Detroit.

Mr. Walter Wendt, 911 Canton Ave., Detroit, Mich.:

Expect to have in your hands by April twentieth a stock all sizes from new moulds will not defend present suit based on heels of old shape but you can allow same to go by default and then sell afterward new shape only if another suit is brought against you will defend same as it must be based on sale of heels stamped patented January Fourteen Nineteen Nineteen please stock Your trade on sizes one three and five Cuban as heavy as possible before twentieth as those sizes will be last to arrive sent at once new stock order all sizes except three naught French and both sizes kidney shape which are new shape will ship by express and hope to furnish complete line by the time you need it and you can then ship all old style heels on hand to our Chicago office suggest you do not mention having been sued and I will come to Detroit in a few days to talk over entire matter personally.

C. C. Tucker.

Copy Telegram

8 p. m. April 6, 1920.

C. C. Tucker, Trenton, N. J.:

Subpœna returnable not later than April 20th just served on me by District Court in I. T. S. matter. Let me have full instructions at once.

Walter Wendt.

[On Western Union Telegram Blank]

185 DE VG 13.

Trenton, N. J., 4.43 p.m. Apr. 9, '20.

Walter Wendt, 911 Canton Ave., Detroit, Mich.:

We guarantee you against loss of any kind will see you Sunday morning.

C. C. Tucker.

7.13 p.m.

[fol. 178] Essex Rubber Company

Box 501 Trenton, New Jersey April 13, 1920.

Wendt Company, 911 Canton Avenue, Detroit, Mich.:

GENTLEMEN: From an examination of the papers which you gave me, our atorneys say that you should not sell the old style tite edge heels after April 19th, because if you do not appear before Judge Tuttle on that day he will probably issue a preliminary injunction. If for any reason he should not issue the preliminary injunction which has been asked for by the I. T. S. Company, then of course you would be at liberty to sell the old style tite edge heels.

You might ask your attorney to ascertain what action Judge Tuttle takes on the 19th, but be careful to instruct him that he should not appear as representing you. We would like to know what happens.

I am advised that inasmuch as the Exhibit which the attorney for the I. T. S. Company will introduce will contain heels from new mols as well as old ones that we should refrain from having an attorney approach the attorneys for the I. T. S. Company on the question of an accounting and damages. Please therefore take no action whatever, but if you are asked for an accounting, advise us immediately.

Very truly yours, Essex Rubber Company. C. C. Tucker, Sales Manager.

[On Printed Letterhead of Essex Rubber Company, Incorporated]

Trenton, N. J., April 14, 1920.

Wendt & Company, 911 Canton Ave., Detroit, Mich.:

GENTLEMEN: I wrote you a letter from New York yesterday and certainly regretted that our attorneys seemed to judge from the papers I handed them that you had better not sell any old style Tite-Edge heels after your last days of grace. Perhaps your own attorney can advise more particularly* in regard to that phase of [fol. 179] the matter, but it is our wish to not appear in the present proceedings. We do not want anybody to be in the position of having to say that this company is particularly interested in this particular suit. Mr. Oakley is in New York this afternoon in conference with the attorneys, and I may have something more to say in the next day or two.

I find that due to an express embargo no further shipment has been made and am therefore shipping you by parcel post some of the men's women's* heels sizes not shipped by express last week and some size 00 black, together with the 000 French and Kidney block* heels on the order you handed to me.

[*Erased in copy.]

The moulds for sizes 0 and 2 French will be in the factory tomorrow and I hope to be able to ship by express or parcel post at least a gross of each size in black and tan by Saturday. Am not able today, however, to say just when the first shipment can be made of the sizes 1, 3 and 5. In regard to the Cuban sizes, if the freight shipment which is held up arrives, I hope you will take orders for as many of them as you possibly can. As far as I know personally, an order taken on the 15th of the month could be delivered two a

weeks later if necessary, without your having violated [the]* restraining order which was issued on the 20th. In other words, if an actual sale is made you could not be restrained from delivering orders already taken. You might ask your attorney that question as I cannot get advice on it this afternoon.

Assuring you that everything possible will be done at this end to keep you supplied, and that we will make any shipments necessary by parcel post in order to do so while the express and freight embargoes are on, I am

Yours very truly, Essex Rubber Company. C. C. T., Sales Manager Shoe Findings Dept.

CCT-S.

Perhaps you can sell and bill before the 20th sizes 1-3 and 5 and then deliver them afterward. You might ask your attorney how you can handle that without your taking any chance.

Tuck.

[fol. 180] April 15, 1920.

Mr. C. C. Tucker, c/o Essex Rubber Co., Trenton, N. J.:

Dear Sir: Your letter written at New York has been received. I showed it to the attorney whom I consulted in this matter, who will follow your instructions.

I was sorry to hear that I must discontinue the sale of heels on April 19th. There is little or no chance that the new heels will be here then so I will probably have to suspend for a spell. In anticipation of this, I am loading my trade as much as I can. One thing is not clear to me. If the exhibits offered in this case contain some of the new heels and an injunction is issued on the strength of that showing, how can I continue to sell them?

On the advice of their attorney, Jones & Roser have pulled all Tite-Edge heels from their shelves and crated them to be returned to me tomorrow. I talked with Mr. Jones yesterday and tried to dissuade him from this course, but to no avail. It is going to take a lot of work to overcome the prejudice this action will precipitate.

Mr. Fox insists that I get a statement signed by Mr. Oakley for the Essex Rubber Company guaranteeing me against all loss for costs and damages in this matter. There should be no objection on your part to giving it for, as I see it, there is in this no justification for either Mr. Oakley or yourself taking offense, as I am making this request on the advice of an attorney as a business proposition and it should be teated as such.

[*Erased in copy.]

Please be prepared to let me have full instructions immediately as to what course you desire to have me take in case they ask for an accounting.

Very truly yours, Wendt & Co.

[On Printed Letterhead of Essex Rubber Company, Incorporated]

Trenton, N. J., April 16, 1920.

Wendt & Co., 911 Canton Ave., Detroit, Mich.:

DEAR WALTER: Mr. Whittemore of our firm of attorneys will go to Detroit, arriving there Monday morning. He has been given a letter of introduction to you.

[fol. 181] There is nothing I can say except that I hope you will accept the suggestions of those who represent us and let them handle the entire situation in accordance with their judgment. As far as I know, pesonally they will not defend the present suit providing the exhibit does not show new style heels stamped with the patent date. If they consider it necessary to do so will take over the suit and handle it.

Had another telegram from Jones & Rosser this morning, asking us to wire instructions, to which we replied that we would be there on Monday. I wish you would please tell Dick Jones that he has nothi*d*g to do with the proposition and has nothing to lose. Please take his stock of heels immediately so as to keep him quiet. I do not know what he may attempt to do but he does not seem to understand that his failure to put in appearance in answer to the suit brought means nothing more than that a restraining order will be issued, after which date he could not sell any more Tite-Edge heels of the shape covered by the order. I think if you get his heels away from him it would probably ease his mind as I do not know what else he has on it.

I hope to make you a little shipment by parcel post tomorrow but cannot be certain. Anyway by the latter part of next week you should certainly have all sizes in both tan and black.

With kindest regards, I am

Very truly yours, Essex Rubber Company. C. C. T., Sales Mgr. Shoe Findings Dept.

CCT/MP.

Size 1 Cuban running at 3 p. m. Will send some by P. P. tomorrow. Am not losing one minute in effort to get new heels to you.

[On Printed Letterhead of Essex Rubber Company, Incorporated]

Trenton, N. J., April 19, 1920.

Mr. Walter Wendt, 911 Canton Ave., Detroit, Mich.:

DEAR WALTER: Enclose formal guarantee against loss by you on account of the I. T. S. suit.

Perhaps my feeling that there should exist sufficient confidence [fol. 182] to warrant your taking for granted that we would assume all responsibility and any loss to which you might be subjected, was due to my being a little too sensitive. There was, of course, never any objection to giving you a written guarantee properly signed by an officer of this Company.

You may at this writing know more about what is going on than I do, as we have not heard from our attorneys by wire today. I am, of course, very anxious to learn what action they have taken and whether in any event they have suggested to your attorney that an extension be secured. Many reasons could be given the court for your need of such an extension and same if granted would give us the required time to stock you up. As a matter of fact this rotten railroad strike is responsible for our not having a full line of new heels in Detroit today.

Will make another shipment of size #3 by parcel post special delivery either tonight or tomorrow. Hope to have size #5 and 0 and 2 French tomorrow. We certainly should not be held up long as delay in delivery of parcel post packages is due only to congestion.

Very truly yours, Essex Rubber Company. C. C. T., Sales Mgr. Shoe Findings Dept.

CCT/MP.

P. S.—If the wording of the guarantee does not please your attorney, have him draw up one to suit himself and I will have Mr. Oakley sign it.

[On Printed Letterhead of Essex Rubber Company, Incorporated]

Trenton, N. J., April 19, 1920.

Wendt & Company, 911 Canton Ave., Detroit, Mich.:

GENTLEMEN: Complying with your request of the 15th inst., we hereby guarantee you against any loss resulting from any suits brought against you because of purchase and sale by you of Tite-Edge brand rubber heels manufactured by this Company.

Very truly yours, Essex Rubber Company. C. H. Oakley, President.

CHO/P.

[fol. 183] [On Printed Letterhead of Essex Rubber Company, Incorporated]

Trenton, N. J., April 20, 1920.

Mr. Walter Wendt, 911 Canton Ave., Detroit, Mich.:

DEAR WALTER: I found this morning that Mr. Whittemore did not go to Detroit and is leaving Judge Angell to take care of our interests for the present. He tells me that one heel from the exhibit is being sent to us for inspection, and that postponement of one week has been granted, which gives us that much more time.

It is also intimated that a further postponement can probably be secured. You are, therefore, as I understand it, at liberty to go right ahead and do business on your present stock until restraining order is actually issued. No doubt you will have full instructions from your attorney.

I am glad to say that after a very bad hold-up we finally brought the moulds for sizes 0 and 2 French in in a taxicab from New York. They are now running, and I hope to be able to send you tomorrow by parcel post one gross each of both sizes in tan and black. We expect to ship today by parcel post about a gross each of sizes 3 and 5 tan and black. We are going to make a freight shipment which I believe will now be possible, on account of your stock order, and as soon as express company will take them will forward at least a gross of all sizes in both colors.

Would be very much interested to learn whether any of the new heels have arrived. Let me know what you have so that I can know what is needed.

I am personally of the opinion that the I. T. S. Company will probably bring another suit a little later, and so after the restraining order is issued I believe it would be very bad policy on our part for you to sell any heels whatsoever with the exception of the new shape, since it is very important that any exhibit they produce in court contain no heels of either the original shape or the one we have been running for the past year or two.

Under the circumstances believe it will be wise for you to send me an order for a stock of white heels to be made of new shape and when you ship what you have left on hand to Chicago, send [fol. 184] all the old style white along with the rest. In other words clean out entirely so that there will be no possible chance for anybody to make affidavit that they have bought from you anything except new shape heels.

While not in possession of full information I am told that the Judge in Cleveland gave the I. T. S. a preliminary injunction against T. P. Rubber Co.
in order that the case might be passed on by the Circuit Court of Appeals. It would, of course, have gone to that court no matter what decision was rendered but Judge Westenhaver has given the I. T. S. Company preliminary injunctions against anybody and everybody, and I do not consider his having done so of special significance. Was rather sorry, however, to learn that the Tee Pee Company had decided to suspend temporarily until the higher court decision is handed down, and I presume they were not strong
the
enough financially to put up bond required, as I could not otherwise understand their decision to suspend production for the present.

I will not be at the factory tomorrow, as I have to go to Cleveland to a meeting of the Rubber Heel Club, but will return to Trenton Thursday morning unless I receive a wire from our attorney requesting me to go to Detroit. As things stand at this writing I would rather be at the factory as I believe I cannot be of any further assistance elsewhere.

Assuring you of my very personal appreciation of your attitude in this entire matter, I am

Very truly your, Essex Rubber Company, C. C. Tucker, Sales Mgr. Shoe Findings Dept.

CCT/MP

April 21, 1920.

Mr. C. C. Tucker, Findings Dept., Essex Rubber Company, Trenton, N. J.:

DEAR SIR: Your special delivery letter dated the 16th inst. was delivered to me at 6:30 P. M. Monday the 19th. That is the big reason I did not see Mr. Whittemore, of your attorneys, when he [fol. 185] was here. I immediately phoned Mr. Angell's residence but it was too late. I was at my desk Monday until about 11 o'clock and do not understand why they could not reach me.

I stopped in to see Mr. Kemp this afternoon. He has had no word from Mr. Whittemore since he left. He advised me that I could continue to sell heels until a restraining order was served on me. This seems to be in conflict with the advice you had on the subject, so I will talk with him about it again tomorrow. If that is the case, I think I could avoid service for a few days. That is, unless they cared to trail me around town.

My actions in that event would of course depend on how much of the new stock reaches me by that time. All heels which you shipped via parcel post last week have arrived. The 25 gross express shipment has not come in. This makes it seem advisable to shoot along an assortment of men's heels parcel post.

I am trying to get an order for new heels from Jones and Roser. Mr. Jones is slippery and hard to pin down and Joe Wessel, his right bower, seems to be afraid of the cars. The other city salesman and the senior store man are with me, however, so the fact that the two big guns are against me leaves me undaunted. I shall see them again in the morning.

Mr. Oakley's guarantee has been left with Mr. Fox for his approval. It appears to fill the bill and you may be sure that it does if you do not hear from me again on it.

With kindest regards, I am,

Very truly your, —— ——.

April 24, 1920.

Mr. C. C. Tucker, Findings Dept., Essex Rubber Company, Trenton, N. J.:

DEAR SIR: It is regretted that there is no red ribbon on this machine. There should be one to write you the news that the hearing has again been postponed, this time for two weeks. Mr. Kemp, of Angell and Turner, advised me this morning that he had arranged for a two week's postponement. It seems that this is one thing that he don't do nothing but, as someone has put it.

[fol. 186] We certainly should be able to get into shape by that time. All heels, express and parcel post, upon which I have billings have now been received. That is, with the exception of 0 and 2 French shipped on the 21st. There are still enroute 35 gross old style shipped on the 5th inst. If they come in this week, I can get rid of some of them. I have strewn around 100 gross Tite-Edge this month, in addition to 50 gross whole heels.

Some of the 5-O and 4-O which have come by parcel post are stamped "patent pending." Will it be proper to sell them with the new ones?

I now have all sizes except French and am going to make a strong effort to get J & R to put in a new stock. Their salesmen are telling everyone, particularly my trade, that they had to throw out Tite-Edge. If I can get them to put them in again, it will be a sure way to shut them up. Very truly yours,

[On Printed Letterhead of Essex Rubber Company, Incorporated]

Trenton, N. J., April 26, 1920.

Mr. Walter Wendt, 911 Canton Ave., Detroit, Mich.:

DEAR WALTER: I have your letters of the 21st and 24th, both of which arrived in the same mail. You say in the former that it would be advisable to send along another lot of men's heels by parcel post, but I assume from your statement in the later letter that that will not be necessary. Unfortunately we are still unable to make an express shipment, but have the promise of permission to forward a lot by freight on the Universal car tomorrow. Inasmuch as you have another postponement I am very much in hopes that the shipment made on the 5th will arrive in time for you to dispose of them, although Mr. De Vere will be glad to get any kind of Tite-Edge heels you happen to have in Detroit, which cannot be properly sold.

Answering your question will say that after the restraining order goes into effect, would prefer not to sell any 5-O and 4-O heels heels stamped "Patents Pending," as it may be that the alteration made in the concave surface together with the change in the letter-[fol. 187] ing of "Patents Pending" to "Patented" will be claimed by us to constitute sufficient difference or distinction to warrant our acting with the idea that no defense be made of the suit on which the exhibit shows anything except new style heels stamped "Patented Jan. 14, 1919."

Am sorry to learn that Jones & Roser are talking too much. Certainly hope you will get them to stock new heels. Be sure they are all new.

When Mr. Whittemore advised that you had better not sell any old style heels after the 19th, his decision was based on the assumption that if no action was taken by us and the case allowed to go by default, it would naturally follow that restraining order would be issued and made effective on the last day of grace. Since, however, the matter has been taken up and postponement secured.

Mr. Kemp is no doubt correct in advising you that you are at liberty to sell any heels you like until restraining order is actually issued and served on you.

I will see that you get another lot of 5-0 and 4-0 heels which are from the altered moulds, and stamped "Patented." I am very much in hopes that a freight shipment will reach you before you need to have new heels. If one cannot be made in the next day or two, and the express embargo is lifted, will ship by express.

I had a talk with the Tee Pee people in New York last Friday, and while not told exactly the reason for their failure to put up bond, and go ahead pending decision by the Circuit Court of Appeals, I was informed that appeal had been made and that they were absolutely confident of reversal. Judge Westenhaver apparently gave the whole subject very little consideration. His mind is apparently made up and nothing can change it. As a result he stated that as the Tee Pee heel looked to him at least as much if not more like the I. T. S. than Usco, he would grant the injunction asked for by the I. T. S. Company. As you know, Judge Westenhaver was recently reversed in the Elyria National Heel Co. suit, and everybody whose opinion is of any value, whom we have been able to reach, thinks that the Tee Pee Co. will win, and the U. S. Rubber Co. will win on the new Usco heel, which they will make [fol. 188] from moulds only slightly different in shape from those they formerly used. I do not seem to be able to work up a scare for myself or the Essex Rubber Co. on the proposition, as I believe we are entirely within our rights and that another 6 months or so will clear up the whole concave-convex heel situation. After that will come the deluge, as there are many companies either prepared or preparing to put out concave-convex heels as soon as they learn just what they can legally do.

Very truly yours, Essex Rubber Company. C. C. Tucker, Sales Mgr. Shoe Findings Dept.

CCT/MP.

April 29, 1920

Mr. C. C. Tucker, Findings Dept., Essex Rubber Company, Trenton, N. J.:

Dear Sir: Your letters of the 26th and note of same date on Jones & Roser matter have been received. Regret that I followed this thing up so zealously that they agreed to put the heels in. I sent them five gross men's and four gross women's, which is not much.

Your argument in this matter has merit, but I do not attach the importance to it that you do. I do not believe that the I. T. S. after having come out in the open by suing me, could consistently allow me to go on unmolested after I start to sell the new heels. The fact that they are strong after the T. P. strengthens this belief.

Therefore, the most good that could result from that would be to gain about ten days time and it does not seem to be worth it

The fact that I am selling heels is proof that I have not been restrained, as you say. But the fact that J. & R. have thrown out

the heel is proof that the long promised court action has been started. Then it came to my notice last week that someone innocently informed a shoemaker that the I. T. S. had sued a shoemaker in one place for using a heel that infringed. That is admittedly most unreasonable, but—have you ever tried to argue with a shoemaker?

If J. & R. want any heels in the next day or two I will stall them [fol. 189] off until I hear from you again. If you think best, I can say that an insufficient number of heels have been received to supply them for a couple weeks.

I would appreciate your sending parcel post a few of the following sizes,—Men's tan 8 and 9; women's tan 1, and black 00 and 1. I will be entirely out of these unless the April 5th shipment shows up.

Very truly yours, —— ——.

[On Printed Letterhead of Essex Rubber Company, Incorporated]

Trenton, N. J., May 1, 1920.

Mr Walter Wendt, 911 Canton Ave., Detroit, Mich.:

Dear Walter: Will you ship by parcel post items requested in your letter of April 29th and also some size 000 French heels which we slipped up on and did not get the marking changed. All so far shipped show the words "Patent Pending", and I am particularly anxious that you make no sale even though the shape is not really altered, of any heels which do not show the stamp "Patented Jan. 14, 1919". Hope to get size 000 black and tan away on Tuesday by parcel post.

Note Mr. Kemp's latest advice.

Inasmuch as you have already sent some Tite-Edge heels to Jones & Roser, it will not be worth while to discuss the question further. I do not know that either you or I can discern all of the reasons for the method being pursued by the I. T. S. Company. They have usually been satisfied for awhile after they have aggitated the situation in first one place and then another, but always or nearly so in your territory.

One of their reasons is easy to see. They consider that they had best make hay while the sun shines, and any injury they can do to a competitor they hope to benefit by, especially when they can stop them from doing business as in the case of the U. S. Rubber Co. and as in the case of the Tee Pee Rubber Co. where their opponents relieved them of certain competition, temporarily.

I believe the Essex Rubber Company has had a good deal of benefit so far out of the litigation, as it has eliminated some com- [fol. 190] petition for us and limited new competition which will certainly develop in large volume very shortly, after the situation is cleared up by definite court decision, which show every heel manufacturer exactly what they can or cannot legally do.

Since you have given Jones & Roser a few heels I doubt if it will make any difference if you give them more. The matter

had to be finally decided sometime and my only real reason for wanting further delay is that all of the moulds have not been altered and it is going to take some time to finish the balance of them.

Very truly yours, Essex Rubber Company. C. C. T., Sales Mgr. Shoe Findings Dept.

CCT/MP.

Night Letter

Collect. July 6, 1920—8:00 p. m.

Essex Rubber Company, Trenton, N. J.:

Notice was served on me today for apearance Monday, July 12th before Master in Chancery for the purposes of an accounting in I. T. S. matter. Phoned Judge Angell and made appointment for tomorrow at his office. He thinks a postponement can be arranged easily. I will wire result of interview.

Wendt & Co.

[On Postal Telegraph-Commercial Cables Blank]

1NYYA 37 NL. 1209.

Trenton, N. J., July 7

Wendt and Co., 911 Canton Ave., Detroit:

Please advise Judge Angell that Mr. Whittemore request that all possible time be secured so please ask him to have date of appearance set as far ahead as he can arrange. Will see you Tuesday in Cleveland.

C. C. Tucker.

[On Printed Letterhead of Essex Rubber Company, Incorporated]

Trenton, N. J., July 16, 1920.

Mr. Walter Wendt, 911 Canton Ave., Detroit, Mich.:

DEAR WALTER: I was very glad to have your telegram announcing the decision in favor of the Tee Pee Rubber Company. It [fol. 191] happens that Mr. De Vere had telegraphed me care of the train I was on last night and I was fortunate enough to get it at Pittsburgh.

Had a talk with our attorney this morning on the telephone, and he stated that while he did not have much to say until he could read and digest the decision, the fact that same was in favor of the Tee Pee Company was very gratifying. There is one thing I feel certain about and that is that we will have no more trouble with the I. T. S. Company in the 6th district, if indeed we do in any section.

I believe that our attorneys have written to their legal representative in Detroit to offer the I. T. S. Company a settlement, and I hope same can be adjusted without your having to go to the trouble

of making an accounting. You doubtless understand that inasmuch as we offered no defense of the suit against you on the old heels there is nothing for us to do but settle on the best basis we can, and it may be that an arrangement can be concluded instead of leaving it to the chancellor to decide the amount of the damages.

I find that you were shipped a day or two ago a few gross of each of all of the sizes of which you gave me a memo. yesterday. I have not had time to check up amounts due today, but will keep your memo before me and try and make another shipment of the same sizes as I am afraid what was shipped will not be sufficient to carry you for any length of time, so you can depend upon it that more will be forwarded within the next few days.

Just before I left Cleveland Mr. Cory told me that you were in the market for O'Sullivan heels and asked me whether to do business with you would interfere with our selling arrangements. I preferred to tell him that he was at liberty to sell you O'Sullivan heels if he could, and further that your credit was good for any amount.

I would, of course, like to know if you propose to stock his brand. With kindest regards, I am

Very truly yours, Essex Rubber Company. C. C. Tucker, Sales Mgr. Shoe Findings Dept.

CCT/MP.

[fol. 192] July 26, 1920.

Mr. C. C. Tucker, c/o Essex Rubber Company, Trenton, N. J.:

Dear Sir: Your letters of the 16th, 17th, 19th and 21st inst. were duly received. The order for E. V. Mullins, Flint, has been filled and the tip on the Breyly Mdse. Co. will be looked into. Thank you. I believe the Burdick matter has already been explained to you. He was peeved when Goldman came along and offered him immediate shipment of Tite Edge heels, so gave him an order and canceled yours. Since you have made the shipment, he has canceled the other order.

I had a talk with Mr. Kemp a week ago following receipt by him of letter from your attorney. Basing our calculations on the amount of old Tite-Edge which I have sold and the cost of them to me, we figured that we would be very fortunate if they would accept the offer suggested. Mr. Fales, of Richey, Slough and Fales, Elyria, was here last Tuesday and we appeared before the Master in Chancery to postpone the matter for thirty days pending their consideration of their proposal. Upon leaving he told me that he thought there would be no difficulty in making an amicable settlement out of court. I hope so, for it would be an awful job to check up three years' Tite-Edge sales.

It is impossible to give you an absolutely definite reply as to what I propose to do regarding O'Sullivan's heels. I feel, after much consideration, that to stock this heel would be to take advantage of the one logical way of competing with the jobbers who sell at a discount quantities of assorted heels in which O'Sullivan's are always

present. My field would be greatly enlarged if I could interest shoemakers who buy heels that way.

I talked with Mr. Cory about it at Cleveland because it was an excellent opportunity to find out whether or not they would sell me. He told me also that he would not do anything to interfere with your selling arrangements, agreed that his line did not compete with yours, and said he would be pleased to have me handle their heels. I told him that I would consider it further, and could get in touch with them about it later.

I have been reluctant to decide to take this step, not because [fol. 193] of a lack of conviction that it is one necessary for me to maintain my growth, but rather because of the decisive stand you took in the matter when it was mentioned last year. I am not unmindful of the fact that my little business was founded, has grown, and is still going thru a close association with your company and you in particular. In spite of the fact that ours has always been an equitable arrangement and that I in no way feel under any obligations because of it, I hesitate to do anything that would disturb these relations.

You seem to think that I would sell less Essex and Tite-Edge under those conditions, but I firmly believe that I would sell more. It would make me a contender for the quantity business, pushing Tite Edge where the other jobbers sell I. T. S. almost exclusively, thus giving me access to many shops where I now am given no consideration. Also it would enable me to offer a real service to my present and all other trade. Shoemakers carry O'S. not because they "want" them, but to satisfy a demand that will not be denied. Every customer that I now have *have* carries them and each one would rather buy all his heels from me than split his business.

These are my feelings in the matter, but, as stated, I have not made a definite move to act on them. When I do, I shall of course write you regarding it.

There have been quite a few complaints that the French and kidney heels do not wear well. Many of them advance the opinion that they are too soft. Have you had any others?

With kindest regards I am,

Very truly yours, —— ——.

Mr. Atkins has some Tite-Edge heels on the way which he says were shipped June 30th. Is that correct?

[On Printed Letterhead of Essex Rubber Company, Incorporated]

Trenton, N. J., Sept. 27, 1920.

Wendt & Co., 911 Canton Ave., Detroit, Mich.

GENTLEMEN: We beg to acknowledge and thank you for your [fol 194] valued favor of the 22nd enclosing your check No. 1402, which we note you tender in settlement of July 31st and August 6th invoices.

We find upon referring to your remittance statement that you deduct $1,000, with the notation "See Mr. Tucker." The writer

spoke to Mr. Tucker about this and he stated that he did not recollect anything pertaining to this deduction, however did say that you might have said something to him regarding same in the course of conversation which may have slipped his mind. We are therefore writing to ask that you kindly favor us with an explanation of this deduction in order that we can give proper credit to your account for this check.

Yours very truly, Essex Rubber Company. L. A. Case.
LAC-S.

Sept. 29, 1920.

Mr. L. A. Case, c/o Essex Rubber Company, Trenton, N. J.:

DEAR SIR: In reply to your letter of the 27th inst, the Thousand Dollar deduction was made because we have turned that amount over to Mr. Kemp, of Angell & Turner, to be used in settling the I. T. S. patent infringement case. The writer told Mr. Tucker that this had been done but he must have forgotten it.

Very truly yours, Wendt & Co.

[On Printed Letterhead of Essex Rubber Company, Incorporated]

Trenton, N. J., Oct. 11, 1920.

Mr. Walter Wendt, 911 Canton Ave., Detroit, Mich.:

DEAR WALTER: Will you kindly do me the favor to settle up the matter of damages with Jones & Roser. Our attorneys advise that J. & R. reported total profits of $229 to which certain costs would be added, and I believe the amount payable would be somewhere between $250 and $300.

It was my understanding that Jones & Roser either have or must pay the amount which they had profited by the sale of Tite-Edge [fol. 195] heels, and we will of course, stand costs of whatever nature connected with the case.

I am sending this letter to Mr. Varney with a request that he drop you a line giving instructions as to how to settle the matter. Would very much appreciate it if you would take care of the matter and send me a debit memo. to cover.

Thanking you for this favor, and with kindest regards, I am

Very truly yours, Essex Rubber Company. C. C. Tucker,
Sales Mgr. Shoe Findings Dept.

CCT/MP.

[On Printed Letterhead of Emery, Varney, Blair & Hoguet]

New York, October 14, 1920.

Mr. Walter Wendt, 911 Canton Avenue, Detroit, Michigan:

DEAR SIR: Mr. Tucker of the Essex Rubber Company has sent to us to be forwarded to you the enclosed letter dated the 11th instant

relating to the settlement of the I. T. S. suit brought against Jones & Roser.

As he has written you, the settlement of this suit will require the payment into court of from $250 to $300 as near as we can estimate.

If you are willing to make this cash payment, as requested by Mr. Tucker in his letter, will you not communicate with Messrs. Angell, Turner & Dyer directly to whom we have forwarded a copy of this letter and also a copy of Mr. Tucker's letter to you.

These attorneys will advise you then, or later, just what amount is required and when and how it is to be paid.

Yours very truly, Emery Varney, Blair & Hoguet.

G/H/Enc.

October 16, 1920.

Mr. C. C. Tucker, c/o Essex Rubber Company, Trenton, N. J.

Dear Sir: Your letters of the 13th inst. have been received. The handling of both the John Wallenius and the American Leather and Findings Co. matters is affected by the inability of the factory [fol. 196] to take care of the volume of business coming in so the replies to them can properly be bunched.

A letter was sent to Mr. Wallenius following receipt of your first letter, quoting him regular shoemaker's discounts—5% in up to five gross lots and 10% on five gross or more. I am not under any expressed restrictions with regard to selling a man of this type and under ordinary circumstances would certainly do so until called, as it offers a chance at some business outside of my local field. Since you promise to make a substantial shipment however, I shall follow your suggestion and offer 15 and 5% net which should interest him.

The order you had from the American L. & F. Co. is the result of the same condition. You may hear from Reimer & Gregory next. These two concerns are the smallest here and I practically have had to turn them down cold. These fellows prefer to buy from me, as they can buy oftener and in smaller quantities.

Your recollections of remarks I made regarding the Amer. L. & F. are correct. Arabian has slowed up badly in his payments. In my opinion he is straight altho often lacking judgment—take your choice. To make matters worse $1200 worth of leather was stolen from their store one night about a month ago not covered by insurance. This stock had been received just a few days before and was shipped with draft attached. It did not make me feel any better to learn that he was holding up my bills to buy leather for cash.

Frankly, altho I can assure you that his order to you was not inspired by me and I knew nothing of it until today, I was just about ready to let him do business with you if he cared to, for the same reason that you are willing to let him come with me. But I, being as anxious to maintain distribution as you are, shall gamble a little in this case and make another effort to keep him satisfied.

I believe you are aware of the fact now that a limited amount of merchandise can only do a like amount of good,

therefore keep the stuff coming. I am unable to give a list of what I particularly need; it would include everything that is now on back order. So make an effort to ship [fol. 197] promptly all the heels you owe me and in the future, with your assurance that my orders will be given preference, an order from me will mean that I need those goods immediately.

Your move in making the new price on whole heels $2.40 is pleasing. It very likely gives you a sufficiently increased income and keeps us in closer competition with Killion than would have been the case if you had elected to go to $2.50. All Detroit jobbers advanced the Essex price last Wednesday.

The matter of advancing the price of Panther was discussed at our last meeting, Oct. 5th. Everybody who in selling the line here, with the exception of B. Marx & So-, stated they did not care to advance because they were anxious to close them out. I could not take an active part in the discussion, but think that Marx finally decided to raise all by himself. Even E. J. Nebel, the original icicle and long-standing Panther man, is going to quit them and has given me a small order for Essex whole heels. I would not be surprised if I were able to work Tite-Edge in some time in the future.

Very truly yours, —— ——.

P. S.—A letter from Mr. Varney's office and your letter were received today also. I phoned Mr. Kemp regarding it and found that he is awaiting word from the I. T. S. attorneys in the matter.

PLAINTIFF'S EXHIBIT No. 9

Copy

November 1st, 1920.

Messrs. Emery, Varney, Blair & Hoguet, 149 Broadway, New York, N. Y.:

DEAR SIRS We have to-day arranged with the Attorneys for the I. T. S. Rubber Company for settlement of the case of I. T. S. Rubber Company, versus Jones & Roser, for $200.00 and costs. A formal stipulation to that effect has been signed and entered and as soon as we are able to get in touch with Mr. Wendt, and get his check, a final decree will be entered by the plaintiff.

[fol. 198] Nothing has been said about the payment of the costs in either of these two cases. We have agreed to pay the costs, and they will not exceed $100.00.

Yours very truly, Angell, Turner & Dyer, By —— ——.

EGK/VW.

[On Printed Letterhead of Emery, Varney, Blair & Hoguet]

New York, November 4, 1920.

Messrs. Angell, Turner & Dyer, Dime Bank Building, Detroit, Michigan:

GENTLEMEN: We have yours of the 1st instant and note what you say. Of course, we understand that costs are to be covered in the settlement.

Yours very truly, L. E. Varney. Emery, Varney, Blair & Hoguet.

G/H.

Copy

October 16, 1920.

Messrs. Emery, Varney, Blair & Hoguet, 149 Broadway, New York, N. Y.:

DEAR SIRS: We have your letter of October 14th, enclosing copies of letters with reference to the case of I. T. S. Rubber Company versus Jones & Roser.

The matters discussed will have our attention.

Yours very truly, Angell, Turner & Dyer, by —— ——.

EGK/VW.

[On Printed Letterhead of Emery, Varney, Blair & Hoguet]

New York, October 14, 1920.

Messrs. Angell, Turner & Dyer, Dime Bank Building, Detroit, Michigan:

Re Settlement of Jones & Roser Suit

GENTLEMEN: We hand you herewith copies of two letter both addressed to Mr. Walter Wendt of 911 Canton Avenue, Detroit, Michigan, with whom our client has an open account.

[fol. 199] You will probably hear from Mr. Wendt who will inquire of you what amount is required to settle the Jones & Roser suit and how it shall be paid. You will see from the enclosed letters that our client has asked him to defray this expense and that we have requested him to call you up for definite information as to how it shall be done.

Yours very truly, Emery, Varney, Blair & Hoguet.

G/H/Enc.

October 14, 1920.

Mr. Walter Wendt, 911 Canton Avenue, Detroit, Michigan.

DEAR SIR: Mr. Tucker of the Essex Rubber Company has sent to us to be forwarded to you the enclosed letter dated the 11th

instant relating to the settlement of the I. T. S. suit brought against Jones & Roser.

As he has written you, the settlement of this suit will require the payment into court of from $250.00 to $300.00 as near as we can estimate.

If you are willing to make this cash payment, as requested by Mr. Tucker in his letter, will you not communicate with Messrs. Angell, Turner & Dyer directly to whom we have forwarded a copy of this letter and also a copy of Mr. Tucker's letter to you.

These attorneys will advise you then, or later, just what amount is required and when and how it is to be paid.

Yours very truly, Emery, Varney, Blair & Hoguet.

G/H/Enc.

Essex Rubber Company

Oct. 11, 1920, Trenton, N. J.

Mr. Walter Wendt, 911 Canton Ave., Detroit, Mich.:

DEAR WALTER: Will you kindly do me the favor to settle up the matter of damages with Jones & Roser. Our attorneys advise that J. & R. reported total profits of $229 to which certain costs would be added, and I believe the amount payable would be somewhere between $250.00 and $300.00.

It was my understanding that Jones & Roser either have or must pay the amount which they had profited by the sale of Tite-Edge [fol. 200] heels, and we will of course, stand costs of whatever nature connected with the case.

I am sending this letter to Mr. Varney, with a request that he drop you a line giving instructions as to how to settle the matter. Would very much appreciate it if you would take care of the matter and send me a debit memo. to cover.

Thanking you for this favor, and with kindest regards, I am

Very truly yours, Essex Rubber Company. C. C. Tucker, Sales Mgr. Shoe Findings Dept.

[On Printed Letterhead of Emery, Varney, Blair & Hoguet]

New York, October 4, 1920.

Messrs. Angell, Turner & Dyer, Dime Bank Building, Detroit, Michigan.

GENTLEMEN: I have yours of the 1st instant and it will be entirely satisfactory if both cases may be got rid of for $1,300.

I am writing my client today to have them take the matter up directly with both Wendt and Jones & Roser.

Yours very truly, L. E. Varney.

G/H.

Copy

October 1, 1920.

Messrs. Emery, Varney, Blair & Hoguet, 149 Broadway, New York City:

DEAR SIRS: Your letter of September 30th authorizing a settlement at $1,200.00 of the cases of I. T. S. Rubber Company versus Wendt and Jones & Roser has been received.

A settlement of the Wendt case on the basis of $1,000 has been agreed to, and Mr. Wendt has deposited with the Master in Chancery his check for $1,000. The Attorneys for the plaintiff insisted upon a settlement for $1,000 and costs. We have not explicitly agreed to the payment of costs but have agreed that it would not stand in the way of a settlement. We think it highly desirable [fol. 201] to settle the Wendt case at $1,000 and agree to payment of costs ($25.00 or $50.00) to avoid any hitch in the settlement.

We have submitted to the I. T. S. attorneys a sworn statement from Jones & Roser, showing net profits of $228.00 and some cents. They may insist on full payment of this amount, plus costs. If they do, we recommend strongly that it be agreed to so that both of the cases may be got rid of for approximately $1,300.00.

The hearing on the accounting has been continued another two weeks from October 4th. We hope to have your definite consent in the course of a week to an adjustment of these cases on the bases suggested.

Yours very truly, Angell, Turner & Dyer, by —— ——.

EGK/VW.

[On Printed Letterhead of Emery, Varney, Blair & Hoguet]

September 30, 1920.

Messrs. Angell & Turner, Dime Bank Building, Detroit, Michigan:

GENTLEMEN: We regret that, owing to the absence of Mr. Varney, your letter of the 8th has not been more promptly attended to.

Without consulting our client, we authorize you to settle the two cases for $1,200.00. We do not think any more should be offered. We take it from your letter that you have offered this and we are wondering whether you have gotten any reply. Before authorizing you to offer any more, we shall have to put the matter up to our client and we will do so in case you cannot settle for that amount.

Yours very truly, Emery, Varney, Blair & Hoguet.

G/H.

Copy

September 8, 1920.

Messrs. Emery, Varney, Blair & Hoguet, 249 Broadway, New York, N. Y.:

DEAR SIRS: We have your letters of July 28th and 30th, regarding I. T. S. Rubber Company, vs. Walter Wendt and I. T. S. Rubber Company vs. Jones & Rosser.

The plaintiff's Attorney has expressed a desire to settle these two [fol. 202] cases simultaneously. He suggested that they might be settled for $1,000 each. We have replied that since the net profits of Jones and Rosser, according to their statement, approximate $200, the two cases should be settled for approximately $1,200. If the plaintiff should accept this, would it meet with your approval to dispose of both cases on that basis, or even a little more, if necessary?

Yours very truly, Angell & Turner, by —— ——.

EGK/VW.

[On Printed Letterhead of Emery, Varney, Blair & Hoguet]

New York, July 30, 1920.

Messrs. Angell & Turner, Dime Bank Building, Detroit, Michigan:

GENTLEMEN: In response to yours of July 26th, please handle the Jones and Roser matter with that of the Wendt case.

We enclose herewith a copy of a letter from our client, Essex Rubber Company, which will give you some general information respecting our client's relations with Jones and Roser. If there is any further data you wish, please let us hear from you.

Yours very truly, L. E. Varney.

G/H/Enc.

Essex Rubber Company, Incorporated

July 29, 1920.

Emery, Varney, Blair & Hoguet, 149 Broadway, New York City:

GENTLEMEN: Replying to your favor of the 28th inst. we find that there were no sales by us of Tite-Edge heels to Jones & Roser during 1919, and any Tite-Edge heels they had during that year were bought from Wendt & Company, and would therefore, be a part of one transaction as far as this Company is concerned.

For your general information Wendt & Co. have an inside price which enables them to sell to other jobbers on a close margin of profit, which accounts for the situation as above outlined.

We find that Jones & Roser purchased from us direct during the years 1917 and 1918 Tite-Edge heels to the invoice value of $3,568.55, or about 10% of the total amount sold to Wendt & Co. It would [fol. 203] appear, therefore, that if the I. T. S. Rubber Co. will accept in settlement of their claim on account of sales to Wendt & Co. the sum of $1,000.00, they should be willing to accept about an additional $100.00 to cover damages in the Jones & Roser case.

Please make it clear to your representative in Detroit that both of the jobbers there concerned in this matter have purchased our Essex brand flat heels, which are in no way connected with the law suits, and that any figure presented by Jones & Roser showing net profits should be based entirely on their sale of Tite-Edge brand heels only.

The writer is giving this information without intending to make any specific recommendation, and now trusts you will be in position to make proper settlement. If any further data is required kindly advise.

Very truly yours, Essex Rubber Company. C. C. Tucker, Sales Mgr. Shoe Findings Dept.

[On Printed Letterhead of Emery, Varney, Blair & Hoguet]

New York, July 28, 1920.

Angell & Turner, Esqs., Dime Bank Building, Detroit, Michigan:

GENTLEMEN: We acknowledge yours of the 26th instant and say that we have written our client in respect to the matter you put up to us. We shall probably have a reply in a few days and will then advise you.

Yours very truly, Emery, Varney, Blair & Hoguet.

G/H.

Copy

July 26, 1920.

Messrs. Emery, Varney, Blair & Hoguet, 149 Broadway, New York City:

GENTLEMEN: We should like to be advised whether we should take any interest in the case of I. T. S. Rubber Company vs. Jones & Roser. The defendants in this case, through their attorney, Mr. W. W. Wicker, have assumed the attitude that they would be protected by the Essex Rubber Company. When the attorney for [fol. 204] the I. T. S. Rub er Company was here recently on the accounting in these two cases, we inquired whether both cases should be adjusted simultaneously, and were told that the plaintiff preferred to handle them separately.

Mr. Wicker has submitted to us a statement showing a net profit of $228.73 made by Jones & Roser on Essex heels during 1919. Is it your desire that we should try to secure a settlement of this matter while we are adjusting the Wendt case?

Yours very truly, Angell & Turner.

Copy

July 20, 1920.

Messrs. Emery, Varney, Blair & Hoguet, 149 Broadway, New York City:

DEAR SIRS: We have your letter of July 15th.

Today we had a conversation with the Attorney of the I. T. S. Rubber Company and Mr. Wendt at the office of the Master-in-Chancery. Our suggestion for settling it at $1,000 was taken under advisement by him, in addition to certain general statements made by Mr. Wendt as to the character and extent of his operations with the heels involved.

After a conference with Mr. Tufford of the I. T. S. Company, plaintiff's attorney will advise us their attitude. It seems very probable that we shall be able to adjust the matter on a very reasonable basis.

The accounting was further postponed until August 20th.

Yours very truly, Angell & Turner, by —— ——.

EGK/VW.

[On Printed Letterhead of Emery, Varney, Blair & Hoguet]

New York, July 15, 1920.

Messrs. Angell & Turner, Dime Bank Building, Detroit, Michigan:

DEAR SIRS: In response to yours of the 13th instant, we are disposed to accept your suggestion that this matter be settled if [fol. 205] possible. There certainly does not seem to be any reason why we should incur the expense of accounting proceedings if we can get the other side to accept a reasonable sum in lieu of such damages and profits as might be turned up by an accounting.

Will you not therefore broach this phase of the matter to the other side. We should suppose that the gross profits on the sale of the infringing heels would total something like $5,000 against which would be charged off such advertising, salesmen expense and other overhead as might apply. Indeed, this overhead might be large enough to cut the profits down to $1,000. The other side might prefer to accept this sum rather than to incur the expense of further proceedings and the delay incident thereto. We authorize you therefore to offer them $1,000 in settlement and if this is not acceptable to get some counter proposition. We suggest also that while these negotiations are in progress, you will get the other side to consent to an indefinite postponement of any hearing on the accounting.

Answering your letter further, we cannot see how the Boston suit in any way affects the present suit in Detroit or the accounting there. A decree has been entered in the Detroit suit and even though the case may have gone otherwise if it had been tried on the merits, that decree settles the rights of the parties in the Detroit suit irrespective of how the Boston suit comes out.

We do not see how the fact that Mr. Wendt proceeded to dispose of the heels he had on hand would warrant the Court in assessing treble damages. Of course, if Mr. Wendt did this after the decree was entered, he was guilty of contempt. We do not know the facts but assume that such is not the case. He was instructed not to sell any more after the decree was entered.

In any event, Mr. Wendt should compile a statement for you (a duplicate of which should be sent to us as soon as possible) showing the total number of heels sold, the gross amount received for the same, the amount he paid for the heels and all possible overhead charges, including advertising, salesmen expense, and the proportionate part of the general expense of his business such as rent, insurance, etc., which can be properly charged off against his heel [fol. 206] business. This statement may then be used as the basis

of the account to be filed before the Master, in case we cannot effect a peaceable settlement.

Yours very truly, Emery, Varney, Blair & Hoguet.

G/H.

Copy

July 13, 1920.

Messrs. Emery, Varney, Blair and Hoguet, 149 Broadway, New York; Mr. Manvel Whittemore:

GENTLEMEN: Your letter of July 7th to Judge Angell has been received. We have been in consultation with Mr. Walter Wendt, also with Mr. W. W. Wicker representing Messrs. Jones & Rosser. Upon our request the attorneys of the I. T. S. Rubber Company have consented to a continuance of the hearing on the order for an accounting until July 21st. Does the suit in Boston in any way affect the accounting here? We do not know of a good reason we might advance for a request for a further continuance, and should like to have you advise us what position we should take at the hearing. Mr. Wendt proceeded to dispose of the heels he had on hand. Possibly the plaintiff will ask treble damages, and against such a contingency it might be advisable to settle on some basis. Have you any suggestions as to this phase of the matter?

Please let us hear from you by return mail if possible, so that we may be advised of your wishes a few days in advance of the 21st.

Yours very truly, Angell & Turner, by —— ——.

K.

[On Printed Letterhead of Emery, Varney, Bair & Hoguet]

New York, July 7, 1920.

Judge Alexis C. Angell, Dime Bank Building, Detroit, Mich.:

DEAR JUDGE ANGELL: I understand that Mr. Wendt has been ordered to account to The I. T. S. Company in the heel litigation [fol. 207] and that he has communicated with you in the matter. Will you please advise him on this accounting?

For your information I may say that the Essex Rubber Company has now been sued by The I. T. S. Company in Boston and the matter will be fought out there. I suggest therefore that you get as long a postponement as possible on this accounting. We will probably communicate with you further.

Very truly yours, Manvel Whittemore.

N:Gr.

Copy

April 30, 1920.

Mr. Marvel Whittemore, 148 Broadway, New York City:

DEAR MR. WHITTEMORE: We have your letter of April 26th addressed to Judge Angell, instructing us not to defend the suits brought

by the I. T. S. Rubber Company for infringement of their Rubber Heel Patent. We shall accordingly let the matter go by default.

We shall keep you advised of the new developments.

Yours very truly, Angell & Turner, by —— ——.

EGK/VW.

[On Printed Letterhead of Emery, Varney, Blair & Hoguet]

New York, April 26, 1920.

Hon. Alexis C. Angell, Dime Bank Building, Detroit, Mich.:

DEAR JUDGE ANGELL: Mr. Mills has sent me, and I have examined and returned to him the missing heel exhibit in the Wendt suit.

I find that this heel is, like all the others, an old style heel which we are quite certain we could not successfully defend in your circuit.

Under the circumstances we do not wish to appear and the plaintiff may proceed in both cases to take his injunction and later a default decree.

I would like to have copies of the injunctions when entered and [fol. 208] be advised when they are served upon the defendants. Please also keep us advised of any accounting proceedings which might be started. You might do this by asking Mr. Wendt to communicate with you whenever any papers are served upon him.

Very truly yours, Manvel Whittemore.

N:Gr.

Copy

April 26, 1920.

Messrs. Emery, Varney, Blair & Hoguet, Counsellors at Law, 149 Broadway, New York City:

DEAR SIRS: We received the telegram from your Mr. Whittemore advising of the non-receipt of the plaintiff's missing exhibit, in the case of I. T. S. Rubber Company versus Walter Wendt.

We have also received Mr. Whittemore's letter of April 23rd. Plaintiff's Attorneys very readily consented to a further continuance of two weeks from to-day.

It is hoped that the missing heel 5-O will be received shortly. We presume that you did not mean for us to suggest to Mr. Mills that he withdraw this exhibit from the controversy.

Yours very truly, Angell & Turner, by —— ——.

WGK/VW.

[On Printed Letterhead of Emery, Varney, Blair & Hoguet]

New York, April 23, 1920.

Hon. Alexis C. Angell, Dime Bank Building, Detroit, Mich.:

DEAR JUDGE ANGELL: When in Detroit Monday I arranged with Mr. Mills, representing the plaintiff in the rubber heel suits that

he should obtain and send me the heel referred to in the affidavit of Frank M. Slough as "numbered 5-O." He promised to write his principal immediately and communicate with me. I have not heard from him as yet and it will therefore be necessary for the return day of the order to show cause to go over at least another week.

However, if Mr. Mills will file some paper in the suit stating that [fol. 209] heel numbered 5-O is not an exhibit and will not be made an exhibit and will not be relied upon in the suit, then we can default and he can proceed to obtain his injunction without opposition on our part. I would prefer this course, but certainly would not tell him so.

Very truly yours, Manvel Whittemore.

N:Gr.

[On Western Union Telegram Blank]

Apr. 23, 1920—p. m. 12.04.

E 31 NY 15 Da New York NY 11.50 A. 23 1459.

Hon. Alexis C. Angell, Dime Bank Bldg., Detroit, Mich.:

Have not heard from plaintiffs attorney re missing heel exhibit, therefore further postponement necessary writing.

Manvel Whittemore.

[On Western Union Telegram Blank]

April 16th, 1920.

Emery, Varney, Blair & Hoguet, 149 Broadway, New York, N. Y.:

Counsel Wendt case willing to adjourn hearing injunction reasonable time.

Alexis C. Angell.

Chg. Angell & Turner.

[On Western Union Telegram Blank]

Apr. 15, 1920, p. m. 5.57.
B477 NY 21 NL Da New York N. Y. 15 2270.

Apr. 15—p. m. 6.00.

Hon. Alexis C. Angell, Dime Bank Building, Detroit, Mich.:

Will call you personally by telephone from New York at ten thirty eastern standard time regarding important situation in Detroit Federal Court.

Emery, Varney, Blair & Hoguet.

[fol. 210] Copy

April 16th, 1920.

Messrs. Emery, Varney, Blair & Hoguet, 149 Broadway, New York, N. Y.

GENTLEMEN:

Attention Mr. Whittemore

We have just wired you as per enclosed copy.

We have been unable as yet to reach Wendt or Jones or Roser. In conference with plaintiff's counsel we learn that Mr. Wendt has caused appearance to be entered by local attorneys, and that those attorneys offered to submit to injunction if the accounting were waived, but plaintiff refused to waive.

Plaintiff's counsel are not patent men, and do not know under which of your client's patents the exhibits were made. When you reach here Monday you can see them and perhaps decide. If you should be detained, we will be in court and get the matter put over and advise you further.

Yours very truly, —— ——.

PLAINTIFF'S EXHIBIT 10

Sheet 1

[On Printed Letterhead of Essex Rubber Company, Incorporated]

Trenton, N. J., Dec. 9, 1919.

The Thomas Urbansky & Sons Co., 2364 Ontario St., Cleveland, Ohio:

GENTLEMEN: We just received from Mr. Warman copy of the bill of complaint filed against you, and will be able within the next two or three days to advise you fully in regard to the matter.

In the meantime, please be assured that there is absolutely no cause for any discomfort on your part.

With the writer's kindest regards, we are,

Very truly yours, Essex Rubber Company. C. C. Tucker, Sales Mgr. Shoe Findings Dept.

CCT/MP.

[fol. 211] Sheet 2

[On Printed Letterhead of Essex Rubber Company, Incorporated]

Trenton, N. J., Dec. 18, 1919.

The Thos. Urbansky & Sons' Co., 2364 Ontario St., Cleveland, Ohio:

GENTLEMEN: In reference to the suit brought against you by the I. T. S. Rubber Company, we advise you that we shall stand behind

our jobbers and pay any judgments which may be obtained against them by reason of any infringement caused by the handling or sale of our goods.

The main object of the I. T. S. Rubber Company in suing you is to bring us out to Cleveland and compel us to submit our case to the courts there; and this we do not propose to do because it has a number of disadvantages. You, yourself, can see that if our heel is an infringement, a direct suit against us would be the most effective way to stop its sale if that is really what the I. T. S. Company wishes; but such a suit the I. T. S. Company has so far refused to bring.

It hurts us a good deal, of course, to have our jobbers sued; and probably appreciating this, the I. T. S. Company is taking this method of injuring our business rather than coming out directly against us.

We will ask you therefore to let the complainant take judgment against you in this suit with the understanding that whatever damages may be assessed by reason of your sale of our heel we will take care of.

With the writer's kindest regards, we are

Very truly yours, Essex Rubber Company, C. C. Tucker, Sales Mgr. Shoe Findings Dept.

CCT/MP.

Sheet 3

Jan. 29th, 1920.

Essex Rubber Co., Inc., Trenton, N. J.:

Attention of Mr. C. C. Tucker

GENTLEMEN: Enclosed herewith please find communication received from Richey, Slough & Fales, Elyria, Ohio, which we presume [fol. 212] is in particular reference to any Tite Edge Heels that we may have on hand.

Please advise us further in this matter, and oblige,

Very truly yours, The Thos. Urbansky & Sons Co.

TJ-MS.

Sheet 4

[On Printed Letterhead of Essex Rubber Company, Incorporated]

Trenton, N. J., Feb. 2, 1920.

The Thos. Urbansky & Sons Co., 2364 Ontario St., Cleveland, Ohio:

GENTLEMEN: Replying to your favor of January 29th, regarding letter sent you by the attorney for the I. T. S. Company, we assumed that you had disposed of what Tite-Edge heels you had on hand, and if not you would return any stock to us, which you had, as you are restrained from selling Tite-Edge heels as they are now being made in nearly all sizes.

We will shortly have a new design which is intended to meet the broad interpretation of the Tufford patent, and will offer same to you as soon as we can, hoping for your favorable consideration.

In the meantime if you have any Tite-Edge heels in stock, we will be glad to have you send them to us charges collect, and render us an invoice for same, which will include any expense of packing, carting, etc. which you may wish to charge us. We want it very distinctly understood that neither you nor any other customer of ours shall be put to any loss or expense.

With the writer's kindest regards, we are

Very truly yours, Essex Rubber Company. C. C. Tucker, Sales Mgr. Shoe Fndings Dept.

CCT/MP.

Sheet 5

June 15, 1920.

Essex Rubber Co., P. O. Box 501, Trenton, N. J.

Attention of Mr. C. C. Tucker

GENTLEMEN: We are just in receipt of the following communication from the Clerk's Office of the District Court of the United States, Northern District of Ohio, Cleveland, Ohio, which speaks for itself:

[fol. 213] "You are hereby notified to appear before the undersigned, appointed Special Master by the order of January 28th, 1920, in the case of The I. T. S. Rubber Co. vs. Thos. Urbansky & Sons Co., for the first hearing on the accounting provided for in said order of January 28th. You will please be present on June 23rd at 10:00 o'clock a. m.

You must be present at this time either by counsel or an authorized member of your Company.

B. C. Miller, Special Master."

Your early advice on the above matter will oblige,

Very truly yours, The Thos. Urbansky & Sons Co.

TJ-MS.

Sheet 6

[On Printed Letterhead of Essex Rubber Company, Incorporated]

Trenton, N. J., June 17, 1920.

The Thos. Urbansky & Sons Co., 2364 Ontario St., Cleveland, Ohio:

GENTLEMEN: Replying to your favor of the 15th inst., regarding notification to appear for hearing on accounting of business done with us on Tite-Edge heels, we beg to advise that the writer has taken up the matter with our attorney today, and will advise you definitely so that you will have any suggestion we can make not later than Monday morning.

In the meantime let us say that we regret that you should have been put to any trouble for such a small matter, as the most that can be claimed in the way of damages would be a small percentage on your purchases of Tite-Edge heels, which according to our records were covered entirely by your purchases of September 5 and September 26th, 1919, totaling $410.01.

Very truly yours, Essex Rubber Company. C. C. Tucker, Sales Mgr. Shoe Findings Dept.

CCT/MP.

P. S.—We will, of course, take care of any damages with which you may be assesse[illegible].

[fol. 214] Sheet 7

[On Printed Letterhead of Essex Rubber Company, Incorporated]

Trenton, N. J., June 18, 1920.

The Thos. Urbansky & Sons Co., 2364 Ontario St., Cleveland, Ohio:

GENTLEMEN: Replying further to your letter of the 15th inst., since it will, of course, be necessary for you to appear in answer to the summons, we suggest that you go prepared to state the number and value of Tite-Edge heels purchased from us, together with the gross and net profit realized on the sale thereof.

Since the amount involved is so small and the maximum damage you could reasonably be assessed would hardly amount to more than a fair percentage of the net profit, we believe that it would not be worth while for you to take time and trouble to consult your attorney. It is our understanding that after you have submitted the necessary information the complainant's attorney would have to go before the court and argue for damages resulting from the sale of our heels.

The writer is certainly surprised that they should go to all that trouble and expense in order to obtain a few dollars. It is of small consequence to us and our only regret is that you have to bother yourselves on account of any transaction with this Company. As you know, we had very good reasons for not wishing to take our Day in Court in Cleveland at the time the opportunity occurred, but we are satisfied that the entire matter will be cleared up very shortly and the exact status of all concave-convex heels definitely determined, after which we sincerely hope to again interest you in the sale of Tite-Edge heels, and will be prepared to make you the most interesting proposition possible.

It goes without saying that we will reimburse you for any expenses for attorney's fee or for any damages you may have to pay. We trust the matter can be disposed of with very little personal inconvenience to you.

Assuring you of our appreciation of your attitude in the entire

[fol. 215] matter, and that the writer hopes to see you at the Convention, we are

Very truly yours, Essex Rubber Company. C. C. Tucker, Sales Mgr. Shoe Findings Dept.

CCT/MP.

Sheet 8

Aug. 3, 1920.

Essex Rubber Co., P. O. Box 401, Trenton, N. J.:

GENTLEMEN: For your information please find enclosed communication and copies of Report of Special Master and Order in further connection with our accounting of Purchases and Sales of Tite-Edge Rubber Heels, pursuant to court order dated June 23, 1920.

Kindly return these papers for our files at your earliest convenience, and oblige,

Very truly yours, The Thos. Urbansky & Sons Co.

TJ-MZ.

Sheet 9

[On Printed Letterhead of Essex Rubber Company, Incorporated]

Trenton, N. J., Aug. 5, 1920.

The Thos. Urbansky & Sons Co., 2364 Ontario St., Cleveland, Ohio:

GENTLEMEN: Replying to your favor of the 3rd inst., it would appear that the $25.00 as compensation to the Special Master and $8.00 stenographer's fees, are in the nature of expenses and have no reference to damages assessed, if there were any. We will be glad to forward you check or credit memo. for the $33.00, but the writer is wondering whether in addition to that amount you have had to pay damages on account of profits realized.

We regret that this matter is not entirely clear and that we will have to ask you to advise just what amount of money is due you on the transaction, upon receipt of which we will be glad to reimburse you in full immediately.

We are, of course, very much gratified with the decision in the Tee Pee case, which positively clears in the 6th district comprising Ohio, Michigan, Kentucky, and Tenn., concave-convex heels of the [fol. 216] shape of Tite-Edge we are now manufacturing, as represented by the enclosed samples. In order to make no possible mistake we are securing definite advice from our attorneys. We are very much in hopes that we are full liberty to solicit your business on this new heel, and if we can secure your interest you can be certain that we will offer you every price advantage as well as protection from loss, if you are willing to talk business with us. We would appreciate an expression from you on this latter subject, and will

await your definite advice as to the exact amount payable on the injunction suit.

With kindest regards, we are

Very truly yours, Essex Rubber Company. C. C. Tucker, Sales Mgr. Shoe Findings Dept.

CCT/MP.

Sheet 10

Aug. 6, 1920.

Essex Rubber Co., P. O. Box 501, Trenton, N. J.:

Attention of Mr. C. C. Tucker

GENTLEMEN: For your further information please find enclosed copies of additional documents relative to the I T. S. case, which speak for themselves.

Kindly return these papers also as soon as you are through with them.

Very truly yours, The Thos. Urbansky & Sons Co.

TJ-MZ.

P. S.—Yours of August 7th just received. Will advise you in due course regarding expenses of injunction suit.

Sheet 11

[On Printed Letterhead of Essex Rubber Company, Incorporated]

Trenton, N. J., Aug. 9, 1920.

The Thos. Urbansky & Sons Co., 2364 Ontario St., Cleveland, Ohio:

GENTLEMEN: Replying to your favor of the 6th inst., we return herewith papers enclosed, as requested.

Will await your advice as to the exact amount we should send [fol. 217] you to cover all costs of every nature, to which you have been subjected, upon receipt of which we will compensate you without delay.

Allow us to repeat that we regret exceedingly that you should have been subjected to any inconvenience in this matter.

Very truly yours, Essex Rubber Company. C. C. Tucker, Sales Mgr. Shoe Findings Dept.

CCT/MP.

Sheet 12

Aug. 16, 1920.

Essex Rubber Co., P. O. Box 501, Trenton, N. J.:

Attention of Mr C. C. Tucker

GENTLEMEN: In further reference to the I. T. S. law suit, please be advised that this matter stands us $56.45.

Kindly let us have your check to cover, and oblige,

Very truly yours, The Thos. Urbansky & Sons Co.

TJ-MZ.

PLAINTIFF'S EXHIBIT 11

Sheet 1

July 15, 1920.

Essex Rubber Company, Trenton, N. J.:

GENTLEMEN: We are enclosing a bill which we received from the United States Court.

Will you remit to us for this amount, or, if you prefer to remit to them direct, it will be satisfactory to us.

Respectfully yours, H. H. Hackman Leather Company, per ——— ———.

HHH:LN.

Sheet 2

[On Printed Letterhead of Essex Rubber Company, Incorporated]

Trenton, N. J., July 19, 1920.

H. H. Hackman Leather Co., 1540 W. Third St., Cleveland, Ohio:

GENTLEMEN: Replying to your favor of the 15th inst., we beg to [fol. 218] advise that in order to relieve you of any inconvenience or trouble, the writer will arrange to have the account liquidated direct.

Regretting that you should have been in any way involved in a matter of so little consequence, we are

Very truly yours, Essex Rubber Company. C. C. Tucker, Sales Mgr. Shoe Findings Dept.

CCT/MP.

Sheet 3

[On Western Union Telegrams-Cablegrams Blank]

Copy

Dated Trenton, N. J., October 20, 1919.

To H. H. Hackman, c/o H. H. Hackman Leather Company, 1540 W. Third Street, Cleveland, Ohio:

Will not defend suit. Will write you later.

Essex Rubber Company.

Confirmation.

Sheet 4

[On Printed Letterhead of Essex Rubber Company, Incorporated]

October 23rd, 1919.

H. H. Hackman Leather Co., 1540 West 3rd Street, Cleveland, Ohio:

GENTLEMEN: We shall not defend the suit brought by the I. T. S. Rubber Company against you as we have already advised you by telegraph.

However, we shall of course protect you fully from any damages that may be recovered against you in case a decree is taken by default, that is, in case you do not defend the suit.

If, however, you should decide to defend the suit, kindly let us know and we will then determine what arrangement we will make with you. We are, of course, ready to defend any suit which the I. T. S. may wish to bring against us; but the manly thing for the I. T. S. to do is to come out and sue us and not go around and try [fols. 219 & 220] and injure our trade by picking off a jobber here and there.

Very truly yours, Essex Rubber Company. C. H. Oakley, Prest.

Sheet 5

Oct. 30, 1919.

Essex Rubber Company, Trenton, N. J.:

GENTLEMEN: Answering your valued favor of the 23rd inst., in reference to the suit brought against us by the I. T. S. Rubber Company, will advise you that we have no intention of defending this suit, and do not see why we should. If judgment is taken by default we naturally will expect that you will reimburse us for damages that might be received, and court costs.

Very truly yours, H. H. Hackman Leather Company, per _____.

HHH—Jr.:LN.

(Here follow Plaintiff's Exhibits 12, 13, and 14, marked side folio pages 221-226, 227 and 228, and 229 and 230 respectively.)

[fol. 231] PLAINTIFF'S EXHIBIT 19

UNITED STATES DISTRICT COURT, EASTERN DISTRICT OF MICHIGAN, SOUTHERN DIVISION

In Equity. No. 326

THE I. T. S. RUBBER COMPANY, Plaintiff

vs.

JONES & ROSSER, a Copartnership Consisting of Richard S. Jones and Edward J. Rosser, Defendants

Tufford Reissue Patent No. 14049

Bill of Complaint

To the Honorable the Judges of the District Court for the Eastern District of Michigan, Southern Division:

The plaintiff, for its Bill of Complaint, says:

PLAINTIFF'S EXHIBIT 12.

J. G. TUFFORD.

RESILIENT HEEL.

APPLICATION FILED JUNE 22, 1915.

222

Reissued Jan. 11, 1916.

14,049.

Fig. 1.

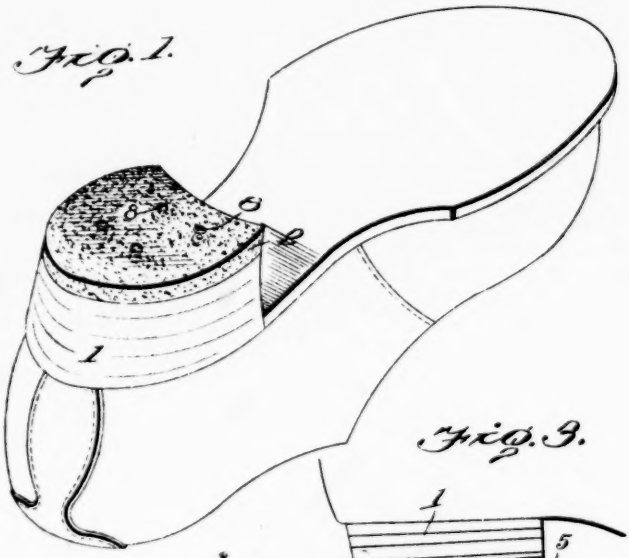

Fig. 3.

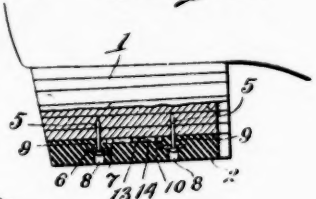

Fig. 2.

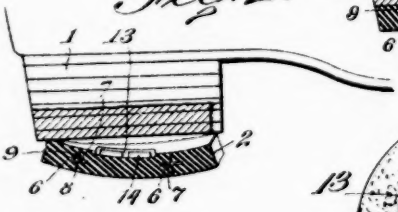

Fig. 4.

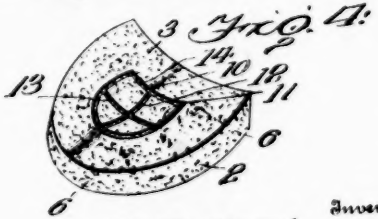

Fig. 5.

Inventor

J. G. Tufford.

By

Attorney

UNITED STATES PATENT OFFICE.

JOHN G. TUFFORD, OF ELYRIA, OHIO, ASSIGNOR, BY DIRECT AND MESNE ASSIGNMENTS, TO THE I. T. S. RUBBER COMPANY, OF ELYRIA, OHIO.

RESILIENT HEEL.

14,049. Specification of Reissued Letters Patent. Reissued Jan. 11, 1916.

Original No. 1,110,730, dated September 15, 1914, Serial No. 780,290. Application for reissue filed June 22, 1915. Serial No. 35,710.

To all whom it may concern:

Be it known that I, JOHN G. TUFFORD, a citizen of the United States of America, residing at Elyria, in the county of Lorain and State of Ohio, have invented certain new and useful Improvements in Resilient Heels, of which the following is a specification.

This invention relates to shoe heels, and more particularly to an improvement in cushion heels of that type comprising an elastic lift adapted to be applied to the ordinary heel.

The ordinary form of elastic lift now in common use is flat upon both its upper and under faces so that its flat upper face will bear flat against the flat under face of the lowermost leather lift of the heel to which the cushion heel is applied. As a consequence, after the elastic or cushion lift has been applied and the shoe has been worn for a short time, the pressure to which the cushion lift is subjected will result in its edge portions being projected or spread to a greater or less degree beyond the sides of the shoe heel proper, presenting an unsightly appearance and providing a crack or space into which dirt may enter, rendering the heel uneven and weakening its connection with the shoe heel proper.

I am aware that it has been proposed to employ a cushion lift having a concave upper face to be applied to the under face of the shoe heel proper, but I do not believe that up to the present time any practical and satisfactory means has been discovered and employed for attaching such a lift so that its connection with the shoe heel will be to any extent permanent. The method usually employed in securing such cushion lifts in place is to embed in the lift a plate conforming in contour to the concavity of the lift and then secure the lift in place by driving nails or screws through the plate and into the heel of the shoe, and where this method is not followed circular washers are embedded in the lift and have nails or other securing elements driven through them and into the shoe heel. In the first instance, the pressure imposed upon the heel will tend to flatten out the plate thereby causing its edges to cut through the lift besides weakening or loosening the securing elements, and, in the second instance, so far as I am aware, the washers have been circular and are arranged so as to be exposed at the tread surface of the lift after the shoe has been worn for a short time.

It is, therefore, one aim of the present invention to provide a cushion lift so constructed that, when applied to a shoe heel, its edge portions will not be forced to project beyond the sides of the heel, when pressure is applied, and to so arrange the attaching means for the lift that the lift may wear to a maximum extent without exposing such fastening means.

Another aim of the invention is to so arrange the attaching devices that they will be located relatively remote from the edge of the heel lift, whereby the lift may wear to a maximum extent without exposing the same, and incidentally the invention contemplates so constructing the washers which constitute an element of the securing means as to further prolong the life of the lift.

The invention has as another object to so form the concave upper side of the cushion lift that, when the lift is subjected to pressure, any tendency for the edge portions of the lift to crowd beyond the sides of the shoe heel will be counteracted and there will be equally as great a tendency for the material of the lift to crowd or compress toward the center thereof.

The result last-mentioned is accomplished in part by forming the concave side of the lift with a number of separate and distinct concave areas which, in fact, constitute a plurality of suction cups cooperating with the under side of the shoe heel when pressure is applied, and inasmuch as these concave areas are separated from each other, the expansion or spreading of the portion of the lift of which they constitute the surfaces will be accommodated so as to secure the result aimed at.

The invention aims further to construct the lift and the attaching means therefor in such a manner as not to destroy or impair the suction action resulting from the use of a lift having a concave upper surface.

In the accompanying drawings:—Figure 1 is a perspective view of the lift embodying the present invention applied to a shoe heel; Fig. 2 is a front to rear sectional view through the lift in position disposed against the under side of a shoe heel and immediately prior to application thereto; Fig. 3 is a

similar view through the heel, illustrating the same applied; Fig. 4 is a perspective view looking at the upper side of the lift removed; and Fig. 5 is a perspective view of one of the washers comprising an element of the attaching means for the lift.

In the drawings, the numeral 1 indicates the heel of a shoe and 2 the cushion lift embodying the present invention. The lift 2 is, as usual, formed from rubber, and is molded or cut so as to be of concavo-convex form on any line of cross section. In marginal outline, the lift is of substantially the same outline as the side of the shoe heel 1 and is, of course, to be finished to the same dimensions as the usual shoe heel, either before or after its application thereto. The concave upper side of the lift 2 is indicated by the numeral 3, and the convex under side by the numeral 4. It is preferable that the lift be of the same thickness throughout and that its marginal surface be at all points radial to the center of curvature of its concave side 3 so that, when the lift is applied to the shoe heel and subjected to pressure, its said marginal surface will be coincident with the side of the shoe heel.

As a means for securing the lift in place upon the under side of the shoe heel, small nails or other suitable securing elements 5 are employed and are driven through washers 6, which are embedded in the lift, and into the shoe heel. These washers 6 are of the form shown in Fig. 5 of the drawings, and each is of segmental form, the chordal edge of each washer being so positioned that the arcuate edge thereof will describe approximately three-fourths of a circle. Each washer is provided with an opening 7 to accommodate the nails or other securing elements 5, and the said opening in each washer is located concentric to the arcuate edge thereof. By reference to Figs. 1 and 4 of the drawings, it will be observed that the washers are so embedded and arranged within the body of the lift that their chordal edges will be presented toward the adjacent portion of the edge of the said body, so that, broadly speaking, that edge portion of each washer which is nearest the edge of the body of the lift will be spaced from said edge a greater distance than if the washers were of practically circular form. At this point it may be remarked that by so forming the washers and by arranging them in the manner stated and shown, a maximum wear of the edge portions of the lift is provided for before the washers can be exposed. It will further be observed by reference to the figures of the drawings that the washers are spaced substantially equidistant from the margin of the lift and that they are located as near the center of the lift as is practical considering a peculiar construction of the lift which will presently be described. The body of the lift 2 is formed in alinement with the opening 7 in each of the washers 6 with openings 8 and 9 which are extremely small in diameter and terminate respectively at the convex and concave sides of the lift. In fact, these openings are so minute that, when the nails 5 are driven through the lift, the walls of the openings will be crowded and, consequently, will snugly embrace and fit the surface of the nails. It has before been stated that a suction force is exerted due to the concave upper side of the lift, and it will now be apparent that due to the snug fit of the nails in the openings 8 and 9 the partial vacuum established when pressure is exerted upon the heel will not be destroyed or impaired. The openings 8 and 9 merely form guides for the nails 5 and are so small that they will not permit any appreciable escape of air from the suction area of the lift when the convex face thereof is flattened to temporarily hold said lift in position on a heel prior to permanently securing the lift with the nails.

By references to Figs. 2 and 4 of the drawings, it will be seen that the concave upper face of the lift lies entirely below a plane passing through the rear upper edge and breast corners of the lift whereby to cause the entire margin of said lift to exert a uniform pressure on the heel of a shoe when the lift is positioned on the heel and the convex face thereof depressed to flatten said lift. In other words, owing to the curvature of the concave attaching face of the lift, the rear upper edge and breast corners of said concave attaching face are disposed in a plane above the upper side edges and the breast edges of the lift.

As before pointed out, the concave side of the lift is provided with a number of concave or suction areas and in forming these areas channels 10 and 11 are molded or cut in the concave face of the lift and preferably extend respectively concentric to the forward and curved edges of the lift, as clearly shown in Fig. 4 of the drawings. These channels are relatively narrow and relatively shallow, and in addition thereto there are channels 12 and 13 which extend respectively from front to rear and transversely of the concave surface of the lift. In this manner, the central portion of said surface is divided into four suction or concave areas in addition to the main area which may be considered as surrounding the group of first-mentioned areas which, in the drawings, are indicated at 14, and it will be apparent that, if desired, the channels may have different lines of extent than here shown, whereby to increase or decrease the number of suction areas 14 or to vary the arrangement thereof.

It will now be seen that, when the lift is

subjected to pressure, each of the several suction areas 14 will be flattened and a partial vacuum created at each point of their location as well as throughout the entire surface of the upper side of the lift. The formation of the group of suction areas, however, presents this advantage, namely, that the channels resulting in their formation accommodate the marginal portions of the material of the lift of which the areas constitute the surfaces when these portions are spread due to the pressure exerted and, therefore, the lift is not compressed or spread bodily from its central portion toward its margin, but the expansion due to compression is equalized throughout the body of the lift.

Having thus described the invention, what I claim as new is:—

1. A cushion heel lift having washers embedded therein near its center portion and each of segmental form, the washers being arranged with their chordal edges presented toward the edge of the lift.

2. A cushion heel lift divided by a plurality of inter-communicating channels into a group of suction areas.

3. A cushion heel lift having a concave attaching face formed with a groove having a line of extent substantially parallel to the margin of the lift and having other channels intersecting each other and communicating with the first-mentioned channel.

4. A cushion heel lift having its attaching face provided with a suction area located substantially centrally thereof, and washers embedded in the lift and located in a series extending around the said area and located relatively close thereto, the washers at their sides which are located nearer the margin of the lift being straight edged.

5. A heel lift of substantially non-metallic resilient material having its body portion of concavo-convex form on every line of cross section, the concave upper face lying entirely below a plane passing through the rear upper edge and the breast corners of the lift.

6. A heel lift of substantially resilient material having its body portion of concavo-convex form on every line of cross section, the concave upper face lying entirely below a plane passing through the rear upper edge and the breast corners of the lift, said lift being provided with nail receiving openings located near the center thereof.

7. A heel lift of substantially resilient material comprising a body portion, the attaching face of which is concave and the tread face of which is convex on every line of cross section and normally held in such form by its own inherent resiliency, the concave attaching face lying entirely below a plane passing through the rear upper edge and the breast corners of the lift, whereby to cause the entire margin of said lift to exert a uniform pressure on the heel of a shoe when said lift is positioned on the heel and the convex tread face thereof depressed to flatten said lift.

8. A heel lift of resilient material comprising a body portion of uniform thickness throughout its entire area and of concavo-convex form on every line of cross section, the concave upper face of the lift lying entirely below a plane passing through the upper edge and the breast corners of said lift.

9. A heel lift of resilient material comprising a body portion, the attaching face of which is concave and the tread face of which is convex, the concave face of the lift being unbroken and lying entirely below a plane passing through the rear upper edge and the breast corners of the lift, whereby when the convex tread face is depressed to flatten said lift a suction will be created between the lift and the heel to hold the attaching face of the lift throughout its entire extent in contact with the exposed face of the heel.

10. A heel lift of substantially resilient material comprising a body portion, the attaching face of which is concave and the tread face convex on every line of cross section, the rear upper edge and breast corners of the concave attaching face of the lift being disposed in a plane above the upper side and breast edges of said concave attaching face.

In testimony whereof, I affix my signature.

JOHN G. TUFFORD. [L. S.]

227=228

RUBBER HEELS "TITE-EDGE" RUBBER HEELS

The Perfect Concavo-Convex Heel

Tread Side

TIGHT EDGE
••
CEMENTLESS
••
FLAT TREAD
••
ATTACHED IN A JIFFY
••
SUPERFINE RUBBER

Top-lift Side

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Men's, Women's French and Cuban and Kidney Block

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Rubber Heels

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Tight Joint,
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ESSEX RUBBER COMPANY
TRENTON, N. J., U. S. A.

(1) This is a suit in equity, arising under the patent laws of the United States.

(2) Plaintiff is a corporation organized and existing under the laws of the State of Ohio and having a regular and established place of business at Elyria, Ohio, and the Defendant, Jones & Rosser, is a co-partnership, consisting of Richard S. Jones and Edward J. Rosser, doing business at 128 Gratiot Ave. and 17 Clinton St., Detroit, Mich., within the said district wherein the acts of infringement herein complained of took place.

(3) John G. Tufford, being within the meaning of the statutes of the United States, the first, true, original and sole inventor of certain improvements in resilient heels which had not been known or used by others in this country before his invention or discovery thereof, or more than two years prior to his application to the United States Patent Office for a patent therefor, and not patented or described in any printed publication in this or any foreign country before his invention or discovery thereof, or more than two years prior to his application, and which had not been in public use or on sale in this country for more than two years prior to his said application, and which had not been abandoned, and not patented [fol. 232] or caused to be patented by him or his legal representatives or assigns in any foreign country upon an application therefor, filed more than twelve months prior to the filing of his said application for Letters Patent in the United States, and being entitled to a patent therefor under the provisions of said statutes, duly applied to the Commissioner of Patents of the United States for Letters Patent thereon, on July 21, 1913. Thereafter, and prior to the issue of the herein-mentioned original patent from said application, the said Tufford assigned by instruments in writing, duly recorded in the United States Patent Office, one-sixth of his entire right, title and interest in said application and in said invention to Carl H. Ingwer, of Elyria, Ohio, one-sixth thereof to Arthur G. Smith, of Elyria, Ohio, and one-twelfth thereof to Wm. C. Smith, of Elyria, Ohio, and requested that the patent so issue. All the requirements of the statutes then in force having been complied with, there were issued, under date of Sept. 15, 1914, to the said Tufford, Ingwer, A. G. Smith and W. C. Smith, United States Letters Patent No. 1,110,730, for such improvements, whereby there was secured to said Tufford, Ingwer, A. G. Smith and W. C. Smith, their legal representatives and assigns, for the term of seventeen years from Sept. 15, 1914, the exclusive right to make, sell and use said improvements.

Thereafter, on October 9, 1914, prior to the issue of the hereinafter-mentioned Reissue patent, the said Tufford, Ingwer, A. G. Smith and W. C. Smith assigned, by another instrument in writing, dated Oct. 9 ,1914, and duly recorded in the United States Patent Office, all of the right, title and interest in said patent No. 1,110,730 and to the said Tufford improvement in resilient heels to the plaintiff herein.

(4) Thereafter, on the 22nd day of June, 1914, for good and lawful cause, plaintiff herein surrendered said original Letters Patent No. 1,110,730 to the Commissioner of Patents, and having made due application therefor on June 22, 1915, and having in all things complied with the acts of Congress in such cases made and provided, said original Letters Patent were cancelled and new Letters Patent, which were marked "Reissued Jan. 11, 1916, #14,049," [fol. 233] were on Jan. 11, 1916, in due form of law, issued to the plaintiff, which said mentioned reissued Letters Patent are of record in the Patent Office of the United States, and which (or a certified copy thereof) is ready here in Court to be produced. (Copy of Reissue patent attached.)

(5) Since the date of said last named assignment conveying the rights to the plaintiff herein, and since Jan. 11, 1916, the plaintiff has been and is now possessed of all the right, title and interest in and to said invention and said reissued Letters Patent, and entitled to all the benefits thereof.

(6) And plaintiff further shows that the plaintiff recovered a decree on said Letters Patent in suit in the District Court of the United States, for the Northern District of Ohio, Eastern Division, against Fetzer & Spies Leather Co., which decree was sustained by the United States Circuit Court of Appeals for the Sixth Circuit; and furtber, that plaintiff did recover a decree, upon said Letters Patent in suit in the District Court of the United States for the Northern District of Ohio, Eastern Division against The Elyria National Rubber Heel Company; and the plaintiff did recover a decree upon said Letters Patent here in suit in the District Court of the United States for the Northern District of Ohio, Eastern Division against United States Rubber Company, which was sustained by the United States Circuit Court of Appeals for the Sixth Circuit. And thereafter, the plaintiff did recover a decree upon said Letters Patent in suit in the District Court of the United States for the Northern District of Ohio, Eastern Division against The Hill Rubber Heel Company, and in the same Court, a consent decree against The Consolidated Rubber Company.

(7) Since Jan. 11, 1916, the date of the reissue of said Letters Patent, and prior to the filing of this Bill of Complaint, the defendants, Richard S. Jones and Edward J. Rosser, within the Eastern District of Michigan, sold, or caused to be sold, or used, or caused to be used, resilient heels, and especially the Essex Tite-Edge Heels, which embody the improvements described in said Reissue Letters [fol. 234] Patent No. 14,049, unlawfully [illegible] without the license of plaintiff, and in infringement of said Letters Patent and plaintiff's rights thereunder, all unlawfully and without the license of said plaintiff, and said defendants threaten to continue said infringement, and have gained great profits from said infringement, plaintiff is informed and believes; wherefore, plaintiff prays that the defendants may be required to make full discovery of the gains from said infringement.

Claims 5 to 9, inclusive, all of which have been sustained by the Circuit Court of Appeals, are infringed.

(8) The plaintiff has marked its resilient heels with the word "Patented" and the number and date of the reissued patent here in suit. The defendants have infringed said patent since plaintiff's heels, so marked with the word "Patented" and the date of the reissue patent, have been distributed.

(9) But for the wrongful acts of these defendants, the plaintiff would be able to make, use or sell the improvements claimed in such Reissue patent with greater profit and advantage. By such wrongful acts of said defendants, the plaintiff, having no adequate remedy at law, is suffering irreparable damage, and is threatened with continued irreparable damage, unless this infringement by defendants is restrained by order of court.

Wherefore, the plaintiff prays:

1. For such preliminary and perpetual injunction against infringement of said reissued Letters Patent as to this Court may seem just.

2. For an accounting of damages and profits due to such infringement, and that defendants may be compelled to pay over to the said plaintiff said damages, as well as the profits.

3. For costs.

4. And for such other relief as equity may seem just.

5. The plaintiff further prays for a writ of subpœna ad respondendum, directed to the defendants, Jones & Rosser, commanding them to appear and make answer to the Bill of Complaint (but not under oath, an answer under oath being hereby waived), and to perform and abide by such orders and decrees herein as to this [fol. 235] Court may seem required by the principles of equity and good conscience.

The I. T. S. Rubber Company, by J. G. Tufford President. F. O. Richey, E. D. Fales, Counsel for Plaintiff. Campbell, Bulkley & Ledyard, Solicitors for Plaintiff.

STATE OF OHIO,
Lorain County, ss:

John G. Tufford, being duly sworn, deposes and says that he is President of The I. T. S. Rubber Company, the corporation named as plaintiff in the foregoing Bill of Complaint subscribed by him; that he has read said Bill and knows the contents thereof; that the same are true, except as to matters alleged in information and belief, and as to such matters he believes the complaint to be true; that he verily believes himself to be the first, original and sole inventor of the improvements set forth in the patent in suit.

J. G. Tufford.

Subscribed and sworn to before me this 29th day of March, 1920. John S. Richey, Notary Public. (Seal.)

Filed April 1st, 1920. Elmer W. Voorheis, Clerk, by Carrie Davison, Deputy Clerk.

[Copy of Letters Patent Reissued to J. G. Tufford, No. 14049 June 11, 1916. Attached to Original Bill.]

#326

Return on Service of Writ

UNITED STATES OF AMERICA,
Eastern District of Michigan, ss:

I hereby certify and return that I served the annexed Bill of Complaint, Order to Show Cause & Affidavit on the therein-named Jones & Rosser by Richard S. Jones & Richard S. Jones by handing [fol. 236] to and leaving a true and correct copy thereof with him personally at Detroit in said District on the 7th day of April, A. D. 1920.

Henry Behrendt, U. S. Marshal, by Joseph J. Guyette, Deputy.

Filed April 8, 1920. Elmer W. Voorheis, Clerk, by Carrie Davison, Deputy Clerk.

UNITED STATES OF AMERICA:

DISTRICT COURT OF THE UNITED STATES FOR THE EASTERN DISTRICT OF MICHIGAN, SOUTHERN DIVISION

In Equity

At a session of said Court, held in the Court Room, in the City of Detroit, in said District, on the 1st day of April, 1920.
Present: Hon. Arthur J. Tuttle, District Judge.

No. 326

THE I. T. S. RUBBER COMPANY, Plaintiff,

vs.

JONES & ROSSER, a Copartnership Consisting of Richard S. Jones and Edward J. Rosser, Defendants

Order to Show Cause

Upon reading and filing the bill of complaint herein and the affidavits of John G. Tufford and Frank M. Slough; and
On Motion of Campbell, Bulkley & Ledyard, attorneys for the plaintiff herein;

It is Ordered that Jones & Rosser, a co-partnership consisting of Richard S. Jones and Edward J. Rosser, do show cause to this Court, at the opening of court, on the 19th day of April, 1920, if any cause there be, why an injunction should not issue herein, as prayed for in said bill of complaint.

It is Further Ordered that the defendants be, and hereby are given up to and including the 9th day of April, 1920, for the filing and serving of such affidavits as they may desire, if any, in support of their position; and that thereafter said plaintiff be given up to and including the 17th day of April, 1920, for the filing of such counter-affidavits, if any, as it may desire.

[fol. 237] And it is further ordered that a copy of this order and of the bill of complaint and affidavits aforesaid, be served on said defendants.

Arthur J. Tuttle, District Judge.

Filed April 1st, 1920. Elmer W. Voorheis, Clerk, by Carrie Davison, Deputy Clerk.

UNITED STATES DISTRICT COURT, EASTERN DISTRICT OF MICHIGAN

In Equity. No. —

THE I. T. S. RUBBER COMPANY, Plaintiff,

vs.

JONES & ROSSER, Defendants

Affidavit of John G. Tufford

STATE OF OHIO,
Lorain County, ss:

John G. Tufford, being first duly sworn, deposes and says:

I am of mature age and am at present employed as President of the plaintiff company at Elyria, O. I invented the heel shown in the patent in suit. I testified in the case of The I. T. S. Rubber Co. vs. Fetzer & Spies Leather Co. No. 435 in this Court, and furnished affidavits in the cases of The I. T. S. Rubber Co. vs. The Elyria National Rubber Heel Co., United States Rubber Co., The Hill Rubber Heel Co., H. H. Hackman & Co., The Thomas Urbansky & Sons Co., The Fornes-Helms Leather Co. and John Piatek & Company.

Prior to my present incumbency, I was, for about thirty-five years, an ordinary shoe cobbler in Elyria, O., and in my work I learned of the disadvantages of the then universally used flat rubber heel, such as the O'Sullivan.

The following are some of the objections to the flat heel: The nails are deeply counter-sunk, as in all rubber heels, and when driven, the rubber is pinched out from under the nail and caused to bubble out at the side or forces up the side, opening the seam, as shown in Exhibit #1a. The nails and washers are placed close

[fol. 238] to the edge, in an effort to nail down the seam. Cement is employed, in order to try to fasten the rubber heel to the leather heel, necessitating the smoothing off of the leather heel and taking in all about twenty minutes to complete the job. The cement soon gives way and the seam opens, making an unsightly joint and permitting dirt and water to leak in, or actually drawing it in, which makes the shoe filthy and often foul, and which is often squirted out in the house. The nails and washers, being close to the edge, limit the trimming area, requiring the shoemaker to carry a large stock, as he must have a heel for practically every size of shoe heel, and these sizes are almost innumerable.

The life of the flat heel was short, because one soon wore into the washer which scraped on the floor.

There were many other objections to the flat heel, which are set forth in my testimony in the other cases. To remedy these faults, I invented the plaintiff's heel, like "Plaintiff's Exhibit, Plaintiff's Heels", which is concavo-convex in such a way that when it is nailed to the shoe by the centrally arranged nails, it is flattened out, and in tending to regain its form, constantly grabs hold of the bottom of the shoe by suction action, as indicated in Exhibit 3a, in such a way that the seam is permanently sealed without the use of cement. The cobbler attaches the heel in a few minutes. In addition, the washers are moved in so as to present a greater trimming area, lengthening the life of the heel, etc. These and other advantages are described in detail in my testimony in the Fetzer & Spies Case.

The patented heel is made without the metal plate, so often used in the prior art heels, and which doomed them to failure from the beginning.

After making the invention I did not have money enough to proceed with it, as I was very poor. Finally, I succeeded in inducing Mr. Arthur G. Smith and Mr. Carl H. Ingwer, who were at that time clerks in a retail shoe store, to raise enough money to apply for a patent. The three of us succeeded in gathering together about $23,000 from friends in Elyria. We then hired a bookkeeper and [fol. 239] with this capital, we embarked upon our enterprise in the first part of 1915.

The success has been phenomenal. In all, we have sold about 120,000,000 heels, the rise being more or less gradual and increasing from month to month, until we are selling between four and five million heels every month, at the present time; or, putting it another way, we are selling between ten and twelve tons of rubber heels every day. Our manufacturing equipment is being worked twenty-four hours every day.

There have been numerous infringements, as is indicated by the number of suits in which I have testified or given affidavits. The commercial success of the device is recited more in detail in the testimony which I gave in the Fetzer & Spies Case.

We have done practically no advertising to the public, and what little we have done, has been to the cobblers to whom the heel is a great boon. This type of heel is known to the cobbler as a suc-

tion heel, and can be found in most any cobbler's shop. Any one entering most any cobbler's shop and asking about the I. T. S. heel will learn from the cobbler of its advantages and of its improvement over the O'Sullivan and the other prior art heels.

I have examined and tested the heels constituting "Plaintiff's Exhibit, Defendants' Tite-Edge Heels" and find them concaved in a curved manner upon the bottom, the same as our heel and concaved on the top in a broken curve, instead of in a continuous curve. The attaching face is curved in all directions from the center towards the edge in all of the larger, and most of the smaller, heels, and in the others there is the clear equivalent when attached.

The attaching faces of all of the heels lie entirely below a plane passing through the rear upper edge and breast corners of the lift. The attaching face is so shaped that there is a somewhat centrally disposed low spot, so that if the upper edges of the lift are put in contact with the horizontal bottom of the heel, as far as may be, with the horizontal bottom of the heel, as far as may be, without using force to distort the normal shape of the lift, any contained liquid would be retained in this lowest spot, because the edge of the lift towards the breast of the heel is higher.

[fol. 240] Where the heels are well made, they adhere to a flat surface when smoothed out thereon. The nail holes are around the center, and when the heel is nailed onto a shoe, it operates just as the patented heel, in clinging to the edges of the shoe heel and grabbing hold of the shoe.

All the advantages of the Tufford heel are realized. They are attached without cement, thereby saving the time of attaching the heel to the shoe; the seam is permanently sealed; in fact, the heel is called the Tite-Edge heel; a wide trimming area is providd; the heel is cheap and easy to make, soft and resilient; the nail holes are staggered with respect to the nail holes in the leather heel.

The heels are devoid of plates and other objectionable devices. Washers are employed, as in the plaintiff's heels, and the washers are located in the same positions as in plaintiff's heels of corresponding size.

I identify the heels marked "Plaintiff's Exhibit USCO Heels," as like those held to infringe by the United States Circuit Court of Appeals in the Sixth Circuit, in United States Rubber Co. Case.

I identify the heel marked "Plaintiff's Exhibit National Heel," as like the heels held to infringe by Judge Westenhaver in the National Case.

I identify the heel marked "Plaintiff's Exhibit Hill Heel" as like the heel held to infringe in the Hill Case.

Heels like the heels constituting "Plaintiff's Exhibit, Defendants' Heels" in the instant case were held to infringe in the case of H. H. Hackman & Co. and The Thomas Urbansky & Sons Co., though there was no appearance for defendant. In the Hackman Case infringement was held on motion for preliminary injunction, in which the plaintiff appeared and argued, but there was no appearance for the defendants. The defendants, H. H. Hackman & Co., de-

faulted in that case, as did defendant in the case of The I. T. S. Rubber Co. vs. The Thomas Urbansky & Sons Co. and The I. T. S. Rubber Co. v. John Piatek & Co.—the first two cases in the Eastern Division, and the last in the Western Division of the Northern District of Ohio, I am informed and believe.

[fol. 241] The continued infringement by the defendants will do irreparable damage to the plaintiff, who is now prepared to supply the demand for the patented heel lifts. Indeed, the plaintiff and The Miller Rubber Company, who manufactures the heels for the plaintiff, have spent large sums of money in preparing to supply the market and in relying upon the patent in suit. The patent has already run some years, and its life is being shortened, of course, year by year. The patent has been sustained in two separate cases by the Court of Appeals in this circuit.

Plaintiff has always marked its heels with the number and date of the patent, and the defendants had notice of the infringement.

J. G. Tufford.

Sworn to before me and subscribed in my presence this 29 day of Mar. 1920. John S. Richey, Notary Public. (Seal.)

Filed April 1st, 1920. Elmer W. Voorheis, Clerk, by Carrie Davison, Deputy Clerk.

UNITED STATES DISTRICT COURT, EASTERN DISTRICT OF MICHIGAN

In Equity. No. —

THE I. T. S. RUBBER COMPANY, Plaintiff,

vs.

JONES & ROSSER, Defendants

Affidavit of Frank M. Slough

STATE OF OHIO,
Lorain County, ss:

Frank M. Slough, being duly sworn, deposes and says:

I am of mature age and reside at Elyria, O.

On Feb. 3, 1920, the defendants, Jones & Rosser, sold to me the heels 10-M, 6-M, 5-W, 3-W, 1-W of "Plaintiff's Exhibit, Defendant's Tite-Edge Heels." I bought these heels from Jones & Rosser at their place of business in Detroit, Mich., on the 3rd day of February, 1920, and paid them for the same.

They had many heels like the above-mentioned heels in stock and on sale.

[fol. 242] They had on sale heels like those constituting the heels 5-M, 7-M and 8-M of "Plaintiff's Exhibit, Defendant's Tite-Edge Heels."

Frank M. Slough.

Sworn to before me and subscribed in my presence this 29th day of March, 1920. John S. Richey, Notary Public. (Seal.)

Filed April 1st, 1920. Elmer W. Voorheis, Clerk, by Carrie Davison, Deputy-Clerk.

UNITED STATES DISTRICT COURT, EASTERN DISTRICT OF MICHIGAN, SOUTHERN DIVISION. IN EQUITY

In Equity. No. 326

THE I. T. S. RUBBER COMPANY, Plaintiff,

vs.

JONES & ROSSER, a Copartnership Consisting of Richard S. Jones and Edward J. Rosser, Defendants

Order to Take Bill pro Confesso

The subpœna in the above-entitled cause having been returned, which return has been filed, and it appearing therefrom that the said subpœna was duly served on the defendants, Jones & Rosser, and no appearance having been entered on the part of said defendants, or answer or other pleading filed, although such appearance should have been entered or pleading filed on or about the 21st day of April, 1920; therefore, on motion of Campbell, Bulkley and Ledyard, Solicitors for the plaintiff, it is ordered and decreed that the Bill herein be taken pro confesso as to said defendants.

Arthur J. Tuttle, District Judge.

Detroit, Mich., May 3rd, 1920.

Filed May 3rd, 1920. Elmer W. Voorheis, Clerk.

[fol. 243] UNITED STATES DISTRICT COURT, EASTERN DISTRICT OF MICHIGAN, SOUTHERN DIVISION

In Equity. No. 326

THE I. T. S. RUBBER COMPANY, Plaintiff,

vs.

JONES & ROSSER, a Copartnership Consisting of Richard S. Jones and Edward J. Rosser, Defendants

Decree pro Confesso

It appearing to the Court that the Bill in Equity in the above-entitled cause was filed in the Court on the first day of April, 1920, and that a subpœna was issued and duly served on the defendants herein, that no appearance has been entered on the part of the defendants, or motion, or answer filed, and that an order taking the

said Bill proconfesso was duly entered on the third day of May, 1920, in the order book, and that no proceedings have been had or taken by said defendants since such order was taken; now therefore, more than thirty days after entering said order as aforesaid, to-wit, on the third day of May, 1920, it is hereby ordered, adjudged and decreed as follows:

That Reissue Letters Patent of the United States in the name of John George Tufford, assignor by direct and mesne assignments to the plaintiff herein, for improvements in Resilient Heels, No. 14,049, and issued to the plaintiff herein, The I. T. S. Rubber Company, on January 11, 1916 being the Letters Patent referred to in the Bill of Complaint herein, are good and valid as respects claims 5 to 9, both inclusive.

That the said John George Tufford was the first and original inventor and discoverer of the improvements in resilient heels, as described in said Letters Patent and specification annexed thereto and claimed in said claims five (5) to nine (9), both inclusive.

That the plaintiff, The I. T. S. Rubber Company is the lawful owner of said Letters Patent.

That Jones & Rosser, a copartnership consisting of Richard S. Jones and Edward J. Rosser, have infringed upon claims five (5) to nine (9) both inclusive of said Letters Patent and upon the ex-
[fol. 244] clusive rights of the plaintiff under the same; that is to say, by the use and by the sale of resilient heels embodying the said invention and improvement patented as aforesaid, charged in said Bill of Complaint.

It is further ordered, adjudged and decreed that the plaintiff do recover of the defendants the profits, gains and advantages which the said defendants have received or made, or which have arisen or accrued to them by the use or by the sale of sundry resilient heels in violation of claims five (5) to nine (9) both inclusive of said Letters Patent since Jan. 11, 1916, and that the plaintiff do recover the damages resulting from the said infringement.

It is further ordered, adjudged and decreed that the cause be referred to William S. Sayres, Jr. a commissioner of this court, residing in the city of Detroit, Michigan, as master pro hac vice, his experience in such matters being found by the Court a sufficient reason for such appointment, to ascertain, and take, and state and report to the Court an account of the number of resilient heels embodying said invention and improvement as described and secured in claims five (5) to nine (9) both inclusive of said Letters Patent which have been sold and caused to be sold and used and caused to be used by said defendants, and also the gains, profits and advantages which the said defendants have received, or which have arisen or accrued to them since Jan. 11, 1916, the date of the issue of said Letters Patent in suit, from infringing the said exclusive rights of the said plaintiff by the use or sale, or by having caused to be used or sold said improvement in said resilient heels secured by claims five (5) to nine (9) both inclusive of said Letters Patent, and the damages which the plaintiff has suffered by such infringement, and

It is further ordered, adjudged and decreed that the plaintiff on

such accounting have the right to cause the examination of the members and officers of the said defendant co-partnership, ore tenus, or otherwise, and also the production of books, vouchers and documents of said defendants, and that the members and officers of the said defendant copartnership attend for such purposes before said master, [fol. 245] from time to time, as such master shall direct, and

It is further ordered, adjudged and decreed, that a perpetual injunction be issued in this suit against the said defendants, restraining them, their associates, officers, attorneys, clerks, agents servants, workmen and other employees, enjoining and restraining them, and each of them, from directly or indirectly using, or causing to be used, or selling or causing to be sold, in any manner, any article, device, apparatus, or resilient heels or heel lifts containing, embodying or employing the said inventions and improvements granted by the said Letters Patent, and embracing the invention and improvement described in claims five (5) to nine (9) both inclusive, or any resilient heel capable of or adapted to be used in infringement of said claims, or from infringing upon or violating the said Letters Patent in any way whatsoever.

It is further ordered, adjudged and decreed that the plaintiff do recover of the defendant the costs in this suit to be taxed.

Arthur J. Tuttle, District Judge.

Detroit, Mich., June 17, 1920.

Filed June 17, 1920. Elmer W. Voorheis, Clerk.

UNITED STATES DISTRICT COURT, EASTERN DISTRICT OF MICHIGAN, SOUTHERN DIVISION

In Equity. No. 326

THE I. T. S. RUBBER COMPANY, Plaintiff

vs.

JONES & ROSSER, a Copartnership Consisting of Richard S. Jones and Edward J. Rosser, Defendants

Perpetual Injunction

The President of the United States of America to Jones & Rosser, a copartnership, its servants, agents, workmen, and other employees, Greeting:

Whereas, it has been represented to us in our District Court of of the United States, the Eastern District of the State of Michigan, [fol. 246] Southern Division, that the Reissued Letters Patent of the United States of America, in the name of John G. Tufford, assignor by direct and mesne assignments to the plaintiff herein, for improvement in resilient heels No. 14,049 and issued to the plaintiff herein, The I. T. S. Rubber Company, on January 11, 1916, of which the plaintiff is the sole and exclusive owner, and that the plaintiff is also the owner of all of the rights to recover damages and profits from all infringements of said Letters Patent; and that the said

Letters Patent are good and valid and have been infringed by the defendants herein, by the use and by the sale of resilient heels embodying said invention and improvement, patented as aforesaid and charged in said Bill of Complaint.

Now, therefore, we do strictly command and enjoin and restrain the said Richard S. Jones and Edward J. Rosser, doing business as a copartnership, your associates, agents, workers, officers and other employees, and each of you, for the remainder of the term of the life of said Letters Patent, from further directly or indirectly infringing the same, and from directly or indirectly selling or causing to be sold, or using or causing to be used, any article, device, apparatus or resilient heels or heel lifts, in any manner containing, embodying or employing the inventions and improvements aforesaid, in said Letters Patent and particularly claimed in claims five (5) to nine (9) both inclusive thereof, or any resilient heels or heel lifts capable of or adopted to be used in infringement of said claims, or from infringing upon or violating the said Letters Patent in any way whatsoever.

Witness the Honorable Arthur J. Tuttle, Judge of the District Court of the United States, this 17th day of June, 1920, in the 144th year of the Independence of the United States of America.

Attest:

Elmer W. Voorheis, Clerk. (Seal.)

Filed June 24th, 1920. Elmer W. Voorheis, Clerk, by Carrie Davison, Deputy Clerk.

[fol. 247] Return on Service of Writ

UNITED STATES OF AMERICA,
Eastern District of Michigan, ss:

I hereby certify and return that I served the annexed Perpetual Injunction on the therein-named Jones & Rosser, a co-partnership consisting of Richard S. Jones and Edward J. Rosser by handing to and leaving a true and correct copy thereof with Richard S. Jones, one of the co-partners personally at Detroit in said District on the 19th day of June, A. D. 1920.

Henry Behrendt, U. S. Marshall, by Henry Walters Deputy

UNITED STATES DISTRICT COURT, EASTERN DISTRICT OF MICHIGAN, SOUTHERN DIVISION

In Equity. No. 326

THE I. T. S. RUBBER COMPANY, Plaintiff,

vs.

JONES & ROSSER, a copartnership Consisting of Richard S. Jones and Edward J. Rosser, Defendants

Final Decree

At a session of the District Court of the United States, in and for the Eastern District and Southern Division of Michigan, continued and held in the District Court Room in the City of Detroit, in said district, on Monday the first day of November, in the year of our Lord, one thousand nine hundred and twenty.

Present, the Hon. Judge Arthur J. Tuttle, United States District Judge.

Pursuant to a stipulation filed by Counsel in this cause, it is ordered and decreed as follows:

(1) That the defendant, having made settlement of all claims or profits arising hereunder in the sum of Two Hundred Dollars ($200.00), the reference to the Master is withdrawn, and

(2) That the plaintiff do recover of the defendant, in lieu of profits made by this defendant, from its sale of the Essex Tight Edge [fol. 248] infringing heels, Two Hundred Dollars ($200.00). In view of the stipulation, the Order for Accounting is withdrawn.

(3) That reissue letters patent of the United States issued to John G. Tufford, assignor, to the complainant herein, on the 11th day of January, 1916, for improvements in resilient heels, No. 14049 and issued to the complainant, The I. T. S. Rubber Company, are good and valid in law, particularly as to claims five (5) to ten (10) both inclusive.

(4) That the said John G. Tufford was the first, true and original inventor of the invention and improvements, described and claimed in said letters patent, and particularly recited in said claims five (5) to ten (10) both inclusive.

(5) That the complainant, The I. T. S. Rubber Company is the lawful owner of said letters patent.

(6) That the defendant has infringed on the said letters patent and particularly on the said claims five (5) to ten (10) both inclusive, and upon the exclusive rights of the complainant under the same, by the sale of heels introduced in evidence as plaintiff's Exhibit—"Defendant's Heels, Tight Edge."

(7) That a perpetual injunction issue out of and under the seal of this Court, directed to the said defendant, Jones & Rosser, a co-partnership, consisting of Richard S. Jones and Edward J. Rosser, their associates, directors, officers, attorneys, clerks, agents, servants, workmen and other employees, enjoining and restraining them and each of them, from directly or indirectly making or causing to be made, using or causing to be used, or vending to others to be used, in any manner, any article, device, apparatus, or resilient heels or heel lifts, containing, embodying or employing the said inventions and improvements granted by the said letters patent, and particularly claimed in the said claims five (5) to ten (10) both inclusive, thereof, or any resilient heel or resilient heel lift capable of or adapted to be used in infringement of said claims or from infringing upon or violating the said letters patent in any way whatsoever.

(8) That the complainant do recover of the defendant, its costs in this suit to be taxed.

Arthur J. Tuttle, Judge.

[fol. 249] O. K. Approved. E. D. Fales, Attorney for Plaintiff. Angell, Turner & Dyer, Attorneys for Defendants.

Filed Nov. 1st, 1920. Elmer W. Voorheis, Clerk, by Mary J. Dealy, Deputy Clerk.

UNITED STATES OF AMERICA,
Eastern District of Michigan,
Southern Division, ss:

I, Arthur J. Tuttle, United States District Judge for the Eastern District of Michigan, do hereby certify that Elmer W. Voorheis is Clerk of the United States District Court for the Eastern District of Michigan on this Twenty-Seventh day of November, A. D. 1920, and has been such Clerk continuously from the first day of January, A. D. 1912, and that all his acts as such Clerk are entitled to full faith and credence.

Witness, my hand, at Detroit, in said District, this Twenty-Seventh day of November in the year of our Lord one thousand nine hundred and twenty, and of the Independence of the United States of America the one hundred and forty-fifth.

Arthur J. Tuttle, United States District Judge.

UNITED STATES OF AMERICA,
Eastern District of Michigan,
Southern Division, ss:

I, Elmer W. Voorheis, Clerk of the District Court of the United States for the Eastern District of Michigan, do hereby certify that the Honorable Arthur J. Tuttle, is United States District Judge for the Eastern District of Michigan, and that the signature attached to the foregoing certificate is the genuine signature of said Judge.

In Testimony Whereof, I have hereunto set my hand and affixed the seal of said Court, at Detroit, in said District, this twenty-seventh day of November, in the year of our Lord one thousand nine hun-
[fol. 250] dred and twenty, and of the Independence of the United States of America the one hundred and forty-fifth.

Elmer W. Voorheis, Clerk United States District Court for the Eastern District of Michigan. (Seal.)

UNITED STATES OF AMERICA,
Eastern District of Michigan, ss:

I, Elmer W. Voorheis, Clerk of the District Court of the United States for the Eastern District of Michigan, do hereby certify that the above and foregoing is a true copy of Bill of Complaint, Order to Show Cause, Affidavit of John G. Tufford, Affidavit of Frank M. Slough, Order to take Bill Pro Confesso, Decree Pro Confesso, Perpetual Injunction, and Final Decree, in the therein entitled cause as the same appears on file and of record in my office; that I have compared the same with the original, and it is a true and correct transcript therefrom and of the whole thereof.

In Testimony Whereof, I have hereunto set my hand and affixed the seal of said Court, at Detroit, in said district, this twenty-seventh day of November, in the year of our Lord one thousand nine hundred and twenty, and of the Independence of the United States of America the one hundred and forty-fifth.

[SEAL.] Elmer W. Voorheis, Clerk.

[Endorsed:] 1008 Eq. No. 326. The District Court of the United States, Eastern District of Michigan, Southern Division. The I. T. S. Rubber Company vs. Jones & Rosser, a Co-partnership consisting of Richard S. Jones and Edward J. Rosser. Certified Copy of Bill of Complaint, Order to Show Cause, Affidavit of John G. Tufford, Affidavit of Frank M. Slough, Order to Take Bill Pro Confesso, Decree Pro Confesso, Perpetual Injunction, and Final Decree. United States District Court, Mass. Dist. Filed in Clerk's Office Dec. 6, 1920. Jones & Rosser. No appearance—no answers. Stipulation as to profits is filed by pl'f's counsel.

[fol. 251] PLAINTIFF'S EXHIBIT 20

UNITED STATES DISTRICT COURT, EASTERN DISTRICT OF MICHIGAN.
SOUTHERN DIVISION

In Equity. 325

THE I. T. S. RUBBER COMPANY, Plaintiff,

vs.

WALTER WENDT, Doing Business as Walter Wendt & Company, Defendant

Tufford Reissue Patent No. 14049

Bill of Complaint

To the Honorable the Judges of the District Court for the Eastern District of Michigan, Southern Division:

The Plaintiff, for its bill of complaint, says:

(1) This is a suit in equity, arising under the patent laws of the United States.

(2) Plaintiff is a corporation organized and existing under the laws of the State of Ohio and having a regular and established place of business in Elyria, O., and the defendant, Walter Wendt, is an individual, doing business as Walter Wendt & Co., at 911 Canton Ave., Detroit, Mich., within the said district wherein the acts of infringement herein complained of were committed.

(3) John G. Tufford, being within the meaning of the statutes of the United States, the first, true, original and sole inventor of certain improvements in Resilient Heels which had not been known or used by others in this country before his invention or discovery thereof, or more than two years prior to his application to the United States Patent Office for a patent therefor, and not patented or described in any printed publication in this or any foreign country before his invention or discovery thereof, or more than two years prior to his application, and which had not been in public use or on sale in this country for more than two years prior to his said application, and which had not been abandoned, and not patented or caused to be patented by him or his legal representatives or assigns in any foreign country upon an application therefor, filed more than twelve months prior to the filing of his said application [fol. 252] for Letters Patent in the United States, and being entitled to a patent therefor under the provisions of said statutes, duly applied to the Commissioner of patents of the United States for Letters Patent thereon, on July 21, 1913. Thereafter, and prior to the issue of the herein-mentioned original patent from said application, the said Tufford assigned by instruments in writing, duly recorded

in the United States Patent Office, one-sixth of his entire right, title and interest in said application and in said invention to Carl H. Ingwer, of Elyria, Ohio, one-sixth thereof to Arthur G. Smith, of Elyria, Ohio, and one-twelfth thereof to Wm. C. Smith, of Elyria, Ohio, and requested that the patent so issue. All the requirements of the statutes then in force having been complied with, there were issued, under date of Sept. 15, 1914, to the said Tufford, Ingwer, A. G. Smith and W. C. Smith, United States Letters Patent No. 1,110,730, for such improvements, whereby there was secured to said Tufford, Ingwer, A. G. Smith and W. C. Smith, their legal representatives and assigns, for the term of seventeen years from Sept. 15, 1914, the exclusive right to make, sell and use said improvements.

Thereafter, on Oct. 9, 1914, prior to the issue of the hereinaftermentioned Reissue patent, the said Tufford, Ingwer, A. G. Smith and W. C. Smith assigned by another instrument in writing, dated Oct. 9, 1914, and duly recorded in the United States Patent Office, all of the right, title and interest in said patent No. 1,110,730 and to the said Tufford improvement in resilient heels to the plaintiff herein.

(4) Thereafter, on the 22nd day of June, 1915, for good and lawful cause, plaintiff herein surrendered said original Letters Patent No. 1,110,730 to the Commissioner of Patents, and having made due application therefor on June 22, 1915, and having in all things complied with the acts of Congress in such cases made and provided, said original Letters Patent were cancelled and new Letters Patent, which were marked "Reissued Jan. 11, 1916, # 14,049" were on Jan. 11, 1916, in due form of law, issued to the plaintiff, which said mentioned reissued Letters Patent are of record in the Patent Office of the United States, and which (or a certified copy thereof) is [fol. 253] ready here in Court to be produced. (Copy of Reissue patent attached.)

(5) Since the date of said last named assignment conveying the rights to the plaintiff herein, and since Jan. 11, 1916, the plaintiff has been and is now possessed of all the right, title and interest in and to said invention and said reissued Letters Patent, and entitled to all the benefits thereof.

(6) And plaintiff further shows that the plaintiff recovered a decree on said Letters Patent in suit in the District Court of the United States, for the Northern District of Ohio, Eastern Division, against Fetzer & Spies Leather Co., which decree was sustained by the United States Circuit Court of Appeals for the Sixth Circuit; and further, that plaintiff did recover a decree upon said Letters Patent in suit in the District Court of the United States for the Northern District of Ohio, Eastern Division against The Elyria National Rubber Heel Company; and the plaintiff did recover a decree upon said Letters Patent here in suit in the District Court of the United States for the Northern District of Ohio, Eastern Division against United States Rubber Company, which was sustained

by the United States Circuit Court of Appeals for the Sixth Circuit. And thereafter the plaintiff did recover a decree upon said Letters Patent in suit in the District Court of the United States for the Northern District of Ohio, Eastern Division against The Hill Rubber Heel Company, and in the same Court, a consent decree against The Consolidated Rubber Company.

(7) Since Jan. 11, 1916, the date of the reissue of said Letters Patent, and prior to the filing of this Bill of Complaint, the defendant, Walter Wendt, within the Eastern District of Michigan, sold, or caused to be sold, or used, or caused to be used, resilient heels (and particularly the Essex Tite-Edge heels), which embody the improvement described in said Reissue Letters Patent # 14,049, and described by the claims thereof held valid by the Circuit Court of Appeals for the Sixth Circuit, unlawfully and without the license of plaintiff, and in infringement of said Letters Patent and plaintiff's rights thereunder, all unlawfully and without the license of said plaintiff, and said defendant threatens to continue said infringe-
[fol. 254] ment, plaintiff is informed and believes; wherefore, plaintiff prays that the defendant may be required to make full discovery of the gains from such infringement.

Claims 5 to 9, inclusive, are infringed.

(8) The plaintiff has marked its resilient heels with the word "Patented" and the number and date of the reissued patent here in suit. Th defendant has infringed said patent since plaintiff's heels, so marked with the word "Patented" and the date of the reissue patent, have been distributed.

(9) But for the wrongful acts of this defendant, the plaintiff would be able to make, use or sell the improvements claimed in such Reissue patent with greater profit and advantage. By such wrongful acts of said defendant, the plaintiff, having no adequate remedy at law, is suffering irreparable damage, and is threatened with continued irreparable damage, unless this infringement by defendant is restrained by order of Court.

Wherefore, the plaintiff prays:

1. For such preliminary and perpetual injunction against infringement of said reissued Letters Patent as to this Court may seem just.

2. For an accounting of damages and profits due to such infringement, and that defendant may be compelled to pay over to the said plaintiff said damages, as well as the profits.

3. For costs.

4. And for such other relief as to equity may seem just.

5. The plaintiff further prays for a writ of subpœna ad respondendum, directed to the defendant, Walter Wendt, commanding him to appear and make answer to the Bill of Complaint (but not under

oath, an answer under oath being hereby waived), and to perform and abide by such orders and decrees herein as to this Court may seem required by the principles of equity and good conscience.

The I. T. S. Rubber Company, by John G. Tufford, President. F. O. Richey, E. D. Fales, Counsel for Plaintiff. Campbell, Buckley & Ledyard, Solicitors for Plaintiff.

[fol. 255] STATE OF OHIO,
Lorain County, ss:

John G. Tufford, being duly sworn, deposes and says that he is President of The I. T. S. Rubber Company, the corporation named as plaintiff in the foregoing Bill of Complaint subscribed by him; that he has read said Bill and knows the contents thereof; that the same are true, except as to matters alleged on information and belief, and as to such matters he believes the complaint to be true; and that he verily believes himself to be the first, original and sole inventor of the improvements set forth in the patent in suit.

J. G. Tufford.

Subscribed and sworn to before me this 29th day of February, 1920. John S. Richey, Notary Public. (Seal.)

Filed April 1st, 1920. Elmer W. Voorheis, Clerk, by Carrie Davison, Deputy.

[Copy of Letters Patent Reissued to J. G. Tufford, No. 14049, June 11, 1916. Attached to Original Bill of Complaint.]

Return on Service of Writ

UNITED STATES OF AMERICA,
Eastern District of Michigan, ss:

I hereby certify and return that I served the Within Bill of Complaint, Order to Show Cause & Affidavits on the therein-named Walter Wendt, doing business as Walter Wendt & Company by handing to and leaving a copy thereof with Walter Wendt personally at Detroit in said District on the 6th day of April, A. D. 1920.

Henry Behrendt, U. S. Marshal, by Henry Walters, Deputy.

Filed April 10, 1920. Elmer W. Voorheis, Clerk, by Carrie Davison, Deputy.

[fol. 256] UNITED STATES DISTRICT COURT, EASTERN DISTRICT OF MICHIGAN

In Equity. No. 325

THE I. T. S. RUBBER COMPANY, Plaintiff,

vs.

WALTER WENDT, Doing Business as Walter Wendt & Company, Defendant

Affidavit of John G. Tufford

STATE OF OHIO,
Lorain County, ss:

John G. Tufford, being first duly sworn, deposes and says:

I am of mature age and am at present employed as President of the plaintiff company at Elyria, O. I invented the heel shown in the patent in suit. I testified in the case of The I. T. S. Rubber Co. vs Fetzer & Spies Leather Co. No. 435 in this Court, and furnished affidavits in the cases of The I. T. S. Rubber Co. v. The Elyria National Rubber Heel Co., United States Rubber Co., The Hill Rubber Heel Co., H. H. Hackman & Co., The Thomas Urbansky & Sons Co., The Fornes-Helms Leather Co. and John Piatek & Company.

Prior to my present incumbency, I was, for about thirty-five years, an ordinary shoe cobbler in Elyria, O., and in my work I learned of the disadvantages of the then universally used flat rubber heel, such as the O'Sullivan.

The following are some of the objections to the flat heels: The nails are deeply counter-sunk, as in all rubber heels, and when driven, the rubber is pinched out from under the nail and caused to bubble out at the side, or forces up the side, opening the seam, as shown in Exhibit # 1a. The nails and washers are placed close to the edge, in an effort to nail down the seam. Cement is employed, in order to try to fasten the rubber heel to the leather heel necessitating the smoothing off of the leather heel and taking in all about twenty minutes to complete the job. The cement soon gives way and the seam opens, making an unsightly joint and permitting dirt and water to leak in, or actually drawing it in, which [fol. 257] makes the shoe filthy and often foul, and which is often squirted out in the house. The nails and washers, being close to the edge, limit the trimming area, requiring the shoemaker to carry a large stock, as he must have a heel for practically every size of shoe heel, and these sizes are almost innumerable.

The life of the flat heel was short, because one soon wore into the washer which scraped on the floor.

There were many other objections to the flat heel, which are set forth in my testimony in the other cases. To remedy these faults,

I invented the plaintiff's heel, like "Plaintiff's Exhibit, Plaintiff's Heels," which is concavo-convex in such a way that when it is nailed to the shoe by the centrally arranged nails, it is flattened out, and in tending to regain its form, constantly grabs hold of the bottom of the shoe by suction action, as indicated in Exhibit 3a, in such a way that the seam is permanently sealed without the use of cement. The cobbler attaches the heel in a few minutes. In addition, the washers are moved in so as to present a greater trimming area, lengthening the life of the heel, etc. These and other advantages are described in detail in my testimony in the Fetzer & Spies Case.

The patented heel is made without the metal plate, so often used in the prior art heels, and which doomed them to failure from the beginning.

After making the invention, I did not have money enough to proceed with it, as I was very poor. Finally, I succeeded in inducing Mr. Arthur G. Smith and Mr. Carl H. Ingwer, who were at that time clerks in a retail shoe store, to raise enough money to apply for a patent. The three of us succeeded in gathering together about $23,000 from friends in Elyria. We then hired a bookkeeper and with this capital, we embarked upon our enterprise in the first part of 1915.

The success has been phenomenal. In all, we have sold about 120,000,000 heels, the rise being more or less gradual and increasing from month to month, until we are selling between four and five million heels every month at the present time; or, putting it [fol. 258] another way, we are selling between ten and twelve tons of rubber heels every day. Our manufacturing equipment is being workd twenty-four hours every day.

There have been numerous infringements, as is indicated by the number of suits in which I have testified or given affidavits. The commercial success of the device is recited more in detail in the testimony which I gave in the Fetzer & Spies Case.

We have done practically no advertising to the public, and what little we have done, has been to the cobblers to whom the heel is a great boon. This type of heel is known to the cobbler as a suction heel, and can be found in most any cobbler's shop. Any one entering most any cobbler's shop and asking about the I. T. S. heel will learn from the cobbler of its advantages and of its improvement over the O'Sullivan and the other prior art heels.

I have examined and tested the heels constituting "Plaintiff's Exhibit Defendant's Tite-Edge Heels" and find them concaved in a curved manner upon the bottom, the same as our heel and concaved on the top in a broken curve, instead of in a continuous curve. The attaching face is curved in all directions from the center towards the edge in all of the larger, and most of the smaller heels, and in others there is the clear equivalent when attached.

The attaching faces of all the heels lie entirely below a plane passing through the rear upper edge and breast corners of the lift. The attaching face is so shaped that there is a somewhat centrally disposed low spot, so that if the upper edges of the lift are put in

contact with the horizontal bottom of the heel, as far as may be without using force to distort the normal shape of the lift, any contained liquid would be retained in this lowest spot, because the edge of the lift towards the breast of the heel is higher.

Where the heels are well made, they adhere to a flat surface when smoothed out thereon. The nail holes are around the center, and when the heel is nailed onto a shoe, it operates just as the patented heel, in clinging to the edges of the shoe heel and grabbing hold of the shoe.

[fol. 259] All the advantages of the Tufford heel are realized. They are attached without cement, thereby saving the time of attaching the heel to the shoe; the seam is permanently sealed; in fact, the heel is called the Tite-Edge heel; a wide trimming area is provided; the heel is cheap and easy to make, soft and resilient; the nail holes are staggered with respect to the nail holes in the leather heel.

The heels are devoid of plates and other objectionable devices. Washers are employed, as in the plaintiff's heels, and the washers are located in the same positions as in the plaintiff's heels of corresponding size.

I identify the heels marked "Plaintiff's Exhibit USCO heels", as like those held to infringe by the United States Circuit Court of Appeals in the Sixth Circuit, in United States Rubber Co. Case.

I identify the heels marked "Plaintiff's Exhibit National Heel", as like the heels held to infringe by Judge Westenhaver in the National Case.

I identify the heel marked "Plaintiff's Exhibit Hill Heel" as like the heel held to infringe in the Hill Case.

Heels like the heels constituting "Plaintiff's Exhibit, Defendant's Heels" in the instant case were held to infringe in the case of H. H. Hackman & Co and The Thomas Urbansky & Sons Co., though there was no appearance for defendant. In the Hackman Case infringement was held on motion for preliminary injunction, in which the plaintiff appeared and argued, but there was no appearance for the defendant. The defendants, H. H. Hackman & Co., defaulted in that case, as did defendant in the case of The I. T. S. Rubber Co. v. The Thomas Urbansky & Sons Co. and The I. T. S. Rubber Co. v. John Piatek & Co.,—the first two cases in the Eastern Division, and the last in the Western Division of the Northern District of Ohio, I am informed and believe.

The continued infringement by the defendant will do irreparable damage to the plaintiff, who is now prepared to supply the demand for the patented heel lifts. Indeed the plaintiff and The Miller Rubber Company, who manufactures the heels for the plaintiff, have spent large sums of money in preparing to supply [fol. 260] the market and in relying upon the patent in suit. The patent has already run some years, and its life is being shortened, of course, year by year. The patent has been sustained in two separate cases by the Court of Appeals in this circuit.

Plaintiff has always marked its heels with the number and date of the patent, and the defendant had notice of the infringement.

J. G. Tufford.

Sworn to before me and subscribed in my presence this 29th day of March, 1920. John S. Richey, Notary Public.

Filed April 1st, 1920. Elmer W. Voorheis, Clerk, by Carrie Davison, Deputy Clerk.

UNITED STATES DISTRICT COURT, EASTERN DISTRICT OF MICHIGAN

In Equity. No. 325

THE I. T. S. RUBBER COMPANY, Plaintiff,

vs.

WALTER WENDT, Doing Business as Welter Wendt & Company, Defendant

Affidavit of Frank M. Slough

STATE OF OHIO,
Lorain County, ss:

Frank M. Slough, being duly sworn, deposes and says:

I am of mature age and reside at Elyria, O.

On Feb. 3, 1920, Walter Wendt, the defendant herein, sold me the heels numbered 5-O, 0-F, 2-F, 4-OW, OOW, 1-W, 3-W and 5-W, which are included in "Plaintiff's Exhibit, Defendant's Tite-Edge Heels", at 911 Canton Ave., Detroit, Mich. I bought these heels from the said Walter Wendt on the said day and paid him for them.

The defendant at that time, had on sale, at 911 Canton Ave., Detroit, Mich., many other heels like those I have mentioned above, and including heels like those marked 5-M, 6-M, 7-M, [fol. 261] 8-M and 10-M of "Plaintiff's Exhibit, Defendant's Tite-Edge Heels".

Frank M. Slough.

Sworn to before me and subscribed in my presence this 29th day of March, 1920. John S. Richey, Notary Public. (Seal.)

Filed April 1st, 1920. Elmer W. Voorheis, Clerk, by Carrie Davison, Deputy Clerk.

UNITED STATES DISTRICT COURT, EASTERN DISTRICT OF MICHIGAN, SOUTHERN DIVISION. IN EQUITY

Equity. No. 325

THE I. T. S. RUBBER COMPANY, Plaintiff,

vs.

WALTER WENDT, Doing Business as Walter Wendt & Company, Defendant

Order to Take Bill pro Confesso

The subpœna in the above-entitled cause having been returned, which return has been filed, and it appearing therefrom that the said subpœna was duly served on the defendant, Walter Wendt, and no appearance having been entered on the part of said defendant, or answer or other pleading filed, although such appearance should have been entered or pleading filed on or about the 26th day of April, 1920; therefore, on motion of Campbell, Bulkley and Ledyard, Solicitors for the plaintiff, it is ordered and decreed that the Bill herein be taken pro confesso as to said defendant.

Arthur J. Tuttle, District Judge.

Detroit, Mich., May 3, 1920.

Filed May 3d, 1920. Elmer W. Voorheis, Clerk.

[fol. 262] UNITED STATES OF AMERICA:

DISTRICT COURT OF THE UNITED STATES FOR THE EASTERN DISTRICT OF MICHIGAN, SOUTHERN DIVISION

In Equity

At a session of said Court, held in the Court Room, in the City of Detroit, in said District, on the 1st day of April, 1920.

Present: Hon. Arthur J. Tuttle District Judge.

No. 325

THE I. T. S. RUBBER COMPANY, Plaintiff,

vs.

WALTER WENDT, Doing Business as Walter Wendt & Company, Defendant

Order to Show Cause

Upon reading and filing the bill of complaint herein and the affidavits of John G. Tufford and Frank M. Slough; and

On motion of Campbell, Bulkley & Ledyard, attorneys for the plaintiff herein;

It is Ordered that said Walter Wendt, doing business as Walter Wendt & Company, do show couse to this Court, at the opening of court, on the 19th day of April, 1920, if any cause there be, why an injunction should not issue herein, as prayed for in said bill of complaint.

It is Further Ordered that the defendant be, and hereby is given up to and including the 9th day of April, 1920, for the filing and serving of such affidavits as he may desire, if any, in support of his position; and that thereafter said plaintiff be given up to and including the 17th day of April, 1920, for the filing of such counter-affidavits, if any, as it may desire.

And it is Further Ordered that a copy of this order and of the bill of complaint and affidavits aforesaid, be served on said defendant.

Arthur J. Tuttle, District Judge.

Filed April 1st, 1920. Elmer W. Voorheis, Clerk, by Carrie Davison, Deputy Clerk.

[fol. 263] UNITED STATES DISTRICT COURT, EASTERN DISTRICT OF MICHIGAN, SOUTHERN DIVISION

In Equity. No. 325

THE I. T. S. RUBBER COMPANY, Plaintiff,

vs.

WALTER WENDT, Doing Business as Walter Wendt & Company, Defendant

Decree pro Confesso

It appearing to the Court that the Bill in Equity in the above-entitled cause was filed in the Court on the first day of April, 1920, and that a subpœna was issued and duly served on the defendant herein; that no appearance has been entered on the part of the defendant or motion, or answer filed, and that an order taking the said Bill pro confesso was duly entered on the third day of May, 1920, in the order book, and that no proceedings have been had or taken by said defendant, since such order was taken; now therefore, more than thirty days after entering said order as aforesaid, to wit, on the third day of May, 1920, it is hereby ordered, adjudged and decreed as follows:

That Reissue Letters Patent of the United States in the name of John George Tufford, assignor by direct and mesne assignments to the plaintiff herein, for improvements in Resilient Heels, No. 14,049, and issued to the plaintiff herein, The I. T. S. Rubber Company, on January 11, 1916, being the Letters Patent referred to in the Bill of Complaint herein, are good and valid as respects claims 5 to 9, both inclusive.

That the said John George Tufford was the first and original inventor and discoverer of the improvements in resilient heels, as described in said Letters Patent and specification annexed thereto and claimed in said claims five (5) to nine (9) both inclusive.

That the plaintiff, The I. T. S. Rubber Company is the lawful owner of said Letters Patent.

That Walter Wendt, doing business as Walter Wendt & Company, has infringed upon claims five (5) to nine (9) both inclusive of said [fol. 264] Letters Patent and upon the exclusive rights of the plaintiff under the same; that is to say, by the use and by the sale of resilient heels embodying the said invention and improvement patented as aforesaid, charged in said Bill of Complaint.

It is further ordered, adjudged and decreed that the plaintiff do recover of the defendant the profits, gains and advantages which the said defendant have received or made, or which have arisen or accrued to him by the use or by the sale of sundry resilient heels in violation of claims five (5) to nine (9) both inclusive of said Letters since Jan. 11, 1916, and that the plaintiff do recover the damages resulting from the said infringement.

It is further ordered, adjudged and decreed that the cause be referred to William S. Sayres, Jr., a commissioner of this court, residing in the city of Detroit, Michigan, as master pro hac vice, his experience in such matters being found by the Court a sufficient reason for such appointment, to ascertain, and take, and state and report to the Court an account of the number of resilient heels embodying said invention and improvement as described and secured in claims (5) to nine (9) both inclusive of said Letters Patent which have been sold and caused to be sold and used and caused to be used by said defendant, and also the gains, profits and advantages which the said defendant has received, or which has arisen or accrued to him since Jan. 11, 1916, the date of the issue of said Letters Patent in suit, from infringing the exclusive rights of the said plaintiff by the use or sale, or by having caused to be used or sold said improvement in resilient heels secured by claims five (5) to nine (9) both inclusive of said Letters Patent, and the damages which the plaintiff has suffered by such infringement, and

It is further ordered, adjudged and decreed that the plaintiff on such accounting have the right to cause the examination of the said defendant, his associates, clerks, agents, servants, workmen and other employees, ore tenus, or otherwise, and also the production of books, vouchers and documents of defendant, and that the said defendant attend for such purposes before said master, from time to time, as such master shall direct, and

[fol. 265] It is further ordered, adjudged and decreed, that a perpetual injunction be issued in this suit against the said defendant, restraining him, his associates, attorneys, clerks, agents, servants, workmen and other employees, enjoining and restraining them, and each of them, from directly or indirectly using, or causing to be used, or selling or causing to be sold, in any manner, any article, device, apparatus, or resilient heels or heel lifts contain-

ing, embodying or employing the said inventions and improvements granted by the said Letters Patent, and embracing the invention and improvement described in claims five (5) to nine (9) both inclusive, or any resilient heel capable of or adapted to be used in infringement of said claims, or from infringing upon or violating the said Letters Patent in any way whatsoever.

It is further ordered, adjudged and decreed that the plaintiff do recover of the defendant the costs in this suit to be taxed.

Arthur J. Tuttle, District Judge.

Detroit, Mich., June 17, 1920.

Filed June 17, 1920. Elmer W. Voorheis, Clerk.

UNITED STATES DISTRICT COURT, EASTERN DISTRICT OF MICHIGAN, SOUTHERN DIVISION

In Equity. No. 325

THE I. T. S. RUBBER COMPANY, Plaintiff,

vs.

WALTER WENDT, Doing Business as Walter Wendt & Company, Defendant

Perpetual Injunction

The President of the United States of America to Walter Wendt, doing business as Walter Wendt & Company, his associates, clerks, agents, servants, workmen, and other employees, Greeting:

Whereas, it has been represented to us in our District Court of the United States, the Eastern District of the State of Michigan, Southern Division, that the Reissued Letters Patent of the United States of America, in the name of John George Tufford, assignor [fol. 266] by direct and mesne assignments to the plaintiff herein, for improvement in resilient heels No. 14,049 and issued to the plaintiff herein, The I. T. S. Rubber Company, on Jan. 11, 1916, of which the plaintiff is the sole and exclusive owner, and that the plaintiff is also the owner of all the rights to recover damages and profits from all infringements of said Letters Patent; and that the said Letters Patent are good and valid and have been infringed by the defendant herein, by the use and by the sale of resilient heels embodying said invention and improvement patent as aforesaid and charged in said Bill of Complaint.

Now, therefore, we do strictly command and enjoin and restrain the said Walter Wendt, doing business as Walter Wendt & Company, your associates, clerks, agents, servants, workmen and other employees, and each of you, for the remainder of the term of the life of said Letters Patent, from further directly or indirectly infringing the same, and from directly or indirectly selling or causing to be sold, or using or causing to be used, any article, device,

apparatus or resilient heels or heel lifts, in any manner containing, embodying or employing the inventions and improvements aforesaid, in said Letters Patent and particularly claimed in claims five (5) to nine (9) both inclusive thereof, of any resilient heels or heel lifts capable of or adapted to be used in infringement of said claims, or from infringing upon or violating the said Letters Patent in any way whatsoever.

Witness the Honorable Arthur J. Tuttle, Judge of the district court of the United States, this 17th day of June, 1920, and in the 144th year of the Independence of the United States of America.

Attest:

Elmer W. Voorheis, Clerk. (Seal.)

Filed June 24th, 1920. Elmer W. Voorheis, Clerk, by Carrie Davison, Deputy.

Return on Service of Writ

UNITED STATES OF AMERICA,
Eastern District of Michigan, ss:

I hereby certify and return that I served the annexed Perpetual Injunction on the therein-named Walter Wendt, Doing business [fol. 267] as Walter Wendt & Co. by handing to and leaving a true and correct copy thereof with him personally at Detroit in said District on the 17th day of June, A. D. 1920.

Henry Behrendt, U. S. Marshal, by Henry Walters, Deputy.

UNITED STATES DISTRICT COURT, EASTERN DISTRICT OF MICHIGAN, SOUTHERN DIVISION

In Equity. No. 325

THE I. T. S. RUBBER COMPANY, Plaintiff,

vs.

WALTER WENDT, Doing Business as Walter Wendt & Company, Defendant

Stipulation

It is hereby stipulated and agreed by and between the parties that:

(1) The defendant will pay at once to the plaintiff, One Thousand Dollars ($1,000.00) in cash;

(2) The plaintiff will accept such One Thousand Dollars ($1,000.-00) in lieu of profits made by this defendant upon the infringing Essex Tight-Edge Heels sold by said defendant, and for damages as the result of such profits.

(3) It is stipulated that said One Thousand Dollars ($1,000.00) is paid and accepted in lieu of the profits of this defendant only on such heels, and the damages occasioned by the sale of such heels by this defendant only.

(4) Is it stipulated that there shall be no Appeal from the Final Decree of this Court in this case.

F. O. Richey, E. D. Fales, Counsel for Plaintiff. Sept. 13, 1920. Angel & Turner, Counsel for Defendant. Sept. 13, 1920.

Filed Nov. 1st, 1920. Elmer W. Voorheis, Clerk.

[fol. 268] UNITED STATES DISTRICT COURT, EASTERN DISTRICT OF MICHIGAN, SOUTHERN DIVISION

In Equity. No. 325

THE I. T. S. RUBBER COMPANY, Plaintiff,

vs.

WALTER WENDT, Doing Business as Walter Wendt & Company, Defendant

Final Decree

At a session of the District Court of the United States, in and for the Eastern District and Southern Division of Michigan, continued and held in the District Court Room in the City of Detroit, in said district, on Monday the first day of November, in the year of our Lord, one thousand nine hundred and twenty.

Present, the Hon. Judge Arthur J. Tuttle, United States District Judge.

Pursuant to a stipulation filed by Counsel in this cause, it is ordered and decreed as follows:

(1) That the defendant having made settlement of all claims or profits arising hereunder in the sum of One Thousand Dollars, ($1,000.00), the reference to the Master is withdrawn, and

(2) That the plaintiff do recover of the defendant, in lieu of *of* profits made by this defendant, from its sale of the Essex Tight-Edge infringing heels, One Thousand Dollars ($1,000.00). In view of the stipulation, the Order for Accounting is withdrawn.

(3) That reissue letters patent of the United States issued to John G. Tufford, assignor, to the complainant herein, on the 11th day of January, 1916, for improvements in resilient heels, No. 14,049 and issued to the complainant, The I. T. S. Rubber Company, are good and valid in law, particularly as to claims five (5) to ten (10) both inclusive.

(4) That the said John G. Tufford was the first, true and original inventor of the invention and improvements, described and claimed in said letters patent, and particularly recited in said claims five (5) to ten (10) both inclusive.

[fol. 269] (5) That the complainant, The I. T. S. Rubber Company is the lawful owner of said letters patent.

(6) That the defendant has infringed on said letters patent and particularly on the said claims five (5) to ten (10) both inclusive, and upon the exclusive rights of the complainant under the same, by the sale of heels introduced in evidence as plaintiff's Exhibit—"Defendant's Heels, Tight Edge."

(7) That a perpetual injunction issue out of and under the seal of this Court, directed to the said defendant, Walter Wendt, doing business as Walter Wendt and Company, his associates, directors, officers, attorneys, clerks, agents, servants, workmen and other employees, enjoining and restraining them and each of them, from directly or indirectly making or causing to be made, using or causing to be used, or vending to others to be used, in any manner, any article, device, apparatus, or resilient heels or heel lifts, containing, embodying or employing the said inventions and improvements granted by the said letters patent, and particularly claimed in the said claims five (5) to ten (10) both inclusive, thereof, or any resilient heel or resilient heel lift capable of or adapted to be used in infringement of said claims or from infringing upon or violating the said letters patent in any way whatsoever.

(8) That the complainant do recover of the defendant, its costs in this suit to be taxed.

Arthur J. Tuttle, Judge.

UNITED STATES OF AMERICA,
Eastern District of Michigan,
Southern Division, ss:

I, Arthur J. Tuttle, United States District Judge for the Eastern District of Michigan, do hereby certify that Elmer W. Voorheis is Clerk of the United States District Court for the Eastern District of Michigan on this Twenty-Seventh day of November, A. D. 1920, and has been such Clerk continuously from the first day of January, A. D. 1912, and that all his acts as such Clerk are entitled to full faith and credence.

Witness, My hand, at Detroit, in said District, this Twenty-Seventh day of November in the year of our Lord one thousand nine hun-[fol. 270] dred and twenty, and of the Independence of the United States of America the one hundred and forty-fifth.

Arthur J. Tuttle, United States District Judge.

UNITED STATES OF AMERICA,
Eastern District of Michigan,
Southern Division, ss:

I, Elmer W. Voorheis, Clerk of the District Court of the United States for the Eastern District of Michigan, do hereby certify that

the Honorable Arthur J. Tuttle, is United States District Judge for the Eastern District of Michigan, and that the signature attached to the foregoing certificate is the genuine signature of said Judge.

In Testimony Whereof, I have hereunto set my hand and affixed the seal of said Court, at Detroit, in said District, this twenty-seventh day of November, in the year of our Lord one thousand nine hundred and twenty, and of the Independence of the United States of America the one hundred and forty-fifth.

Elmer W. Voorheis, Clerk United States District Court for the Eastern District of Michigan. (Seal.)

UNITED STATES OF AMERICA,
Eastern District of Michigan, ss:

I, Elmer W. Voorheis, Clerk of the District Court of the United States for the Eastern District of Michigan, do hereby certify that the above and foregoing is a true copy of Bill of Complaint, Affidavit of John G. Tufford, Affidavit M. Slough, Order to Take Bill Pro Confesso, Order to Show Cause, Decree Pro Confesso, Perpetual Injunction, Stipulation, and Final Decree, in the therein entitled cause as the same appears on file and of record in my office; that I have compared the same with the original, and it is a true and correct transcript therefrom and of the whole thereof.

In Testimony Whereof, I have hereunto set my hand and affixed the seal of said Court, at Detroit, in said District, this twenty-seventh day of November, in the year of our Lord one thousand nine hundred and twenty, and of the Independence of the United States of America the one hundred and forty-fifth.

Elmer W. Voorheis, Clerk. (Seal.)

[fol. 271] [Endorsed:] 1008, Eq. No. 325. The District Court of the United States, Eastern District of Michigan, Southern Division. The I. T. S. Rubber Company vs. Walter Wendt, doing business as Walter Wendt & Company. Certified Copy of Bill of Complaint, Affidavit of John G. Tufford, Affidavit of Frank M. Slough, Order to Take Bill Confesso, Order to Show Cause, Decree Pro Confesso, Perpetual Injunction, Stipulation, and Final Decree. United States District Court, Mass. Dist. Filed in Clerk's Office Dec. 6, 1920.

Plaintiff's Exhibit 21

In the District Court of the United States for the Northern District of Ohio, Eastern Division

In Equity. No. 514

The I. T. S. Rubber Company, Plaintiff,

vs.

The Thomas Urbansky & Sons Company, Defendant

Bill of Complaint

To the Honorable the Judges of the District Court of the United States for the Northern District of Ohio, Eastern Division:

The plaintiff for its Bill of Complaint says:

(1) This is a suit in equity, arising under the patent laws of the United States.

(2) Plaintiff is a corporation organized and existing under the laws of the State of Ohio, and a citizen of the United States and of the State of Ohio, having a regular and established place of business at Elyria, O., and the defendant, The Thomas Urbansky & Sons Company, is an Ohio corporation, having a regular and established place of business at No. 2364 Ontario St., Cleveland, O., within the said district wherein the acts of infringement herein complained of took place.

(3) John G. Tufford, being within the meaning of the statutes [fol. 272] of the United States, the first, true, original and sole inventor of certain improvements in Resilient Heels which had not been known or used by others in this country, before his invention or discovery thereof, or more than two years prior to his application to the United States Patent Office for a patent therefor, and not patented or described in any printed publication in this or any foreign country before his invention or discovery thereof, or more than two years prior to his application, and which had not been in public use or on sale in this country for more than two years prior to his said application, and which had not been abandoned, and not patented or caused to be patented by him or his legal representatives or assigns in any foreign country upon an application therefor, filed more than twelve months prior to the filing of his said application for Letters Patent in the United States, and being entitled to a patent therefor under the provisions of said statutes, duly applied to the Commissioner of Patents of the United States for Letters Patent thereon, on July 21, 1913. Thereafter, and prior to the issue of the herein-mentioned original patent from said application, the said Tufford assigned by instruments in writing, duly recorded in the United States Patent Office, one-sixth of his entire right, title and interest in said applica-

tion and in said invention to Carl H. Ingwer, of Elyria, O., one-sixth thereof to Arthur G. Smith, of Elyria, O., and one-twelfth thereof to Wm. C. Smith of Elyria, Ohio, and requested that the patent so issue. All of the requirements of the statute then in force having been complied with, there were issued under date of Sept. 15, 1915, to the said Tufford, Ingwer, A. G. Smith and W. C. Smith, United States Letters Patent No. 1,110,730, for such improvements, whereby there was secured to said Tufford, Ingwer, A. G. Smith and W. C. Smith, their legal representatives and assigns for the term of seventeen years, from Sept. 15, 1914, the exclusive right to make, sell and use said improvements.

Thereafter, on Oct. 9, 1914, prior to the issue of the hereinafter-mentioned Reissue Patent, the said Tufford, Ingwer, A. G. Smith and W. C. Smith assigned, by another instrument in writing, dated Oct. 9, 1914, and duly recorded in the United States Patent Office, [fol. 273] all of the right, title and interest in the said patent No. 1,110,730 and to the said Tufford improvement in resilient heels to the plaintiff herein.

(4) Thereafter, on the 22nd day of June, 1915, for good and lawful cause, plaintiff herein surrendered said original Letters Patent No. 1,110,730 to the Commissioner of Patents, and having made due application therefor on June 22, 1915, and having in all things complied with the acts of Congress in such cases made and provided, said original Letters Patent were cancelled and new Letters Patent, which were marked "Reissued Jan. 11, 1916, No. 14,949" were on Jan. 11, 1916, in due form of law, issued to the plaintiff, which said mentioned reissued Letters Patent are of record in the Patent Office of the United States, and which (or a certified copy thereof) is ready here in Court to be produced. (Copy of Reissue patent attached.)

(5) Since the date of said last named assignment conveying the rights to the plaintiff herein, and since Jan. 11, 1916, the plaintiff has been and is now possessed of all right, title and interest in and to said invention and said reissued Letters Patent, and entitled to all the benefits thereof.

(6) And the plaintiff further shows that in the month of September, 1917, Fetzer & Spies Leather Co., jobbers in shoe findings in the city of Cleveland, O., was selling rubber heels embodying the invention set forth in and in infringement and in violation of the rights of this plaintiff under the Letters Patent here in suit, said heels being marked "Catspaw" and made by the Foster Rubber Co.

(7) The plaintiff herein brought its Bill in Equity in the United States District Court for the Northern District of Ohio, Eastern Division, in Equity 435, complaining that such Fetzer & Spies Leather Co., was infringing and threatening further to infringe said Letters Patent. The heel sold by Fetzer and Spies Leather Co. was a substantial duplicate of the plaintiff's heels "K" and small "K" included in "Plaintiff's Exhibit, Plaintiff's Heels."

The defendant filed its answer to the Bill of Complaint of this plaintiff, denying the propriety of the reissue proceedings; denying [fol. 274] that the grounds upon which the Reissue was granted were proper grounds for reissuing a patent; denying ownership of the patent by the plaintiff, and infringement. The defendant further alleged that the reissue was for a different invention, and that Tufford was not the original and first inventor, for the reason that the Tufford invention had been previously invented, known or used in this country by the following: Cara S. Ferguson, of Columbus, O., at Columbus, O., Frederick Nerger, of Chicago, Ill., at Chicago, Ill., and Morgan & Wright, of Detroit, Mich., at Chicago, Ill. The defendant further averred that the subject-matter of the Tufford invention was previously patented or described in the following United States patents: C. S. Ferguson, No. 638,228, Dec. 5, 1899; F. Nerger, No. 661,129, Nov. 6, 1900; R. E. Foster, No. 777,653, Dec. 13, 1904; British patents to Jno. Cairns, No. 8205, Apr. 5, 1906, and Paul Stern, No. 8159, Apr. 7, 1913, and the defendant further averred that the subject-matter of the Tufford patent had been in public use or on sale for more than two years before Tufford's invention by the following: Cara S. Ferguson, of Columbus, O.; Frederick Nerger, of Chicago, Ill., at Chicago, Ill., and Morgan & Wright of Detroit, Mich., at Chicago, Ill.

(8) And thereafter, the defendant took the depositions of the following, in Chicago: Frederick Nerger, Wm. Holmes, Harry F. Nerger, Jos. Suarez, Jas. C. Bowman, Ralph A. Nerger, and at Detroit, John H. Mulloy, Otto Swanson, Stanley J. Pitlock, Wm. W. McMahan, Michael Jordan, and at Boston, Mass., Wm. M. Gunlock, which were offered in evidence at the trial.

And thereafter the case came to trial, about the 28th day of June, 1918. The following were called for the plaintiff: Arthur G. Smith, Arthur B. Taylor, John G. Tufford, Chas. F. Baker, Richard Griffiths, and W. G. Lerch; and the following for the defendant: Roland Spies, Edward H. Scribner. On rebuttal, the following testified for the plaintiff: Arthur G. Smith, Wm. G. Lerch, Carl H. Ingwer, Ferdinand F. Brooker, Jno. G. Tufford, Richard Griffiths and R. M. Eberhard.

Thereafter, the Court took the cause under consideration and on [fol. 275] Aug. 20, 1918, handed down the opinion, a copy of which is attached to this Bill and marked "Opinion of Judge Westenhaver in the Fetzer & Spies Case," and on Aug. 26, 1918, a decree was entered in the United States District Court for the Northern District of Ohio, Eastern Division, holding that the patent in suit was good and valid in law; that John G. Tufford was the first inventor of the improvement therein; that the I. T. S. Rubber Company was the lawful owner thereof; that the defendant had infringed, and enjoining the defendant from further infringement of said Letters Patent.

Thereafter an appeal was taken by the defendant from such decree to the United States Circuit Court of Appeals for the Sixth Circuit. About June 3, 1919, such appeal was heard, and on Oct. 7, 1919, the United States Circuit Court of Appeals for the Sixth

Circuit, per curiam, handed down the opinion, and wherein the Circuit Court of Appeals sustained the District Court in holding the Tufford patent valid and infringed.

(9) And the plaintiff further says that in the month of July, 1918, The Elyria National Rubber Heel Co., manufacturers of rubber heels, doing business in Elyria, O., was selling rubber heels embodying the invention set forth in and in infringement and in violation of the rights of the plaintiff under the Letters Patent here in suit. The plaintiff herein brought its Bill in equity in the United States District Court for the Northern District of Ohio, Eastern Division, suit in equity 457, complaining that such The Elyria National Rubber Heel Company was infringing and threatening further to infringe said Letters Patent.

The plaintiff filed a motion for a preliminary injunction to restrain the defendant from such infringement, and the said cause came on to be heard on such motions, affidavits and exhibits and other evidence submitted in connection with the motion, before his Honor, Judge Westenhaver. The plaintiff submitted affidavits of the following: John G. Tufford, Arthur G. Smith and Jos. Tufford. The defendant submitted affidavits of the following: Herman L. Beal, Herbert B. Bradshaw, Burton W. Cary, Albert L. Ely, Cara S. Ferguson, Roy J. Ferguson, Karl W. Klein, Miah [fol. 276] Marcus, C. L. Landon, Stephen R. Nichols, Wm. Noel, Clifford H. Oakley, Albert K. Pray, Robert H. Rice, Chester C. Shepherd, Hezzelton E. Simmons, Frank W. Whitcher and Frank L. Sessions. The plaintiff submitted rebutting affidavits of the following: Carl H. Ingwer, Alfred Lee, John G. Tufford, Arthur G. Smith and O. O. Smith.

The following patents were discussed by the expert Sessions on behalf the defendant:

U. S.	patent to	John G. Tufford,	No. 1,110,730
" "	reissue "	" " "	" 14,049
" "	patent "	Cara S. Ferguson,	638,228
" "	" "	Frederick Nerger,	661,129
" "	" "	A. B. Wilton,	24,269
" "	" "	E. A. Munger,	380,508
" "	" "	C. G. Hainline,	615,168
U. S.	patent to	H. O'Sullivan,	No. 625,897
" "	" "	W. E. Herbst,	658,441
" "	" "	W. W. Comingor,	663,865
" "	" "	J. C. Hale,	740,124
" "	" "	P. W. Pratt,	769,324
" "	" "	C. Yahraus et al.,	817,355
" "	" "	W. E. Herbst,	897,860
" "	" "	W. B. Arnold,	598,838
" "	" "	C. A. Reade,	119,407

Foreign Patents

British Patent No. 13,529 of 1889 to Gotllieb Schmidt.
German " " 198,456 of 1907 to Johann Brandenburger.

British	Patent No.	17,571 of 1909 to Tippette et al.
German	"	" 251,550 of 1911 to Sigmund Zala.
French	"	" 443,338 of 1912 to Jacques Giraud.
"	"	addition No. 17,279, dated Feb. 19, 1913.

The defendant's heel in the National Case is exemplified by "Plaintiff's Exhibit National Heel" filed with this Bill.

After the hearing, the cause was taken under consideration by the Court, and on Feb. 27, 1918, his Honor, Judge Westenhaver, [fol. 277] handed down the opinion, and on Nov. 9, 1918, a decree was entered, granting a preliminary injunction, restraining the defendant from further infringement of the patent. Thereafter such injunction was suspended, pending the appeal, on condition that defendant file a bond and deposit its gross profits with the clerk of said court, and thereafter the defendant appealed to the United States Circuit Court of Appeals for the Sixth Circuit, and such case is now pending unheard before such Court.

(10) And the plaintiff further says that in the month of January, 1919, United States Rubber Company, manufacturers of rubber heels, and doing business in Cleveland, O., was selling rubber heels like "Plaintiff's Exhibit United States Heels" filed herewith, embodying the invention set forth in and in infringement and in violation of the rights of the plaintiff under the Letters Patent here in suit. The plaintiff herein brought its Bill in equity in the United States District Court for the Northern District of Ohio, Eastern Division, suit in equity 470, complaining that such United States Rubber Co. was infringing and threatening to infringe said Letters Patent.

The plaintiff filed a motion for a preliminary injunction to restrain the United States Rubber Co. from such infringement. In support of such motion the plaintiff filed affidavits of John G. Tufford and F. O. Richey. In opposition to such motion, the defendant filed affidavits of the following: Ernest Hopkinson, Albert A. Summerville, Ernest B. Curtiss, Daniel E. Mansfield, Edward H. Scribiner, Wm. M. Gunlock, Frederick Abele, Edward S. Mitchell. The defendant answered, denying the validity of the reissue proceedings; denying that the invention patented in the Reissue was disclosed in the original Tufford patent; alleging that the Reissue was unduly and unlawfully expanded; alleging that Tufford had not exercised due diligence in discovering the inadvertence, accident or mistake in the issue of the original patent and in making application for the Reissue; alleging that the Tufford invention had been abandoned as to the public; alleging that the Reissue patent was unlawfully granted to cover subject-matter not included in the application for [fol. 278] the Reissue as filed, and not covered by the oath of the inventor; alleging that the Tufford patent was invalid and void for the reason that the claims in suit covered new matter not disclosed in the specification or drawing of the application for reissue, as filed; alleging that by changes and amendments during the prosecution of the Reissue application, the application as filed and sworn to was departed from in substance, so that the patent as issued and the claims in suit were not included in the oath of the applicant; alleging that

by reason of the rejection of claims in the original and reissue applications upon reference to patents of the prior art, the acquiescence of the applicant in such rejection and cancellation of rejected claims and amendments and changes incorporated in the claims, the plaintiff disclaimed as being of the invention of said Tufford Reissue Patent the form made and sold by the defendant, and that the plaintiff was estopped from asserting a construction of the claims in suit which would cover the defendant's heel.

Defendant denied infringement. Defendant alleged that the Tufford patent was anticipated by the following patents:

A. B. Wilton,	No.	24,269,	dated	May 31, 1859.
C. A. Read,	"	119,407,	"	Sep. 26, 1871.
E. A. Munger,	"	380,508,	"	Apr. 3, 1888.
A. B. Arnold,	"	598,838,	"	Feb. 8, 1898.
C. G. Hainline,	"	615,147,	"	Nov. 29, 1898.
C. S. Ferguson,	"	638,228,	"	Dec. 5, 1899.
F. Nerger,	"	661,129,	"	Nov. 6, 1900.
W. W. Comingor,	"	663,865,	"	Dec. 18, 1900.
J. C. Hale,	"	740,124,	"	Sep. 29, 1903.
Yahraus et al.,	"	817,355,	"	Apr. 10, 1904.
P. W. Pratt,	"	769,324,	"	Sep. 6, 1904.
R. E. Foster,	"	777,653,	"	Dec. 13, 1904.
W. E. Herbst,	"	897,860,	"	Sep. 1, 1908.
British	No.	13,529,	Aug. 27, 1889,	Gottlieb Schmidt.
"	"	8,205,	Apr. 5, 1906,	John Cairns.
"	"	17,571,	July 28, 1909,	Robert Tippette.
[fol. 279] British	No.	8,159,	Apr. 7, 1913,	Paul Stern.
German	"	251,550,	May 12, 1911,	Sigmund Zala.
French	"	443,338,	July 31, 1913,	Jacques Giraud.

and by knowledge, use or sale of the following:

Frederick Nerger of and at Chicago, Ill. and elsewhere in the United States.

Morgan & Wright of and at Detroit, Mich., and elsewhere in the United States.

Cara S. Ferguson of and at Columbus, O.

Revere Rubber Company of and at Chelsea, Mass., and elsewhere in the United States.

The Foster Rubber Co. of and at Boston, Mass., and elsewhere in the United States.

Edward H. Scribner of and at Chelsea, Mass.

Herbert B. Bradshaw of and at Columbus, O.

The Goodyear Tire & Rubber Co. of and at Akron, O., and elsewhere in the United States.

William Noll of and at Malden, Mass.

Albert K. Pray of and at Chelsea, Mass.

The Springfield Elastic Tread Co. of and at Springfield, O., and elsewhere in the United States.

Henry Spies of and at Cleveland, O.

And said cause came on to be heard on such motion before his Honor, Judge Westenhaver, who, about the 14th day of February, 1919, handed down an opinion, and thereafter a decree was entered in such District Court, restraining the defendant from further infringing the said Tufford patent, and thereafter such injunction was suspended, pending the appeal, on condition that defendant furnish a bond and deposit its gross profits with the Clerk of the Court.

And thereafter such defendant appealed to the United States Circuit Court of Appeals for the Sixth Circuit, who heard such appeal about the 4th day of June, 1919. On the 7th day of October, 1919, the United States Circuit Court of Appeals handed down its opinion, sustaining the District Court in holding the patent valid and infringed.

[fol. 280] (11) And the plaintiff further shows that in the month of October, 1919, H. H. Hackman & Co., a partnership composed of Henry Hackman, Sr., Chas. F. Baker and Henry Hackman, Jr., jobbers of shoe findings and the like, and doing business in Cleveland, O., were selling rubber heels like "Plaintiff's Exhibit Essex Heel" filed herewith, embodying the invention set forth in and in infringement and in violation of the rights of this plaintiff under the Letters Patent here in suit, said heels being marked "Tite-Edge" and made by the Essex Rubber Company.

The plaintiff herein brought its bill in equity in the United States District Court for the Northern District of Ohio, Eastern Division, in Equity No. 506, complaining that H. H. Hackman & Co. were infringing and threatening further to infringe said Letters Patent.

Thereafter the court took the cause under consideration on Nov. 8, 1919, on motion for a preliminary injunction, affidavits, brief and argument filed and submitted on behalf of plaintiff, there being no appearance for defendant, and his Honor, Judge Westenhaver of said court did order the issuance of a preliminary injunction restaining the defendants from further infringing upon said Letters Patent and from further selling heels like "Plaintiff's Exhibit Essex Heel."

(12) And plaintiff further says that in the month of October, 1919, The Consolidated Rubber Company, manufacturers of rubber heels and doing business in Elyria, O., was making and selling rubber heels like "Plaintiff's Exhibit Consolidated Heel" embodying the invention set forth in and in infringment of and in violation of the rights of the plaintiff under the Letters Patent here in suit.

The plaintiff herein brought its bill in equity in the United States District Court for the Northern District of Ohio, Eastern Division, suit in equity 507, complaining that the said The Consolidated Rubber Company was infringing and threatening further to infringe said Letters Patent.

And thereafter a settlement was effected, in which The Consolidated Rubber Company did acquiesce in the patent in suit and did [fol. 281] consent to an order permanently enjoining it from further manufacturing, selling and using heels like "Plaintiff's Exhibit Consolidated Heel." and such injunction was ordered by his Honor, Judge Westenhaver, pursuant to such stipulation.

(13) And plaintiff further shows that in the month of October, 1919, The Hill Rubber Heel Co., sellers of rubber heels, doing business at Elyria, O., was selling rubber heels like "Plaintiff's Exhibit Hill Heel", embodying the invention set forth in and in infringement and in violation of the rights of the plantiff under th Letters Patent here in suit.

The plaintiff herein brought its bill in equity in the United States Court for the Northern District of Ohio, Eastern Division, suit in equity 508, complaining that such The Hill Rubber Heel Company was infringing and threatening further to infringe said Letters Patent.

The plaintiff filed a motion for a preliminary injunction to restrain the defendant from such infringement, and the said cause came on to be heard on such motion, affidavits, exhibits and other evidence submitted in connection with said motion by both parties, and on arguments made by both parties before his Honor, Judge Westenhaver, who, handing down an opinion from the bench, issued an order, which was entered, granting a preliminary injunction, which issued, restraining the defendant from further infringement of the patent.

(14) Since Jan. 11, 1916, the date of the issue of said Reissue Letters Patent, and prior to the filing of this Bill of Complaint, the defendant, The Thomas Urbansky & Sons Company, has, within the Eastern Division of the Northern District of Ohio, sold or caused to be sold or used, or caused to be used, resilient heels which embody the improvements described in said reissued Letters patent No. 14,049, and among others, those marked "Tite-Edge, Essex Rubber Co., Trenton, N. J.", unlawfully and without the license of the plaintiff, and in infringement of said Letters Patent and plaintiff's rights thereunder, and said defendant threatens to continue said infringement, and has gained great profits from such infringement, plaintiff is informed and believes. Where-[fol. 282] fore, the plaintiff prays that the defendant may be required to make full recovery of the gains from such infringement.

Claims 5 to 9, inclusive, are infringed.

(15) The plaintiff has marked its resilient heels with the word "Patented" and the number and date of the reissue patent here in suit. The plaintiff has further notified the defendant of its infringement, and defendant has continued to infringe upon plaintiff's rights since it was so notified.

(16) But for the wrongful acts of this defendant, the plaintiff would be able to make, use and sell the improvement claimed in said reissue patent with greater profit and advantage. By such wrongful acts of this defendant, the plaintiff, having no adequate remedy at law, is suffering irreparable damage and is threatened with continued irreparable damage, unless this infringement by defendant is restrained by order of Court.

Wherefore, the plaintiff prays:

1. For such preliminary and perpetual injunction against such infringement of said Reissue Letters Patent as to this Court may seem just.

2. For an accounting of profits and damages due to such infringement, and that defendant may be compelled to pay over to said plaintiff said damages, as well as the profits.

3. For costs.

4. For such other relief as to equity may seem just.

5. The plaintiff further prays for a writ of subpœna ad respondendum, directed to the defendant, The Thomas Urbansky & Sons Company, commanding it to appear and make answer to the Bill of Complaint, but not under oath, (an answer under oath being hereby waived), and to perform and abide by such orders and decrees herein as to this Court may seem required by the principals of equity and good conscience.

The I. T. S. Rubber Company, by J. G. Tufford President.
F. O. Richey, Solicitor and of Counsel for Plaintiff.

[fol. 283] STATE OF OHIO,
Lorain County, ss:

John G. Tufford, being duly sworn, deposes and says that he is President of The I. T. S. Rubber Company, the corporation named as plaintiff in the foregoing Bill of Complaint, subscribed by him; that he has read said Bill and knows the contents thereof; that the same are true, except as to matters alleged on information and belief, and as to such matters he believes the complaint to be true, and that he verily believes himself to be the first, original and sole inventor of the improvements set forth in the patent in suit.

J. G. Tufford.

Sworn to before me and subscribed in my presence this 2d day of December, 1919. John S. Richey, Notary Public. (Seal.)

THE UNITED STATES OF AMERICA,
Northern District of Ohio, ss:

The President of the United States of America to the Marshal of the Northern District of Ohio, Greeting:

You are hereby Commanded to summon The Thomas Urbansky & Sons Company citizen of and resident in the State of Ohio, if it be found in your District, to be and appear in the District Court of the United States for the Northern District of Ohio, aforesaid, at Cleveland, on or before the twentieth day after service, excluding the day thereof, to answer a certain Bill in Equity, filed and exhibited in said Court, against it by The I. T. S. Rubber Company citizen of and resident in the State of Ohio.

Hereof you are not to fail under the penalty of the law thence ensuing. And have you then and there this writ.

Witness, the Honorable John M. Killits and the Honorable D. C. Westenhaver, District Judges of the United States, this 4th day of December A. D. 1919 and in the 144th year of the independence of the United States of America.

B. C. Miller, Clerk, by Anna H. Elliott, Deputy Clerk. (Seal.)

[fol. 284] Memorandum

The said defendant is required to file its answer or other defense in the Clerk's Office on or before the twentieth day after service, excluding the day thereof, otherwise the bill may be taken pro confesso.

B. C. Miller Clerk.

U. S. Marshal's Return

The U. S. of America,
Northern District of Ohio, ss:

Received this writ at Cleveland, Ohio, Dec. 4, 1919, and on Dec. 5, 1919, at Cleveland, Ohio, I served the within named, The Thomas Urbansky & Sons Co., by delivering to Thomas Urbansky Treas., of the said The Thomas Urbansky & Sons Co., personally, a true and certified copy hereof, with all endorsements thereon; the president chairman of the board of directors or trustees sec., or other chief officer could not be found in the district.

Chas. W. Lapp, U. S. Marshal, by Al. D. Keeley, Deputy.

Marshal's Fees:

Service	$2.00
Travel	.06
	$2.06

(Returned and filed Dec. 9, 1919. B. C. Miller, Clerk U. S. District Court, N. D. O.)

[Endorsed:] No. 514. U. S. Marshal's No. 8983. United States District Court, Northern District of Ohio. The I. T. S. Rubber Co. vs. The Thos. Urbansky & Sons Co. Subpœna in Equity. Return day Dec. 24th 1919. $25.00 deposited by plaintiff for costs. Richey & Adams Complainant's Attorneys.

[fol. 285] UNITED STATES DISTRICT COURT, NORTHERN DISTRICT OF OHIO, EASTERN DIVISION

In Equity. No. 514

THE I. T. S. RUBBER COMPANY, Plaintiff,

vs.

THE THOMAS URBANSKY & SONS COMPANY, Defendant

Motion for a Preliminary Injunction

Now comes the plaintiff in the above-entitled cause, by its solicitor, and moves this Honorable Court to grant a writ of injunction against the defendant, The Thomas Urbansky & Sons Company, restraining it and its employees from further infringing, pendente lite Reissue Letters Patent of the United States to John G. Tufford, No. 14,049, issued Jan. 11, 1916, and owned by this plaintiff, and particularly enjoining and restraining such defendant from making, selling and using rubber heels like those constituting "Plaintiff's Exhibit Defendant's Heels" in evidence in this case.

In support of this motion, plaintiff will rely upon the affidavit of John G. Tufford filed herewith, Bill of Complaint, and upon the exhibits, affidavits, pleadings and other parts of the records on file with this Court in the cases of The I. T. S. Rubber Co. vs. Fetzer & Spies Leather Co., ≡ 435, The I. T. S. Rubber Co. vs. The Elyria National Rubber Heel Co., in Equity 457, and The I. T. S. Rubber Co. vs. United States Rubber Co., in Equity 470, and upon the opinions of this Honorable Court and the Circuit Court of Appeals in the Sixth Circuit in said cases.

F. O. Richey, Solicitor and of Counsel for Plaintiff.

Elyria, O., Dec. 2, 1919.

[fol. 286] UNITED STATES DISTRICT COURT, NORTHERN DISTRICT OF OHIO, EASTERN DIVISION

In Equity. No. 514

THE I. T. S. RUBBER COMPANY, Plaintiff,

vs.

THE THOMAS URBANSKY & SONS CO., Defendant

Affidavit of John G. Tufford

STATE OF OHIO,
Lorain County, ss:

John G. Tufford, being first duly sworn, deposes and says:

I am sixty years old and reside at Elyria, O., and am President of the plaintiff company. I am the inventor of the patented de-

vice, and testified in the case of the plaintiff herein against the Fetzer & Spies Leather Co., recently tried in this Court, and furnished affidavits in the cases of the plaintiff herein vs. United States Rubber Co., The Elyria National Rubber Heel Co., The Hill Rubber Heel Co., The Consolidated Rubber Co. and H. H. Hackman & Co.

I have examined "Plaintiff's Exhibit Defendant's Heels." I myself purchased from the defendant certain of the heels of this exhibit about the middle of November, 1919. The defendant had on hand and was threatening to sell other heels like each of the heels constituting this exhibit.

I find that heels 10-M, 8-M, 7-M, 6-M, 5-M, 3-W and 1-W are duplicates (perhaps with slight immaterial variations) of those held to infringe by this Court in the case of this plaintiff v. H. H. Hackman & Co., in Equity 506. They operate in the same way as plaintiff's heels, and realize the same results. The curvature in the attaching face is broken instead of curve, as in the plaintiff's heels. Otherwise, they are like the USCO heels held by this court and the Circuit Court of Appeals in this (the Sixth) Circuit to infringe. The attaching face is curved in all directions and on every line of cross section.

The attaching face of the lift lies entirely below a plane passing through the rear upper edge and breast corners of the lift. [fol. 287] The attaching face of the lift is so shaped that there is a somewhat centrally disposed low spot, so that if the upper edges of the lift are put in contact with the horizontal bottom of the heel, as far as may be, without using force to distort the normal shape of the lift, any contained liquid would be retained in this lowest spot.

When flattened out upon the surface of the shoe heel and nailed thereto, the lift in tending to regain its normal shape, clings to the edges of the shoe heel, in effect grabbing a hold of the same all about the margin.

All the advantages of the Tufford heel are realized. No cement is used in attaching the heel, thereby saving time in attaching it to the shoe. The seam is permanently sealed; in fact, the heel is called the "Tite-Edge" heel. A wide trimming area is provided. Owing to the use of the Tufford form, the washers and nails are set in from the edge, increasing the trimming area and prolonging the life of the heel. The heel is cheap and easy to make soft and resilient and the nail holes are staggered with respect to the nails in the leather heels.

I find that some of these heels will stick down,—notably the 1-W, 3-W and 7-M. Others will not, because of rough edges or other leaks therein. In some of defendant's heels the angles in the breast corner form a leak, through which the air may enter to prevent sticking.

Defendant's heels sizes 000-F are exactly like the other heels, except that the ring around the attaching face is broken at the central part of the breast and a segment omitted. This only im-

pairs or reduces the efficiency of the Tufford invention. What remains performs functions of the Tufford invention, perhaps not so well as the Tufford heel.

The heels are devoid of plates and other objectionable devices. Washers are employed, as in the plaintiff's heels, and the washers are located in the same positions as in plaintiff's heels of corresponding size.

The continued infringement by the defendant will do irreparable damage to the plaintiff, who is now prepared to supply the [fol. 288] demand for heel lifts. Plaintiff and The Miller Rubber Co., who makes the heels for plaintiff, have, at great expense, prepared to supply the demand. The infringement by the defendant has and is encouraging others to infringe. The heels marked "Plaintiff's Exhibit, Plaintiff's Commercial Heels" exemplify the patented heel as manufactured by the plaintiff.

When we went into the rubber heel business in 1915, we adopted the prices set by the manufacturers of other high-grade lifts. These concerns have since increased their prices. We have not. Our sales now amount to about five million heels a month. The cost of producing our heels has increased.

J. G. Tufford.

Sworn to before me and subscribed in my presence this 2nd day of December, 1919. John S. Richey, Notary Public. (Seal.

UNITED STATES DISTRICT COURT, NORTHERN DISTRICT OF OHIO, EASTERN DIVISION

In Equity. No. 514

THE I. T. S. RUBBER COMPANY, Plaintiff,

vs.

THE THOMAS URBANSKY & SONS COMPANY, Defendant

Brief on Motion for Preliminary Injunction

The issues in this case are, for the most part, the same as in the case of this plaintiff v. H. H. Hackman & Co., in equity 506 in this Court, and we will not repeat here the arguments made there. (Winans v. Denmead, 15 Howard, 330, 343; 14 L. Ed. 717, and Ives v. Hamilton, 92 U. S., 426 apply.)

The smaller heels of the defendant, marked 000-F, present the old question that infringement cannot be avoided by impairing the function or reducing the efficiency of the patented device, for in these heels defendant does not complete the ring or circle of the attaching face, but omits a portion thereof at the breast of the heel. That such omission cannot avoid infringment is clear from the [fol. 289] opinion of the Circuit Court of Appeals in this (the

Sixth) Circuit, in Nathan v. Howard, 143 F. R., 889, wherein Judge (afterwards Justice) Lurton wrote the opinion affirming the Circuit Court for this District.

In the Nathan case the patent covered a stove, one of the essential elements of which was a ring, shown at 9, page 891 F. R. 143, and which was described in the specification of the patent as follows:

"Supported upon the top of the fire pot and extending entirely around the same in a hollow ring, 9, * * * (p. 892).

The function of the ring was described as follows:

"The location of the ring at the contracted top of the fire pot insures the introduction of the highly heated air directly in contact with the products of combustion immediately after leaving the bed of fire, thereby effecting a more certain and rapid union of the gases at the proper place in the stove." (p. 892.)

Claim 1 recited "a hollow ring 9" and was as follows:

"In a stove, a fire pot, 1, a bulging outwardly at its upper part and having a contracted top, a hollow ring 9, located at the top of the fire pot and having openings, 9a, and a flue or flues 3, for heating air communicating with said hollow ring and bent inwardly and being narrow or contracted at its upper end, the wall of the fire pot forming one side of said flue substantially as shown, and for the purposes described."

The "ring" was not only described as extending "entirely around", but was, as a ring, made an essential element of the claims in suit. It effected the performance of the desired function. The defendant omitted a part of the ring, just as defendant here does in the 000–F heels. The Court said p. 893:

"Again, defendants say that they have not used the ring of Howard. It is true that they do not extend their ring entirely around the top of the fire pot. A segment has been omitted. That [fol. 290] which remains performs the function of the complete ring, perhaps not so well as if the ring had been completed. It is still, in substance and effect, the 'ring' of Howard, and though a segment is omitted, defendants themselves advertise it as a 'ring'. But the impairment of the function of this hollow ring by omitting a short segment will not escape infringement."

Certainly it would be difficult to find a case more on all fours with the case at bar than this case. Defendant here advertises its heels as "Tite-Edge". A segment has been omitted here as there. The functions are impaired only to the extent that the segment is omitted.

The opinion in Nathan v. Howard has been followed by other courts.

"The impairment of the function of a part of a patented structure by omitting a portion will not avoid infringement." (Manton-Gaulin Mfg. Co. v. Dairy Machinery & C. Co., 238 F. R., 210, 215 (D. C. D. Conn.).

To the same effect is the holding of Judge Taft in King Ax Co. v. Hubbard, 97 F. R., 795:

"This is an instance not infrequent in patent litigation, where the infringer has sought to evade the claims of a patent, the substance of which he is appropriating, by deliberately impairing the function of one element without destroying the substantial identity of structure, operation and result. Sewall v. Jones, 91 U. S. 171; Coupe v. Weatherhead, 16 Fed. 673; Machine Co. v. Binney, 24 Fed. Cas. 653. This court, following the Supreme Court, has pointed out in a number of cases that, the more meritorious the patent, the more liberal will the court be in applying the doctrine of equivalents to cover devices adapted for that purpose of appropriating all that is good in a patent without rendering the tribute which the patent law was intended to secure, for a temporary period to those who by their ingenuity have made possible real progress in the industrial arts."

[fol. 291] (Syllabus:) "The fact that an alleged infringing mechanical device lacks one of the functions of the patented device does not avoid infringement, where such function is not claimed in the patent." (Litson v Alaska, 130 F. R., 129; C. C. A. 9th).

Doughty v. West. Fed. Cas. #4028.

Veneer Machinery Co. v. Grand Rapids Chair Co., 227 F. R., 419; C. C. A. 6th.

Murray v. Detroit Wire Spring Co., 206 F. R., 465; C. C. A. 6th.

(Syllabus:) "Infringement is not avoided by the fact that defendants' machine does not work as perfectly as complainants', provided it is intended to work in the same way." (National v. McLauren, 186 Fed. 992 (C. C. S. D., N. Y.)

(Syllabus:) "Infringement is not avoided by using the inventive idea of the patent in another structure in imperfect form." (Van Kannel v. Straus, 235 F. R., 135; C. C. A. 2nd).

(Syllabus:) "Infringement is shown where the alleged infringing device operates on the same principle as that of the patent, and accomplishes the same results in substantially the same way by equivalent means; the only difference being in the form or proportions of the parts." (Selger Refrigerator Co. v. American Car & Foundry Co., 171 F. R., 416; C. C., D. N. J.)

The defendant marks its 000–F heels "Tite-Edge," the same as the others, thus making no distinction between the various sizes.

Clearly, defendant has appropriated the Tufford invention,—in some cases in toto,—in others in impaired form, but, nevertheless, the invention.

Claims 5 to 9 are infringed, as in the Hackman Case.

What we might say upon the subject of irreparable damage has already been said in our brief in the Hackman Case.

The validity of the patent is assured; the grant is rapidly expiring; infringement is clear.

[fol. 292] As was said at the hearing in the Hill Case (in equity 508) by his Honor, Judge Westenhaver, the time has come to act in these matters. There have been numerous adjudications of the patent in suit by this court. All reasons for alleged invalidity of the patent have been overruled by the Circuit Court of Appeals in determining what was and what was not infringement. Indeed, the Circuit Court of Appeals went even further than this Court. It is time that the demoralization of plaintiff's trade, as well as the other annoyances caused by the infringements, should cease.

A preliminary injunction is in order.

Respectfully, F. O. Richey, Solicitor and of Counsel for Plaintiff.

Elyria, O., Dec. 2nd, 1919.

UNITED STATES DISTRICT COURT, NORTHERN DISTRICT OF OHIO, EASTERN DIVISION

In Equity. 514

THE I. T. S. RUBBER COMPANY, Plaintiff,

vs.

THE THOMAS URBANSKY & SONS COMPANY, Defendant

Tufford Reissue Patent 14049

(Interlocutory Decree—Entered Jan. 28th, 1920 by Judge Westenhaver)

This cause having come on, more than thirty days after entry of decree pro confesso, to be heard on the motion of the plaintiff for a final decree, it is hereby ordered, adjudged and decreed as follows:

First. That Reissue Letters Patent of the United States issued to John G. Tufford, assignor to the complainant herein, on the 11th day of January, 1916, for Improvements in Resilient Heels, No. 14,049 and issued to the complainant, The I. T. S. Rubber Company, are good and valid in law, particularly as to claim five (5) to nine (9) both inclusive.

Second. That the said John G. Tufford was the first, true and original inventor of the invention and improvements, described [fol. 293] and claimed in said Letters Patent, and particularly recited in said claims five (5) to nine (9) both inclusive.

Third. That the complainant, The I. T. S. Rubber Company is the lawful owner of said Letters Patent.

Fourth. That the defendant, The Thomas Urbansky & Sons Co., has infringed upon the said Letters Patent, and particularly the said

claims five (5) to nine (9) both inclusive, and upon the exclusive rights of the plaintiff under the same, by the sale of heel introduced in evidence as "Plaintiff's Exhibit, Defendant's Heels."

Fifth. That the case be referred to B. C. Miller, a Commissioner of this Court, residing in the city of Cleveland, as master pro hac vice, his experience in such matters being found by the Court sufficient reason for such appointment, to ascertain, and take, and state, and report to the Court an account of the number of heels embodying said invention and improvement, as described and secured in claims five (5) to nine (9) of said Letters Patent, made, used or sold by said defendant, and also the gains, profits and advantages which the said defendant has received, or which have arisen or accrued to them since the issue of the patent in suit from infringing the said exclusive rights of plaintiff by the sale of such heels described and secured by claims five (5) to nine (9) inclusive of said Letters Patent, and which the complainant has suffered by such infringement.

Sixth. That a perpetual injunction issue out of and under the seal of this Court, directed to the said defendant, The Thomas Urbansky & Sons Company, its associates, directors, officers, attorneys, clerks, agents, servants, workmen and other employees, enjoining and restraining them and each of them, from directly or indirectly making or causing to be made, using or causing to be used, or vending to others to be used, in any manner, any article, device, apparatus, or resilient heels or heel lifts, containing, embodying or employing the said inventions and improvements granted by the said Letters Patent, and particularly claimed in the said claims five (5) to nine (9) both inclusive thereof, or any resilient heel or resilient heel lift capable of [fol. 294] or adapted to be used in infringement of said claims, or from infringing upon or violating the said Letters Patent in any way whatsoever.

Seventh. That the plaintiff do recover of the defendant its costs in this suit to be taxed.

D. C. Westenhaver, District Judge.

Cleveland, O., Jan. 28, 1920.

IN THE DISTRICT COURT OF THE UNITED STATES, NORTHERN DISTRICT OF OHIO, EARTERN DIVISION

No. 514. In Equity

THE I. T. S. RUBBER COMPANY, Plaintiff,

vs.

THE THOMAS URBANSKY & SONS COMPANY, Defendant

Report of Special Master

By the decretal order of this court entered on January 28th, 1920, this cause was referred to the undersigned as special master to ascer-

tain and take, and state and report to the court an account of the number of heels embodying the invention and improvement as described and secured in claims five (5) to nine (9) of the Letters Patent in suit, made used or sold by the defendant herein, and also the gains, profits and advantages which the said defendant has received, or which have arisen or accrued to it since the issue of the patent in suit, from infringing the said exclusive rights of plaintiff by the sale of said heels, and which the plaintiff has suffered by said infringement. In accordance with Equity Rule No. 63, and pursuant to the order of the Master, returned herewith, a hearing was had and a debit and credit statement was filed by defendant, which statement is returned herewith. Pursuant to notice a further meeting was held before the Master on the 2d day of August, 1920, at which meeting it was announced the question of the accounting had been settled by an agreement of counsel, whereby defendant was to pay to plaintiff an amount of damages agreed upon by the parties hereto.

In view of this agreement, no further report is made by the Master, [fol. 295] and the papers hereto referred to are attached hereto and filed with this report.

Respectfully submitted, B. C. Miller, Special Master.

August 2, 1920.

In the District Court of the United States, Northern District of Ohio, Eastern Division

No. 514. In Equity

The I. T. S. Rubber Company, Plaintiff,

vs.

The Thomas Urbansky & Sons Company, Defendant

Hearing Before B. C. Miller, Special Master, Pursuant to Notice

Present: On behalf of complainant, E. D. Fales, Esq., and on behalf of the defendant Mr. T. J. Urbansky.

It is ordered by the Master that the defendant, the Thomas Urbansky & Sons Company, its associates, directors, officers, attorneys, clerks, agents, servants, workmen and other employes, heretofore enjoined in this case by the order of January 28, 1920, file with me as such Special Master, at my office, Room 330 Federal Building, in the City of Cleveland, Ohio, on or before the 30th day of June, 1920, a debit and credit account, as provided by Equity Rule No. 63, showing the number of heels manufactured and sold by said defendant embodying in whole or in part the inventions or improvements covered by reissue letters patent No. 14,049; said account to show the actual cost of said articles and the expense of selling the same and the profit made thereon by the said defendant, its associates, directors, officers, attorneys, clerks, agents, servants, workmen and other em-

ployes, said account to be properly verified by a duly authorized officer of the defendant company by an affidavit to the effect that the account produced is the account required by this order, and that the list of heels given in said account comprises all such heels sold by the defendant and required by this order to be set forth in said account.

B. C. Miller, Special Master.

June 23, 1920.

[fol. 296] Thereupon, the hearing was adjourned, to be resumed upon notice by the Special Master.

The Thos. Urbansky & Sons Co., 2364 Ontario St., Cleveland, O.

June 30th, 1920.

STATE OF OHIO,
County of Cuyahoga, ss:

Statement of Purchases and Sales of Rubber Heels as Required by B. C. Miller, Special Master, in Order Dated June 23, 1920

Quantity	Tite Edge	Dr.		Cr.
1388¾ dozen	Men's @ 2.25 Dz.	312.19		312.19
58½ "	Wom's 2.00 "	117.00		117.00
		429.19		429.19
Less disct. received 15-5-5%		99.94	Allowed 5-2%.....	29.61
		329.25		399.58
			Operating cost 13¾%	54.94
				$344.64

Quantity	Usco	Dr.		Cr.
210 dozen	Men's @ 2.50 Dz.	525.00		525.00
218 "	Wom's 2.25 "	490.50		490.50
1 "	" White	2.50		2.50
3 "	Men's 13's 2.75 dz.	8.25		8.25
		1026.25		1026.25
Less disct. received 20.5%		246.30	Allowed 5-2%.....	70.80
		779.95		955.45
			Operating cost 13¾%	131.37
				824.08

I, Thos. J. Urbansky, secretary of the Thos. Urbansky & Sons Co. do hereby certify that the above statement is true and correct, to the best of my knowledge.

Thos. J. Urbansky.

Sworn to and subscribed before me this 30th day of June, [fol. 297] 1920. In testimony whereof I have hereunto set my hand and seal the day and year aforesaid. George Malliam, Notary Public. My Com. expires July 8th, 1921. (Seal.)

(Received and filed July 1, 1920. B. C. Miller, Special Master.)

(Order Allowing Special Master Compensation—Entered Aug. 2nd, 1920, by Judge Westenhaver)

IN THE DISTRICT COURT OF THE UNITED STATES, NORTHERN DISTRICT OF OHIO, EASTERN DIVISION

No. 514. In Equity

THE I. T. S. RUBBER COMPANY, Plaintiff,

vs.

THE THOMAS URBANSKY & SONS COMPANY, Defendant

Order

It appearing to the Court that the Master heretofore appointed herein has filed his report showing an agreement of the parties hereto as to the damages to be paid plaintiff it is ordered that the compensation of such Special Master be and the same is hereby fixed at $25.00, and that his expenses for stenographer's fees be and the same are hereby allowed in the sum of $8.00.

It is further ordered that said compensation and expenses of the Master be taxed as a part of the costs.

August 2, 1920.

D. C. Westenhaver, Judge.

IN THE UNITED STATES OF AMERICA,
Northern District of Ohio,
Eastern Division, ss:

No. 514. In Equity

THE I. T. S. RUBBER COMPANY, Plaintiff,

vs.

THOMAS URBANSKY & SONS COMPANY, Defendant

Stipulation

The parties, Plaintiff and Defendant, to the above entitled cause, having come to an agreement with reference to the profits of the [fol. 298] defendant in the matter of the infringement of the Tufford United States Patent, Re-issue # 14049, and the plaintiff having agreed to accept a stated amount in settlement thereof, it is hereby stipulated by the parties, the plaintiff and the defendant, that the reference to the Master be withdrawn, the Hon. Judge D. C. Westenhaver consenting.

E. D. Fales, Counsel, for Plaintiff. Aug. 2, 1920. Thos. J. Urbansky, for Defendant. Aug. 2, 1920.

Approved. D. C. Westenhaver, Judge.

Order for Final Decree

(Final Decree Entered Aug. 7th, 1920, by Judge Westenhaver)

THE UNITED STATES OF AMERICA,
Northern District of Ohio,
Eastern Division, ss:

At a stated term of the District Court of the United States, within and for the Eastern Division of the Northern District of Ohio, begun and held at the city of Cleveland, in said district, on the 1st Tuesday in April, 1920, being the 6th day of said month, in the year of our Lord, One Thousand Nine Hundred and Twenty, and of the independence of the United States of America, the one hundred and forty-fourth, to wit, on Saturday, the 7th day of August, A. D. 1920.

Present: Honorable D. C. Westenhaver, United States District Judge.

Among the proceedings then and there had, were the following, to wit:

In Equity. 514

THE I. T. S. RUBBER COMPANY, Plaintiff,

vs.

THE THOMAS URBANSKY & SONS CO., Defendant

Pursuant to stipulation filed by Counsel in this cause,

It is ordered, that the defendant, having made settlement of all claims for profits arising hereunder, the references of the Master shall be withdrawn and the interlocutory decree heretofore entered in this cause, be made final; and it is further ordered that [fol. 299] the plaintiff shall pay all costs herein, including the costs as taxed by the Court in the order of August 2, 1920, now remaining unpaid.

D. C. Westenhaver, Judge.

UNITED STATES DISTRICT COURT, NORTHERN DISTRICT OF OHIO, EASTERN DIVISION

No. 514

THE I. T. S. RUBBER CO.

vs.

THE THOS. URBANSKY & SONS CO.

Aug. 7/20.—Final Decree entered.

Thos. Urbansky & Sons Co., Cleveland, Ohio

	Ptf.	Deft.	Aggregate
Costs in Common Pleas Court	....	....	.....
Clerk	....	....	6.00
Marshal	....	....	2.06
Attorney's Docket Fee	....	....	.....
Depositions	....	....	.....
Witnesses	....	....	.....
Stenographer's Fees	....	....	.....
Master's Fees & Expenses	....	....	33.00
Fine or Penalty	....	....	.....
U. S. Com'r's Court	....	....	.....
Total	....	....	$41.06

B. C. Miller, Clerk.

U. S. DISTRICT COURT, N. D. O.

No. 514

THE I. T. S. RUBBER —

v.

THE THOMAS URBANSKI SONS CO.

Receipt for Papers

Plaintiff's Exhibit Defendant's Heels.
The above Papers taken from the files by F. O. Richey, Attorney for Plaintiff.
Dated 2/19, 1920. O. K. J. W. K.

[fol. 300] THE UNITED STATES OF AMERICA,
Northern District of Ohio, ss:

I, B. C. Miller, Clerk of the District Court of the United States within and for said District do hereby certify the foregoing to be a true copy of the

Bill of Complaint,
Subpœna in Equity,
Motion for Preliminary Injunction,
Affidavit of John Tufford,
Brief on Motion for Preliminary Injunction,
Interlocutory Decree,
Report of Special Master,
Order allowing Special Master Compensation,
Stipulation,
Final Decree,
Cost Bill,
Receipt for papers,

filed in the above-entitled cause in said Court, and that the same are correctly copied from originals now on file in my office.

Witness, my official signature, and the seal of said Court at Cleveland, in said District, this 26th day of Sept. A. D. 1921, and in the 146th year of the Independence of the United States of America.

B. C. Miller, Clerk, by C. A. Wilder. (Seal.)

[Endorsed:] No. 514. United States District Court, Northern District of Ohio, Eastern Division. The I. T. S. Rubber Co., Plaintiff, v. The Thos. Urbansky & Sons Co., Defendant. Certified copy of Bill of Complaint, etc. Filed —— —, ——. B. C. Miller, Clerk.

[fol. 301] PLAINTIFF'S EXHIBIT 22

IN THE DISTRICT COURT OF THE UNITED STATES FOR THE NORTHERN DISTRICT OF OHIO, EASTERN DIVISION

In Equity. No. 506

THE I. T. S. RUBBER COMPANY, Plaintiff,

vs.

H. H. HACKMAN & Co., Defendants

Tufford Reissue Patent No. 14049

Bill of Complaint

To the Honorable the Judges of the District Court of the United States for the Northern District of Ohio, Eastern Division:
The Plaintiff for its bill of complaint says:

1. This is a suit in equity, arising under the patent laws of the United States.

2. Plaintiff is a corporation organized and existing under the laws of the State of Ohio, and a citizen of the United States and

of the State of Ohio, having a regular and established place of business at Elyria, O., and the defendant, H. H. Hackman & Co. is a partnership consisting of H. H. Hackman, Sr., H. H. Hackman, Jr. and Chas. F. Baker, doing business on West 3rd St., Cleveland, O., where such defendants have committed infringing acts.

3. John G. Tufford, being within the meaning of the statutes of the United States, the first, true, original and sole inventor of certain improvements in resilient heels, which had not been known or used by others in this country before his invention or discovery thereof, or more than two years prior to his application to the United States Patent Office for a patent therefor, and not patented or described in any printed publication in this or any foreign country before his invention or discovery thereof, or more than two years prior to his application, and which had not been in public use or on sale in this country for more than two years prior to his said application, and which had not been abandoned, and not patented or caused to be patented by him or his legal [fol. 302] representatives or assigns in any foreign country upon an application therefor, filed more than twelve months prior to the filing of his said application for Letters Patent in the United States, and being entitled to a patent therefor under the provisions of said statutes, duly applied to the Commissioner of Patents of the United States for Letters Patent thereon, on July 21, 1913. Thereafter, and prior to the issue of the herein-mentioned original patent from said application, the said Tufford assigned by instruments in writing, duly recorded in the United States Patent Office, one-sixth of his entire right, title and interest in said application and in said invention to Carl H. Ingwer of Elyria, O., one-sixth thereof to Arthur G. Smith, of Elyria, O., and one-twelfth thereof to Wm. C. Smith, of Elyria, O., and requested that the patent so issue. All of the requirements of the statutes then in force having been complied with, there was issued, under date of Sep. 15, 1914, to the said Tufford, Ingwer, A. G. Smith and W. C. Smith, United States Letters Patent #1,110,730, for such improvements, whereby there was secured to said Tufford, Ingwer, A. G. Smith and W. C. Smith, their legal representatives and assigns, for the term of seventeen years from Sept. 15, 1914, the exclusive right to make, sell and use said improvements.

Thereafter, on Oct. 9, 1914, prior to the issue of the hereinaftermentioned reissue patent, the said Tufford, Ingwer, A. G. Smith and W. C. Smith, assigned, by another instrument in writing, dated Oct. 9, 1914, and duly recorded in the United States Patent Office, all of the right, title and interest in the said patent #1,110,730 and to the said Tufford improvement in resilient heels to the plaintiff herein.

4. Thereafter, it appearing that said original patent #1,110,730 was inoperative or invalid by reason of a defective or insufficient specification, and such error having arisen by inadvertence, acci-

dent or mistake and without any fraudulent or deceptive intention, on the 22nd day of June, 1915, for good and lawful causes, plaintiff herein surrendered said original Letters Patent No. 1,110,730 to the Commissioner of Patents, and having made due application therefor on June 22, 1915, and having in all things complied with [fol. 303] the acts of Congress in such cases made and provided, said original Letters Patent were cancelled and new Letters Patent, which were marked "Reissued Jan. 11, 1916, #14,049" were on Jan. 11, 1916, in due form of law, issued to the plaintiff, which said mentioned reissued Letters Patent are of record in the Patent Office of the United States, and which (or a certified copy thereof) is ready here in Court to be produced. (The original reissued patent is in the custody of this court as an exhibit in the case of The I. T. S. Rubber Company v. Fetzer & Spies Leather Company, in Equity No. 435).

The reissue patent #14,049 illustrates and describes the same invention as the original patent #1,110,730 and no new matter has been introduced into said Reissue patent.

5. Since the date of said last named assignment conveying the rights to plaintiff herein, and since Jan. 11, 1916, the plaintiff has been and is now possessed of all right, title and interest in and to said invention and said reissued Letters Patent and entitled to all the benefits thereof.

6. And the plaintiff further shows that in the month of September, 1917, Fetzer & Spies Leather Company, jobbers in shoe findings in the city of Cleveland, Ohio, was selling rubber heels embodying the invention set forth in and in infringement and in violation of the rights of this plaintiff under the Letters Patent here in suit.

7. The plaintiff herein brought its Bill in equity in the United States District Court for the Northern District of Ohio, Eastern Division (in Equity 435) complaining that such Fetzer & Spies Leather Company was infringing and threatening further to infringe said Letters Patent. The defendant filed its Answer to the Bill of Complaint, and said cause came on to be heard on the pleadings and proof before his Honor, Judge Westenhaver, who ordered a decree for the plaintiff, affirming the validity of the patent and holding the same infringed, and a perpetual injunction was accordingly granted and issued, as prayed for, restraining the defendant from further infringing said Letters Patent.

8. And the plaintiff further says that in the month of July, [fol. 304] 1918, The Elyria National Rubber Heel Company, manufacturers of rubber heels, doing business in Elyria, O., was selling rubber heels embodying the invention set forth in and in infringement and in violation of the rights of the plaintiff under the Letters Patent here in suit. The plaintiff herein brought its Bill in equity in the United States District Court for the Northern District of Ohio, Eastern Division (Suit in Equity #457) com-

plaining that such The Elyria National Rubber Heel Company was infringing and threatening further to infringe said Letters Patent.

The plaintiff filed a motion for a preliminary injunction to restrain the defendant from such infringement, and the said cause came on to be heard on such motion, affidavits and exhibits and other evidence submitted in connection with the motion, before his Honor, Judge Westenhaver, who ordered a decree for the plaintiff, holding the same infringed by the heels sold by The Elyria National Rubber Heel Co., and a preliminary injunction was granted and issued, as prayed for, restraining the defendant from infringing said Letters Patent.

Thereafter such preliminary injunction was suspended, and the defendant was required to and did file a bond, with good and sufficient surety, approved by the Clerk of such Court, in the sum of $10,000.00, to secure the plaintiff against damage and loss of profits during the period in which the injunction remained suspended.

Defendant was further required to report the monthly sales and gross profits on its heels, and to deposit with the Clerk such gross profits during the suspension of the injunction.

9. And the plaintiff further says that prior to Jan. 3, 1919, United States Rubber Co., manufacturer of rubber heels and doing business at New York City and elsewhere, was selling rubber heels embodying the invention set forth in and in infringement and in violation of the rights of plaintiff under the letters patent here in suit. United States Rubber Company admitting the jurisdiction of this court in the premises, the plaintiff herein brought its Bill in equity in the United States District Court for the Northern District of Ohio, Eastern Division (suit in Equity [fol. 305] 470) complaining that such United States Rubber Company was infringing and threatening further to infringe upon said Letters Patent. This plaintiff filed a motion for a preliminary injunction to restrain the defendant from such infringement, and the said cause came to be heard on such motion, affidavits and exhibits and other evidence submitted in connection with the motion, before his Honor, Judge Westenhaver, who ordered a decree for the plaintiff, holding the same infringed by the heels sold by the United States Rubber Co., and a preliminary injunction was granted and issued as prayed for, restraining the defendant from infringing said Letters Patent.

Thereafter such preliminary injunction was suspended and the defendant was required to and did file a bond, with good and sufficient surety, approved by the Clerk of such court, in the sum of $20,000.00, to secure the plaintiff against damage and loss of profits during the period in which the injunction remained suspended.

Defendant was further required to report the monthly sales and gross profits on its heels and to deposit with the Clerk such gross profits during the suspension of the injunction.

10. And thereafter, the said Fetzer & Spies Leather Co., the said Elyria National Rubber Co., and the said United States Rubber Co. did appeal from the decisions of the District Court to the United States Circuit Court of Appeals for the Sixth Circuit, and thereafter, on the 3rd and 4th of June, 1919, respectively, such Court of Appeals did hear the appeals in the Fetzer & Spies Leather Co. and the United States Rubber Co. cases. Thereafter the Court took such cases under consideration, and on the 7th day of October, 1919, did hand down opinions sustaining the United States District Court in the Fetzer & Spies Leather Co. and the United States Rubber Company cases, and holding the Tufford reissue patent valid and infringed.

The appeal on the Elyria National Rubber Heel Co. case is now pending before and unheard by such Circuit Court of Appeals.

11. Since Jan. 11, 1916, the date of the reissue of said Letters Patent, and prior to the filing of this Bill of Complaint, the defend- [fol. 306] ants, H. H. Hackman & Co., have within the Eastern Division of the Northern District of Ohio, sold or caused to be sold, or used, or caused to be used, resilient heels which embody the improvements described in said reissue Letters Patent No. 14,049, and among others, those marked "Tite-Edge, Essex Rubber Co., Trenton, N. J.", unlawfully and without the license of the plaintiff, and in infringement of said Letters Patent and plaintiff's rights thereunder, and said defendants threaten to continue said infringement and have gained great profits from such infringement, plaintiff is informed and believes. Wherefore, the plaintiff prays that the defendants may be required to make full discovery of the gains from such infringement.

Claims 5 to 9, inclusive, are infringed.

12. The plaintiff has marked its resilient heels with the word "Patented" and the number and date of the reissue patent here in suit. The plaintiff has further notified the defendants of their infringement, and defendants have continued to infringe upon plaintiff's rights since they were so notified.

13. But for the wrongful acts of these defendants, the plaintiff would be able to make, use and sell the improvement claimed in said reissue patent with greater profit and advantage. By such wrongful acts of these defendants, the plaintiff, having no adequate remedy at law, is suffering irreparable damage and is threatened with continued irreparable damage, unless this infringement by defendants is restrained by order of Court.

Wherefore, the plaintiff prays:

1. For such preliminary and perpetual injunction against such infringement of said Reissue Letters Patent as to this Court may seem just.

2. For an accounting of profits and damages due to such infringement, and that defendants may be compelled to pay over to said plaintiff said damages, as well as the profits.

3. For costs.

4. For such other relief as to equity may seem just.

5. The plaintiff further prays for a writ of subpœna ad respondendum, directed to the defendants, H. H. Hackman & Co., command- [fol. 307] ing them to appear and make answer to the Bill of Complaint, but not under oath, (an answer under oath being hereby waived), and to perform and abide by such orders and decrees herein as to this Court may seem required by the principles of equity and good conscience.

The I. T. S. Rubber Company, by J. G. Tufford, President. Richey & Adams, F. O. Richey, Solicitor- and of Counsel for Plaintiff.

STATE OF OHIO,
Lorain County, ss:

John G. Tufford, being duly sworn, deposes and says that he is President of the I. T. S. Rubber Company, the corporation named as plaintiff in the foregoing bill of complaint, subscribed by him; that he has read said Bill and knows the contents thereof; that the same are true, except as to matters alleged on information and belief, and as to such matters he believes the complaint to be true, and that he verily believes himself to be the first, original and sole inventor of the improvements set forth in the patent in suit.

J. G. Tufford.

Sworn to before me and subscribed in my presence this 17th day of October, 1919. F. O. Richey, Notary Public. (Seal.)

UNITED STATES DISTRICT COURT, NORTHERN DISTRICT OF OHIO, EASTERN DIVISION

In Equity. No. 506

THE I. T. S. RUBBER COMPANY, Plaintiff,

vs.

H. H. HACKMAN & COMPANY, Defendants

Tufford Reissue Patent No. 14049

Motion for a Preliminary Injunction

Now comes the plaintiff in the above entitled cause, by its solicitor, and moves this Honorable Court to grant a writ of injunction against [fol. 308] the defendants, H. H. Hackman & Co., restraining each of them and their employees from further infringing, pendente lite, Reissue Letters Patent of the United States to John G. Tufford, No. 14,049, issued Jan. 11, 1916 and owned by this plaintiff, and particularly enjoining and restraining such parties from making, selling and using rubber heels like those constituting Plaintiff's

Exhibit Defendant's Essex Tite-Edge Heel Lifts in evidence in this case.

In support of this motion, plaintiff will rely upon the affidavit of John G. Tufford filed herewith, bill of complaint, and upon the exhibits, affidavits, pleadings and other parts of the records on file with this Court in the cases of The I. T. S. Rubber Co. vs. Fetzer & Spies Leather Co., #435, The I. T. S. Rubber Co. vs. The Elyria National Rubber Heel Co., in Equity 457, and The I. T. S. Rubber Co. vs. United States Rubber Co., in Equity 470, and upon the opinions of this Honorable Court and the Circuit Court of Appeals in the Sixth Circuit in said cases.

F. O. Richey, Solicitor & of Counsel for Plaintiff.

Elyria, Ohio, Oct. —, 1919.

UNITED STATES DISTRICT COURT, NORTHERN DISTRICT OF OHIO, EASTERN DIVISION

In Equity. No. 506

THE I. T. S. RUBBER COMPANY, Plaintiff,

vs.

H. H. HACKMAN & COMPANY, Defendants

Tufford Reissue Patent No. 14049

This cause having come on more than thirty days after entry of decree pro confesso, to be heard on the motion of the plaintiff for a final decree, it is hereby ordered, adjudged and decreed as follows:

First. That Reissue Letters Patent of the United States issued to John G. Tufford, assignor to the complainant herein, on the 11th day of January, 1916, for Improvements in Resilient Heels, No. 14,049 and issued to the complainant, The I. T. S. Rubber Com-[fol. 309] pany, are good and valid in law, particularly as to claims five (5) to nine (9) both inclusive.

Second. That the said John G. Tufford was the first, true and original inventor of the invention and improvements, described and claimed in said letters patent, and particularly recited in said claims five (5) to nine (9) both inclusive.

Third. That the complainant, The I. T. S. Rubber Company is the lawful owner of said letters patent.

Fourth. That the defendants, H. H. Hackman & Company, have infringed upon said Letters Patent, and particularly the said claims five (5) to nine (9) both inclusive, and upon the exclusive rights of the plaintiff under the same, by the sale of heels introduced in evidence as "Plaintiff's Exhibit Defendant's Heels".

Fifth. That the case be referred to B. C. Miller, residing in the city of Cleveland, who by reason of his special fitness is appointed as master pro hac vice, to ascertain, and take, and state, and report to the Court an account of the number of heels embodying said in-

vention and improvement, as described and secured in claims five (5) to nine (9) of said Letters Patent, made, used or sold by said defendants, and also the gains, profits and advantages which the said defendants have received, or which have arisen or accrued to them since the issue of the patent in suit from infringing the said exclusive rights of plaintiff by the sale of such heels described and secured by claims five (5) to nine (9) inclusive of said Letters Patent, and which the complainant has suffered by such infringement.

Sixth. That a perpetual injunction issue out of and under the seal of this Court, directed to the said defendants, H. H. Hackman & Company, their associates, directors, officers, attorneys, clerks, agents, servants, workmen and other employees, enjoining and restraining them and each of them, from directly or indirectly making or causing to be made, using or causing to be used, or vending to others to be used, in any manner, any article, device, apparatus, or resilient heels or heel lifts, containing, embodying or employing the said inventions and improvements granted by the said letters patent, and particularly claimed in the said claims [fol. 310] five (5) to nine (9) both inclusive thereof, or any resilient heel or resilient heel lift capable of or adapted to be used in infringement of said claims or from infringing upon or violating the said Letters patent in any way whatsoever.

Seventh. That the plaintiff do recover of the deftndants its costs in this suit to be taxed.

Eighth. That the bond filed by the plaintiff in this case be discharged, and the Clerk so notify the bonding company.

D C. Westenhaver, District Judge

Cleveland, O., Dec. 23, 1919.

UNITED STATES DISTRICT COURT, NORTHERN DISTRICT OF OHIO, EASTERN DIVISION

In Equity. 506

THE I. T. S. RUBBER COMPANY, Plaintiff,

vs.

H. H. HACKMAN & COMPANY, Defendants.

Decree

This cause came on to be heard at this term, upon the plaintiff's motion for a preliminary injunction, and was submitted upon the Bill of Complaint and the affidavit and grief filed by the plaintiff, and argument made on behalf of the plaintiff, and the exhibits referred to therein. No appearance for the defendants.

And thereupon, upon consideration thereof, it was ordered, adjudged and decreed as follows:

That the preliminary injunction issue, restraining and enjoining defendants, H. H. Hackman & Company, of Cleveland, Ohio, their associates, officers, attorneys, clerks, servants, and workmen, and each of them, from directly or indirectly making or causing to be made, using or causing to be used, or vending to others to be used, in any manner, heels introduced in evidence as "Plaintiff's Exhibit Defendant's Heels", any article, device, apparatus, resilient heel, heel lift, or rubber heel attachments for boots and shoes containing, embodying or employing said invention and improvement granted by the aforesaid Letters Patent (Reissue 14,049), and par- [fol. 311] ticularly claimed in claims 5 to 9, both inclusive, thereof, or any resilient heel or resilient heel lift capable of or adapted to be used in infringement of said claims, or from infringing upon or violating.

THE UNITED STATES OF AMERICA,
Northern District of Ohio, ss:

I, B. C. Miller, Clerk of the District Court of the United States within and for said District, do hereby certify the foregoing to be true and correct copies of the Bill of Complaint, Motion for a Preliminary Injunction, and Journal Entries, filed and entered in the above entitled cause in said Court, and that the same are correctly copied from the originals now on file in my office.

Witness, my official signature, and the seal of said Court at Cleveland in said District, this 28th day of October A. D. 1920, and in the 145th year of the Independence of the United States of America.

B. C. Miller, Clerk, by Anna D. Elliott. (Seal.)

1008 Eq

[Endorsed:] No. 506. United States District Court, Northern District of Ohio, Eastern Division. The I. T. S. Rubber Company, Plaintiff, vs. H. H. Hackman & Co., Defendants. Certified Copy of Bill of Complaint, etc. B. C. Miller, Clerk United States Court, Mass. Dist. Filed in Clerk's Office Nov. 1, 1920.

PLAINTIFF'S EXHIBIT No. 25

Copy

April 15, 1920.

Wendt & Co., 911 Canton Ave., Detroit, Mich.:

DEAR WALTER: Before this reaches you Judge Alexis C. Angell may have communicated with you.

I believe our attorneys wish to arrange in some way for an examination of the exhibit which will be introduced by the attorneys [fol. 312] for the I. T. S. Rubber Company, and will probably

telephone Judge Angell tomorrow from New York instructing him what to do.

I trust that you will cooperate with Judge Angell in the matter and give him any and all information possible and accept his suggestions with my assurance that they will be acting for our best interests whatever they do.

It is my understanding that it is our attorneys' wish that this company does not appear in the action unless they should decide to defend the suit and that will pro ably depend on whether any of the heels in the exhibit are exactly the same and marked the same as we propose to manufacture.

It is also possible, and I hope probable, that some postponement can be arranged which will give us more time to stock you up with the new heels.

It may be that Judge Angell will work out his ideas through your own attorney. All I ask is that you will cooperate with him in whatever suggestions he may make and ask your attorney, if called upon, to do the same.

I would prefer that you say as little to your own attorney as possible regarding our responsibility in the matter but send us his bill or at least tell us how much you have paid him and we will send you a check to cover.

I hope you will ask Mr. Jones or his assistant to sell off his Tite-Edge heels that he has on hand before Tuesday and take from him any which he may have left and credit him with the full value.

I am fairly confident that I will be able to send you by parcel post on Saturday black and tan in sizes 0 and 2 French and 1 and 2 Cuban and hope they will reach you without delay.

Very truly yours, Essex Rubber Company, Sales Manager
Shoe Findings Department.

[fols. 313 & 314] Copy

April 16, 1920.

Wendt & Company, 911 Canton Ave., Detroit, Mich.:

GENTLEMEN: This will introduce you to Mr. Manvel Whittemore Attorney, member of the firm of Emery, Varney, Blair & Hoguet, who will go to Detroit for the purpose of investigating the heel litigation.

Will you kindly cooperate with Mr. Whittemore in every way and very much oblige,

Very truly yours, Essex Rubber Company, President.
CHO/P.

Copy

April 18, 1920.

Mr. C. C. Tucker, Findings Dept. Essex Rubber Company, Trenton, N. J.

DEAR SIR: Your special delivery letter of the 15th inst. was received here while I was at Angell & Turner's office Saturday morning. I am pleased with Mr. Varney's action in putting the local

handling of the case into that office. Judge Angell is a well known citizen, an able lawyer, and member of a first class firm.

Mr. Angell was not in the office but I spent almost an hour with their Mr. Kemp. I took along one of each of the styles of Tite-Edge heels which you have made and also went out and bought a pair of I T S in an endeavor to fully acquaint him with all phases of the matter. He seemed to have a fair understanding of it when I left him and promised to send for me when I was wanted again.

Mr. Kemp said that Judge Angell went over to the opposition lawyer's office and arranged for a postponement. That bit of news was the one big ray of sunshine of yesterday's developments, for it means that I do not go out of business tomorrow.

Yours very truly, Wendt & Co., (Signed) Walter Wendt.

(Here follow Plaintiff's Exhibits 55, 85, and 91, marked side folio pages 315 and 316, 317-320, and 321-326 respectively)

[fol. 327] DEFENDANT'S EXHIBIT C

Department of the Interior,
United States Patent Office.

To all persons to whom these presents shall come, Greeting:

This is to Certify that the annexed is a true copy from the records of this office of the File Wrapper and Contents, in the matter of the Reissue Letters Patent of John G. Tufford, Assignor by Direct and Mesne Assignments to The I. T. S. Rubber Company, Number 14,049, Granted January 11, 1916, for Improvement in Resilient Heels.

In Testimony Whereof I have hereunto set my hand and caused the seal of the Patent Office to be affixed, in the District of Columbia, this 3rd day of October, in the year of our Lord one thousand nine hundred and twenty-two and of the Independence of the United States of America the one hundred and forty-seventh.

Wm. A. Kinnan, Acting Commissioner of Patents. (Seal.)

Div. 11.
Number (Series of 1915), 35710.

Div. 11.
(Ex'r's Book) 85/209

1915

Reissue No. 14049

Name: John G. Tufford, Assor. by direct and mesne assigts. to The I. T. S. Rubber *Rubber* Company, of Elyria, Ohio,
of Elyria,
County of ——,
State of Ohio.
Invention: Resilient Heels.
Division of Original Patent No. —, granted —— —, ——. 191-.

315=316

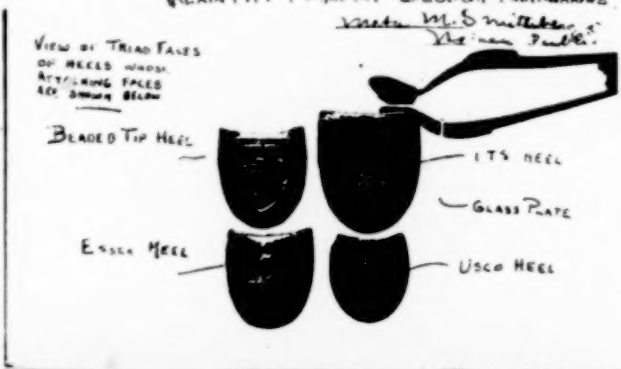
1008 Eq

Dec. 6, 1920

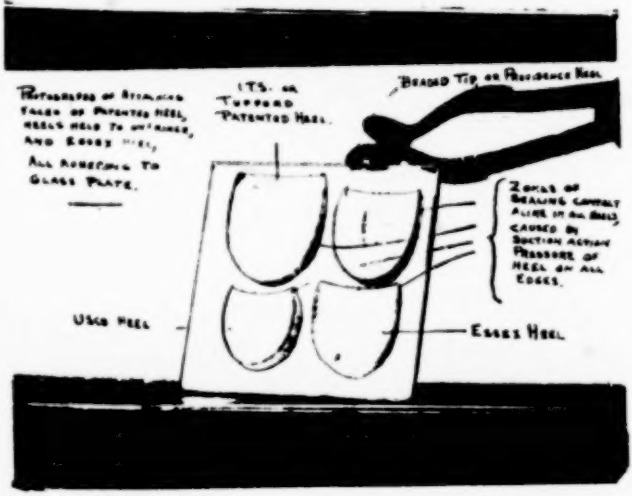
UNITED STATES DISTRICT COURT.
DISTRICT OF MASSACHUSETTS.

THE U.S. RUBBER CO., PLAINTIFF
vs.
ESSEX RUBBER CO., DEFENDANT
} IN EQUITY #1008

PLAINTIFF'S EXHIBIT SLOUGH PHOTOGRAPHS
Wesley M. Smith & Co.
Witness Pratt.



Pltf's 7
55
11-28-22
Q. Wyss.


REPRODUCED OF STANDARD FACES OF PATENTED HEEL, HEELS HELD TO UPPERS, AND ESSEX HEEL, ALL ADHERING TO GLASS PLATE.
U.S.R. OR TUPPER PATENTED HEEL.
BEADED TIP OR PRUDENCE HEEL
ZONES OF SEALING CONTACT AREAS OF ON HEEL CAUSED BY SUCTION ACTUAL PRESSURE OF HEEL ON ALL EDGES.
USCO HEEL
ESSEX HEEL

PLAINTIFF'S EXHIBIT 85.

A. TROIANO.

RUBBER HEEL FOR SHOES.

APPLICATION FILED APR. 16, 1918.

318

1,291,269.

Patented Jan. 14, 1919.

Fig. 1.

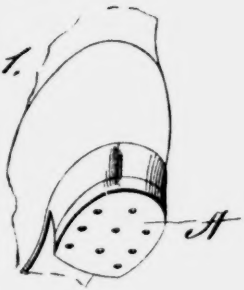


Fig. 2.

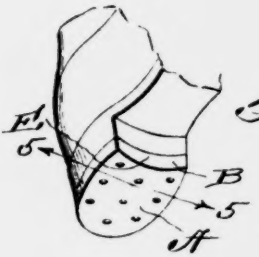


Fig. 3.

Fig. 4.

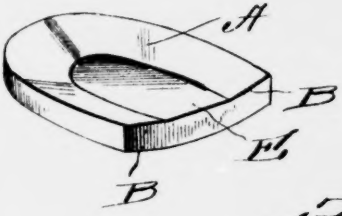


Fig. 5.

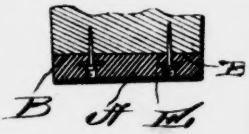


Fig. 6.

Inventor

Witness

R. A. Boswell.

By

Antonio Troiano.

A. P. Hough

Attorney

UNITED STATES PATENT OFFICE.

ANTONIO TROIANO, OF WASHINGTON, DISTRICT OF COLUMBIA.

RUBBER HEEL FOR SHOES.

1,291,269. Specification of Letters Patent. Patented Jan. 14, 1919.

Application filed April 16, 1918. Serial No. 228,845.

To all whom it may concern:

Be it known that I, ANTONIO TROIANO, a subject of the King of Italy, residing at Washington, in the District of Columbia, have invented certain new and useful Improvements in Rubber Heels for Shoes; and I do hereby declare the following to be a full, clear, and exact description of the invention, such as will enable others skilled in the art to which it appertains to make and use the same, reference being had to the accompanying drawings, and to the letters and figures of reference marked thereon, which form a part of this specification.

This invention relates to new and useful improvements in lifts for the heels of shoes and consists essentially in the provision of a lift of resilient material and of uniform thickness, and having a portion of its upper surface flat and oval-outlined with a surrounding beveled portion comprising the major part of the entire upper surface of the lift, and so formed that when fastening nails are driven through the angle intermediate the flat and beveled surfaces, the lift will be held securely against the heel, the beveled or inclined portion being held under greater pressure against the heel than the flat surface, thereby preventing loosening of the lift incident to thrusts upon the marginal edge thereof.

The invention consists of further details of construction, combinations and arrangements of parts which will be hereinafter fully described, shown in the accompanying drawings and then specifically defined in the appended claim.

I illustrate my invention in the accompanying drawings which, with the letters of reference marked thereon, form a part of this specification and in which:

Figure 1 is a perspective view showing the application of my lift to the heel of a shoe.

Fig. 2 is a perspective view of the heel in a reversed position to that shown in Fig. 1.

Fig. 3 is a sectional view showing the lift in contact with the heal and before being nailed down.

Fig. 4 is a detail perspective view of the lift.

Fig. 5 is a sectional view on line 5—5 of Fig. 2, illustrating the lift secured to the heel, and

Fig. 6 is an end view of the lift detached from heel.

Reference now being had to the details of the drawings by letter: A lift, which is made of a resilient material, such as rubber, is of uniform thickness throughout its length and breadth and has a central elongated oval-outlined flat part E of its upper surface surrounded by a beveled or inclined portion A, the ends B of which terminate flush with the forward ends of the lift and said flat part.

It will be noted that said inclined or beveled portion comprises the major portion of the upper surface of the lift and also that there is a clear angular line of demarcation between the flat and beveled portions, this being deemed essential in the formation of a lift from which best results are obtained when the same is fastened to the heel of a shoe. Nails F are driven through the lift along the angular margin between said flat and beveled portions thereof, thus drawing the lift against the bottom of the heel and when thus fastened, it will be noted that the entire beveled portion of the upper surface will be held snugly against the bottom of the heel with greater pressure than the flat portion and owing to the area of the beveled portion being the major part of the entire area of the upper surface of the lift, the latter will snugly bind against the heel and be prevented from loosening incident to thrusts upon the marginal edges of the lift.

It has been found from practice that lifts frequently become loosened and distorted from their positions where the upper surface of the lift is formed otherwise than in the manner herein shown and described.

What I claim to be new is:

A lift for shoes, comprising a piece of resilient material of substantially uniform thickness throughout its length and breadth, and having an elongated central oval-outlined flat part upon its upper surface with a surrounding beveled portion comprising more than one-half of the entire surface of the lift, the ends of said beveled portions terminating flush with the forward edge of

the lift and said flat part, the elements of the beveled portion consisting of straight lines at angles to the flat portion, and fastening means passing through the lift and through the angle intermediate said flat and beveled parts, and adapted to hold the lift against the bottom of the heel of a shoe, causing the beveled part of the lift to be held against the heel with greater pressure than the flat part and tending to prevent the lift against loosening incident to thrusts upon the marginal edges thereof.

In testimony whereof I hereunto affix my signature in presence of a witness.

ANTONIO TROIANO.

Witness:
A. L. HOUGH.

PLAINTIFF'S EXHIBIT 91.

W. E. SANDERS.

RESILIENT HEEL.

322

APPLICATION FILED JUNE 6, 1917. RENEWED SEPT. 18, 1920.

1,383,763.

Patented July 5, 1921.

FIG. 1.

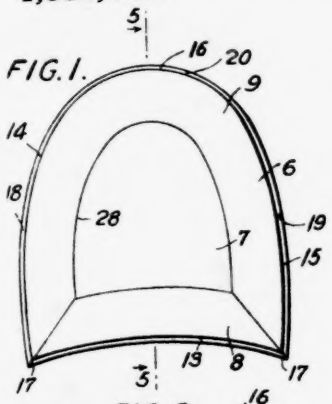


FIG. 3.

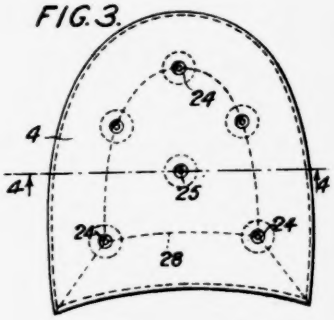


FIG. 2.

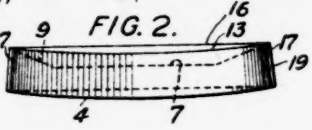


FIG. 4.

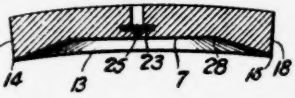


FIG. 5.

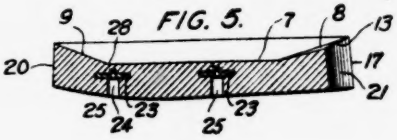
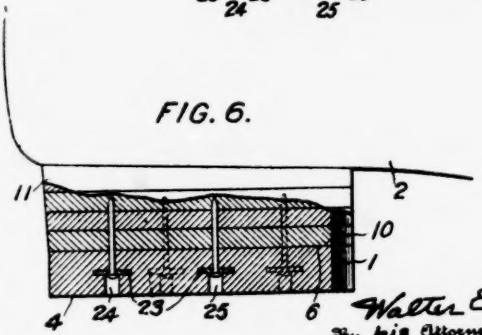


FIG. 6.



Inventor

Walter E. Sanders

By his Attorneys

Emery, Booth, Janney & Varney

UNITED STATES PATENT OFFICE. 323

WALTER E. SANDERS, OF TRENTON, NEW JERSEY, ASSIGNOR TO ESSEX RUBBER COMPANY, INC., OF TRENTON, NEW JERSEY, A CORPORATION OF NEW JERSEY.

RESILIENT HEEL.

1,383,763. Specification of Letters Patent. Patented July 5, 1921.

Application filed June 6, 1917, Serial No. 173,070. Renewed September 18, 1920. Serial No. 411,269.

To all whom it may concern:

Be it known that I, WALTER E. SANDERS, a citizen of the United States, and a resident of Trenton, in the county of Mercer and State of New Jersey, have invented an Improvement in Resilient Heels, of which the following is a specification.

This invention relates to resilient heels, and with regard to certain more specific features, to a heel in which part or all of the material is distorted during the time that the heel is in service.

Among the objects of the invention may be noted the provision of a resilient heel so constructed and proportioned that the edges thereof fit closely against the shoe; a heel in which the points of support or attachment are located on the line of maximum stress; and a heel which when applied to the shoe lies flat against the shoe and at the same time offers a flat lower surface, to give maximum wear and maximum security in walking. Other objects will be in part obvious and in part pointed out hereinafter.

The invention accordingly comprises the features of construction and operation, combinations of elements, and arrangements of parts, which are exemplified in the structure hereinafter described, and the scope of the application of which will be indicated in the following claims.

In the accompanying drawings, in which is shown one of various possible embodiments of this invention,

Figure 1 is a plan or top view of a preferred form of heel.

Fig. 2 is a front elevation thereof.

Fig. 3 is a bottom view of the same heel.

Fig. 4 is a transverse section on the line 4—4 of Fig. 3.

Fig. 5 is a longitudinal section on the line 5—5 of Fig. 1.

Fig. 6 is a fragmentary elevation of a shoe, with the heel applied thereto.

Similar reference characters indicate similar parts throughout the several views of the drawings.

In considering this invention in its relation to the prior art, it may be noted that for many years attempts have been made to produce a resilient heel that can be securely attached to a shoe without the use of cement, which is not only expensive but requires time for setting, and unless properly set is liable to squeeze out between the heel and the shoe, thereby causing the heel to become loose or detached. For a heel to be satisfactory in service, it must of course be securely attached to the shoe, and should preferably present a flat outer or lower surface, to give a maximum area over which the weight may be distributed, thereby affording a firmer footing and obviating the danger of slipping. From the point of view of the manufacturer or shoemaker, the heel should be so constructed that it may be securely applied in minimum time, preferably without the use of cement, and so proportioned that little or no buffing is required in order to adapt the heel to the shoe to which it is being applied. And the heel should preferably fit flat against the shoe. As the description progresses, it will be seen that in the present invention the disadvantages of prior-art construction have been overcome and the above-noted present-day requirements and desiderata adequately realized.

Referring now to the accompanying drawings, there is illustrated a lift or heel 1, preferably of the usual shape, and constructed of some flexible material such as rubber, and adapted to be secured to a shoe 2, as indicated in Fig. 6. When applied to the shoe, the lower face 4 of the heel is flat, and the upper face 6 comprising the central portion 7, breast bevel 8 and side and rear bevel 9, lies against the lower surface 10 of the outer lift of the leather heel 11. From Figs. 2, 4, 5 and 6, it will be seen that the side edges 14, 15, and rear edge 16 are all in the same plane. From Fig 2 it will be seen that the breast edge is dished or concave below this plane, the lowest point of the concave edge being about half the vertical depth of the bevel 9, though this ratio of edge depth to bevel depth may be varied considerably to meet the requirements of the stock, size of heel, shape of heel, and other variable factors. The angle of bevel is correspondingly smaller along the breast of the heel than above the sides and rear of the heel, as indicated in Fig. 5. The angle of bevel along the breast of the heel is a minimum at the center of the breast edge, and increases toward the corners of the heel. The concave breast edge insures a tight fit of the corners 17 against the lift 10, and produces a better result in this regard than would be attained if this upper breast edge

were all in the plane of the side edges 14, 15, and rear edge 16. And it will be apparent that if the heel is buffed or finished, or otherwise reduced in size by taking off the same amount of material entirely around the periphery thereof, the side edges and rear edge will still be in the same plane, because as is shown in Figs. 4 and 5, the side and rear bevel 9 is flat or rectilinear in cross-section, and of substantially uniform angle of bevel around the periphery of the heel; so that if it is reduced uniformly as by removing an equal amount of material all the way around, the upper side and rear edges of the finished heel would still be in a plane parallel to the original plane of these edges and separated from the original plane by a distance equal to the depth of material removed multiplied by the tangent of the angle of bevel. In other words, the entire side and rear margin or edge of the upper face of the lift is preferably in the same plane, both before and after buffing.

In order to minimize the waste of material in attaching the heel to the shoe, the heels are preferably manufactured in a number of sizes and shapes so that some one of the styles of heels manufactured will conform approximately to any desired shoe. This effects substantial economy by reducing the material that is wasted by the manufacturer or shoemaker in finishing the heel to the proper size for the shoe to which it is to be applied. For the purpose of further reducing the amount of waste material, and in some instances avoiding waste altogether, the sides 18, 19, rear 20 and breast 21 of the heel are not vertical, but are disposed at such an angle, as indicated in Figs. 1, 2, 3, 4 and 5, that when the heel is distorted into the position it occupies after attachment to the shoe (see Fig. 7), the sides, rear and breast will assume a vertical position and of course will retain that position as long as the heel is in service. This means that when the heel is first made, the sides, rear and breast taper inward in an upward direction. This is indicated in Figs. 2, 4 and 5, where, as in the other figures, the extent of departure of the sides, rear and breast from a vertical line has been somewhat exaggerated for the reason that the actual departure from the vertical is so slight that it would hardly be noticeable if drawn precisely to scale. It will be clear that this departure is only sufficient to bring the sides, rear and breast into vertical position when the heel is brought into its service position indicated in Fig. 6.

As indicated in Figs. 4 and 5, washers 23 of copper, steel, or other suitable material are preferably embedded about midway of the vertical depth of the heel, coaxially with each of the nail holes 24, 25. These are thin annular disks and are provided in order to afford a secure bearing surface for the heads of the nails 26 (Fig. 6) that are used for attaching the heel to the shoe. It will be observed from Fig. 3 that the outer nail holes 24 are located in the line 28 of junction of the central portion 7 of the upper face 6. This line of junction is the line where the tension strains in the upper face 6 are greatest and likewise where the compression strains in the lower face 4 are greatest, when the heel is applied to the plane lower surface of the outer leather heel-lift of the shoe, as indicated in Fig. 6.

By having the outer nails pass through this line of junction at several points and thereby fastening the upper face of the heel to the shoe securely at several points in this line, the entire upper face of the heel is caused to lie flat against the shoe, and thereby the advantages of a flat upper surface in service are attained without requiring any particular skill on the part of the operator in driving the nails to apply the heel to the shoe, nor excessive pressure exerted by the nails against the rubber. In the embodiment of the invention that is illustrated in the accompanying drawings, the rear outer nail hole is approximately in the central longitudinal axis of the heel and thus intersects the line 28 of junction at its rearmost point, while two other nail holes are located approximately on this line of junction at the two points of intersection of the side and rear bevel 9 with the breast bevel 8. But it is to be understood that this position of the nail holes is merely illustrative and that the number and location thereof may be varied to any extent consistent with the present disclosure, without departing from the spirit of this invention. The central nail hole 25 is provided principally to afford a means for holding the heel in position on the shoe while the upper nails are being driven; though of course the nail in this central hole assists to some extent in securing the heel to the shoe.

As has been stated above, the central portion 7 of the upper face 6, and the bevels 8 and 9 thereof are each flat in cross-section. The lower face 4 is preferably a somewhat irregular curved surface including a protuberant portion opposite said central portion 7 of the upper face 6 and so proportioned that when the upper face is flattened in applying the heel to a shoe, the lower face likewise becomes flattened. The curvature of the lower face thus depends upon the material used, since for a given angle and depth of bevel in the upper face the lower face will need to be curved to a greater or less extent depending upon the compressibility and other qualities of the stock of which the heel is made. For example, a stock that is comparatively soft, open and porous will stand considerable compression, while a

stiffer stock compresses less during the application of the heel to the shoe and would tend to hump outwardly at the lower surface 4 unless the lower surface were made flatter than when the softer stock is used. Any humping of this sort, or any other departure from a flat lower surface in service would be undesirable because the area of the heel in contact with the pavement or the like would be thereby decreased, and as a result the heel would not afford as firm and secure a footing. And since a stiffer stock is often preferred for the smaller sizes of heels on account of the greater pressure per square inch with small heels, the stiffness of the stock used commercially does vary somewhat with the size of the heel, so that in practice the curvature of the lower face 4 of the heel will not be the same for all sizes and qualities of heel.

By having the line of junction 28 conform to the contour of the outer heel lift of the shoe to which the resilient heel 1 is applied, a substantially uniform depth of bevel 8 and 9 is assured all the way around the heel, and this assures an even and uniform pressure of all points of the upper breast edge, side edges and rear edge against the shoe when the heel is applied, thereby giving the desired uniformity of grip on the edge all the way around the heel and preventing the edge from becoming separated from the shoe at any point.

In view of the above, it is believed that the various features of this invention will be clear without elaboration, and it will be seen that with the heel herein disclosed the several objects of the invention are achieved and other advantageous results attained.

As various possible embodiments might be made of the above invention and as various changes might be made in the embodiment above set forth, it is to be understood that all matter herein set forth or shown in the accompanying drawings is to be interpreted as illustrative and not in a limiting sense.

I claim:

1. A resilient heel comprising a heel-section or body having a convex lower surface, the upper surface being provided with an upwardly and outwardly extending beveled marginal portion rectilinear in cross-section, and a central plane portion, the upper breast edge being concave below the plane connecting the upper corners of the heel.

2. A rubber heel attachment for shoe heels, comprising an elastic heel-section having a convex outer or lower surface, and an upper surface comprising a central portion and a beveled portion extending outwardly and upwardly therefrom, entirely around the heel, the outer sides and rear edge of the bevel being disposed substantially in a plane, and the upper breast edge being dished below said plane, whereby when the heel-section is applied to the heel, the bevel and central portions may be flattened against the heel, and said outer edge may fit securely against the heel, the curvature of the lower surface being such that said surface may become substantially plane.

3. A resilient heel of a single element of elastic material and comprising a convex lower surface, a plane upper surface having an upwardly and outwardly extending bevel substantially rectilinear in cross-section, the outer edge of the side and rear bevels being all substantially in a single plane parallel to the plane of the central portion, the side and rear bevels being of uniform depth and angle, whereby, after a uniform amount of material is removed from the periphery of the heel, the outer side and rear edges of the bevel are still substantially in a single plane parallel to the central portion and the upper breast edge being dished below said plane to insure a tight fit of the upper corners of the heel against the shoe; and means whereby the heel may be attached to a shoe, the beveled portion then flattening out and bearing tightly against the heel at all points, and the lower surface having such curvature that said surface becomes substantially a plane parallel to said central portion.

4. A one piece resilient heel having an upper surface provided with a plane depressed portion, the upper surface flattening against a flat heel surface and the lower surface being protuberant opposite said plane depressed portion and flattening when the heel is applied to the heel surface of a shoe.

In testimony whereof, I have signed my name to this specification this second day of June, 1917.

WALTER E. SANDERS.

MISSING PAGES

Parts of application filed

Petition,	June 22, 1915.
Affidavit,	" ", 1915.
Specification,	" ", 1915.
Drawing,	" ", 1915.
Old Patent,	June 22, 1915.
Abstract of Title (Ordered),	" ", 1915.
Cash, $30,	June 22, 1915.
Cert. Dep.	—— —, 191-.
Appl. filed complete	June 22, 1915.

[fol. 328] Original Patent No. 1,110,730, Date Sept. 15, 1914.
Examined, H. C. Armstrong, Dec. 1, 1915.
Notice of Allowance by Commissioner, Dec. 1, 1915.
Reissued January 11, 1916.
Attorneys: R. S. & A. B. Lacey, City.
Associate Attorney: —— ——.
Reissue No. —. Patent Reissued —— —, 191-.
Name: —— ——.
10 claims. Resilient Heels. (36-35.)

B-F

Reissue Serial No. 35710. Paper No. 1.
U. S. Pat. Office, Jun. 24, 1915. Division XI.
Application filed June 22, 1915.
$30 Rec'd Jun. 22, 1915. J. C. C., U. S. Pat. Office. 7218-R.

In the United States Patent Office

Petition

To the Commissioner of Patents:

Your petitioner, John G. Tufford, a citizen of the United States of America, residing at Elyria, in the County of Lorain, and State of Ohio, whose post-office address is 1217 East Avenue, Elyria, Ohio, prays that he may be allowed to surrender the Letters Patent for Improvements in Resilient Heels, granted to him September 15, 1914, No. 1,110,730, whereof The I. T. S. Rubber Company, on behalf and with the consent of which this application is made, is now the sole owner, by assignment, and that Letters Patent may be reissued to said The I. T. S. Rubber Company for the same invention upon the annexed amended specification. With this petition is filed an abstract of title, duly certified, as required in such cases.

And he hereby appoints the firm of R. S. & A. B. Lacey, of Washington, D. C., Anderson B. Lacey and Samuel N. Acker constituting said firm (Registration No. 496), his attorneys, with full power of substitution and revocation, to prosecute this application, to make alterations and amendments therein, to sign the drawings, [fol. 329] to receive the Letters Patent, and to transact all business in the United States Patent Office connected therewith.

Signed at Washington, in the District of Columbia, this 15th day of June, 1915.

John G. Tufford. (Seal.)

The undersigned, assignee of the entire interest in the above-mentioned Letters-Patent, hereby assents to the accompanying application.

The I. T. S. Rubber Company, by J. G. Tufford, President. (Seal.)

Specification

To all whom it may concern:

Be it known That I, John G. Tufford, a citizen of the United States of America, residing at Elyria, in the County of Lorain, and State of Ohio, have invented certain new and useful Improvements in Resilient heels, of which the following is a specification:

This invention relates to shoe heels, and more particularly to an improvement in cushion heels of that type comprising an elastic lift adapted to be applied to the ordinary heel.

The ordinary form of elastic lift now in common use is flat upon both its upper and under faces so that its flat upper face will bear flat against the flat under face of the lowermost leather lift of the heel to which the cushion heel is applied. As a consequence, after the elastic or cushion lift has been applied and the shoe has been worn for a short time, the pressure to which the cushion lift is subjected will result in its edge portions being projected or spread to a greater or less degree beyond the sides of the shoe heel proper, presenting an unsightly appearance and providing a crack or space into which dirt may enter, rendering the heel uneven and weakening its connection with the shoe heel proper. I am aware that it

Per B. has been proposed to employ a cushion lift having a

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concave upper face to be applied to the under face of the shoe heel proper, but I do not believe that up to the present time any practical and satisfactory means has been discovered and employed for attach- [fol. 330] ing such a lift so that its connection with the shoe heel will be to any extent permanent. The method usually employed in securing such cushion lifts in place is to embed in the lift a plate conforming in contour to the concavity of the lift and then secure the lift in place by driving nails or screws through the plate and into the heel of the shoe, and where this method is not followed circular washers are embedded in the lift and have nails or other securing elements driven through them and into the shoe heel. In the first instance, the pressure imposed upon the heel will tend to flatten out the plate thereby causing its edges to cut through the lift besides weakening or loosening the securing elements, and, in the second instance, so far as I am aware, the washers have been circular and are

arranged so as to be exposed at the tread surface of the lift after the shoe has been worn for a short time.

It is, therefore, one aim of the present invention to provide a cushion lift so constructed that, when applied to a shoe heel, its edge portions will not be forced to project beyond the sides of the heel, when pressure is applied, and to so arrange the attaching means for the lift that the lift may wear to a maximum extent without exposing such fastening means.

Another aim of the invention is to so arrange the attaching devices that they will be located relatively remote from the edge of the heel

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lift, whereby the lift may wear to a maximum extent without exposing the same, and incidentally the invention contemplates so constructing the washers which constitute an element of the securing means as to further prolong the life of the lift.

The invention has as another object to so form the concave upper side of the cushion lift that, when the lift is subjected to pressure, any tendency for the edge portions of the lift to crowd beyond the sides of the shoe will be counteracted and there will be equally as great a tendency for the material of the lift to crowd or compress toward the center thereof.

The result last-mentioned is accomplished in part by forming the concave side of the lift with a number of separate and distinct con- [fol. 331] cave areas which, in fact, constitute a plurality of suction cups co-operating with the underside of the shoe heel when pressure is applied, and inasmuch as these concave areas are separated from each other, the expansion or spreading of the portion of the lift of which they constitute the surfaces will be accommodated so as to secure the result aimed at.

The invention aims further to construct the lift and the attaching means therefor in such a manner as not to destroy or impair the suction action resulting from the use of a lift having a concave upper surface.

In the accompanying drawings:

Figure 1 is a perspective view of the lift embodying the present invention applied to a shoe heel;

Fig. 2 is a front to rear sectional view through the lift in position

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disposed against the under side of a shoe heel and immediately prior to application thereto;

Fig. 3 is a similar view through the heel, illustrating the same applied;

Fig. 4 is a perspective view looking at the upper side of the lift removed; and

Fig. 5 is a perspective view of one of the washers comprising an element of the attaching means for the lift.

In the drawings, the numeral 1 indicates the heel of a shoe and 2 the cushion lift embodying the present invention. The lift 2 is, as usual, formed from rubber, and is molded or cut so as to be of

concavo-convex form on any line of cross section. In marginal outline, the lift is of substantially the same outline as the side of the shoe heel 1 and is, of course, to be finished to the same dimensions as the usual shoe heel, either before or after its application thereto. The concave upper side of the lift 2 is indicated by the numeral 3, and the convex under side by the numeral 4. It is preferable that

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the lift be of the same thickness throughout and that its marginal surface be at all points radial to the center of curvature of its concave [fol. 332] side 3 so that, when the lift is applied to the shoe heel and subjected to pressure, its said marginal surface will be coincident with the side of the shoe heel.

As a means for securing the lift in place upon the under side of the shoe heel, small nails or other suitable securing elements 5 are employed and are driven through washers 6, which are embedded in the lift, and into the shoe heel. These washers 6 are of the form shown in Fig. 5 of the drawings, and each is of segmental form, the chordal edge of each washer being so positioned that the arcuate edge thereof will describe approximately three-fourths of a circle. Each washer is provided with an opening 7 to accommodate the nails or other securing elements 5, and the said opening in each washer is located concentric to the arcuate edge thereof. By reference to Figs. 1 and 4 of the drawings, it will be observed that the washers are so embedded and arranged within the body of the lift that their chordal edges will be presented toward the adjacent portion of the edge of the said body, so that, broadly speaking, that edge portion of each washer which is nearest the edge of the body of the lift will be spaced from said edge a greater distance than if the washers were of practically circular form. At this point it may be remarked that by so forming the washers and by arranging them in the manner stated and shown, a maximum wear of the edge portions of the lift is provided for before the washers can be exposed. It will further be observed by reference to the figures of the drawings that the washers

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are spaced substantially equi-distant from the margin of the lift and that they are located as near the center of the lift as is practical considering a peculiar construction of the lift which will presently be described. The body of the lift 2 is formed in alinement with the opening 7 in each of the washers 6 with openings 8 and 9 which are extremely small in diameter and terminate respectively at the convex and concave sides of the lift. In fact, these openings are so minute that, when the nails 5 are driven through the lift, the walls of the openings will be crowded and, consequently, will snugly embrace and fit the surface of the nails. It has before been stated that [fol. 333] a suction force is exerted due to the concave upper side of the lift, and it will now be apparent that due to the snug fit of the nails in the openings 8 and 9 the partial vacuum established when pressure is exerted upon the heel will not be

Insert D^1. destroyed or impaired.

D^1

As before pointed out, the concave side of the lift is provided with a number of concave or suction areas and in forming these areas channels 10 and 11 are molded or cut in the concave face of the lift and preferably extend respectively concentric to the forward and curved edges of the lift, as clearly shown in Fig. 4 of the drawings. These channels are relatively narrow and relatively shallow, and in addition thereto there are channels 12 and 13 which extend respectively from front to rear and transversely of the concave surface of the lift. In this manner, the central portion of said surface is divided into four suction or concave

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areas in addition to the main area which may be considered as surrounding the group of first-mentioned areas which, in the drawings, are indicated at 14, and it will be apparent that, if desired, the channels may have different lines of extent than here shown, whereby to increase or decrease the number of suction areas 14 or to vary the arrangement thereof.

It will now be seen that, when the lift is subjected to pressure, each of the several suction areas 14 will be flattened and a partial vacuum created at each point of their location as well as throughout the entire surface of the upper side of the lift. The formation of the group of suction areas, however, presents this advantage, namely, that the channels resulting in their formation accommodate the marginal portions of the material of the lift of which the areas constitute the surfaces when these portions are spread due to the pressure exerted and, therefore, the lift is not compressed or spread bodily from its central portion toward its margin, but the expansion due to compression is equalized throughout the body of the lift. Insert B^1.

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Having thus described the invention, what I claim as new is:—

[fol. 334] —1—

A cushion heel lift having washers embedded therein near its center portion and each of segmental form, the washers being arranged with their chordal edges presented toward the edge of the lift.

—2—

A cushion heel lift divided by a plurality of inter-communicating channels into a group of suction areas.

—3—

A cushion heel lift having a concave attaching face formed with a groove having a line of extent substantially parallel to the margin of the lift and having other channels intersecting each other and communicating with the first-mentioned channel.

—4—

A cushion heel lift having its attaching face provided with a suction area located substantially centrally thereof, and washers embedded in the lift and located in a series extending around the said area and located relatively close thereto, the washers at their sides which are located nearer the margin of the lift being straight edged.

Canceled per B

—5—

A cushion heel lift having a concavo-convex form on every line of cross section.

—6—

A cushion heel lift, the attaching face of which is concave and the tread face of which is convex on every line of cross section.

[Matter enclosed between rules erased in copy.]

Sub C[1]

[—7—]*

Insert B[2] 5a. A cushion heel lift, $\underset{B^2}{\wedge}$ the attaching face of which is concave and the tread face of which is convex on every line of cross section, there being nail receiving openings penetrating the lift near the center thereof.

[—8—]*

Insert B[3] 6a. A cushion heel lift, $\underset{B^3}{\wedge}$ the attaching face of which

Insert B[4] is normally concave $\underset{B^4}{\wedge}$ and the tread face of which is [fol. 335] normally convex on every line of cross section, thereby to cause the entire margin of the lift to snugly engage the heel of a shoe when said lift is positioned on the heel and pressure applied to the convex face thereof to flatten said lift.

[—9—]*

Insert B[5] 7a. A cushion heel lift $\underset{B^5}{\wedge}$ having a concavo-convex form on every line of cross section and provided with openings piercing the lift near the crest of the convex face thereof.

[Matter enclosed between rules erased in copy.]

[*Words and figures enclosed in brackets erased in copy.]

[—10—]*

8a. A heel lift formed of yieldable material and provided with a normally convex tread face and a normally concave attaching face defining a suction area whereby, when the lift is positioned on the flat surface of a heel and pressure is applied to the convex face entire attaching face
Per A. of the lift, the ∧ [margin]* of said lift will be retained face
" " in engagement with the ∧ [margin]* of the heel by the action of the suction area.

Insert A¹.>

In Testimony Whereof, I affix my signature.

John G. Tufford. (Seal.)

Oath

STATE OF OHIO,
District of Columbia,
County of Lorain, ss:

John G. Tufford, the above-named petitioner, being duly sworn, deposes and says that he is a citizen of the United States of America, and a resident of Elyria, in the County of Lorain, and State of Ohio; that he verily believes himself to be the original, first and sole inventor of the Improvements set forth and claimed in the foregoing specification and for which he solicits a patent; that he does not know and does not believe that said improvements were ever before known or used; that he believes the Letters-Patent referred to in the foregoing petition and herewith surrendered are inoperative or in- [fols. 336 & 337] valid for the reason that the specification thereof is defective or insufficient and that such defect or insufficiency consists particularly in the omission to claim adequately therein that which he had really invented and disclosed; and he further says that the errors which render said patent so inoperative or invalid arose from inadvertence, accident or mistake, and without any fraudulent or deceptive intention upon his part; and that the following is a true specification of the errors constituting such inadvertence: Failure to clearly comprehend and point out on the part of his attorneys the true invention made by him in that the claims restricted the invention to a heel lift in which washers of a particular form are embedded and to a heel lift in which intercommunicating channels are formed in the attaching face, whereas he did not, in fact, consider his invention so limited. Deponent further says that the error so particularly specified arose as follows: Joint consideration of deponent's said invention and application by him and his attorneys was had principally by correspondence and was then believed by him to be adequate to afford his attorneys a full and accurate understanding of the invention; that he was not specifically and at length

[*Words and figures enclosed in brackets erased in copy.]

advised of the actions of the Patent Office upon his application and the application was amended without his complete knowledge; that, by reason of his limited knowledge of patents and patent law, he did not understand and appreciate the actual scope of the claims of his patent until recently when the same was explained fully to him in connection with the commercial exploitation of the invention; and that he believes that the failure of his attorneys to obtain claims of proper character and scope was due to the omission of a proper personal conference between him and his attorneys after his application was acted upon by the Patent Office and the failure of his attorneys to realize the full importance and value of those features of the invention which give to it its real and practical value.

John G. Tufford. (Seal.)

Subscribed and sworn to before me this 15th day of June, 1915. J. K. Moore, Notary Public. (Seal.)

(Here follows specification marked side folio pages 338, 339, 340, 341, and 342)

[fol. 343] Surrendered. No. 1,110,730

The United States of America to all to whom these presents shall come:

Whereas John C. Tufford, of Elyria, Ohio, has presented to the Commissioner of Patents a petition praying for the grant of Letters Patent for an alleged new and useful improvement in Resilient Heels, he having assigned one-sixth of his right, title, and interest in said improvement to Carl H. Ingwer, one-sixth to Arthur G. Smith, and one-twelfth to William C. Smith, all of Elyria, Ohio, a description of which invention is contained in the specification of which a copy is hereunto annexed and made a part hereof, and has complied with the various requirements of law in such cases made and provided, and

Whereas, upon due examination made the said Claimant is adjudged to be justly entitled to a patent under the law.

Now therefore these Letters-Patent are to grant unto the said John G. Tufford, Carl H. Ingwer, Arthur G. Smith, and William C. Smith, their heirs or assigns for the term of Seventeen years from the fifteenth day of September, one thousand nine hundred and fourteen, the exclusive right to make, use and vend the said invention throughout the United States and the Territories thereof.

In testimony whereof, I have hereunto set my hand and caused the seal of the Patent Office to be affixed at the City of Washington this fifteenth day of September, in the year of our Lord one thousand nine hundred and fourteen, and of the independence of the United States of America the one hundred and thirty-ninth.

R. F. Whitehead, Acting Commissioner of Patents. (Seal.)

R. S. & A. B. Lacey. 18,105. 1915.

J. G. TUFFORD.

RESILIENT HEEL.

APPLICATION FILED JULY 21, 1913.

338

1,110,730.

Patented Sept. 15, 1914.

Fig. 1.

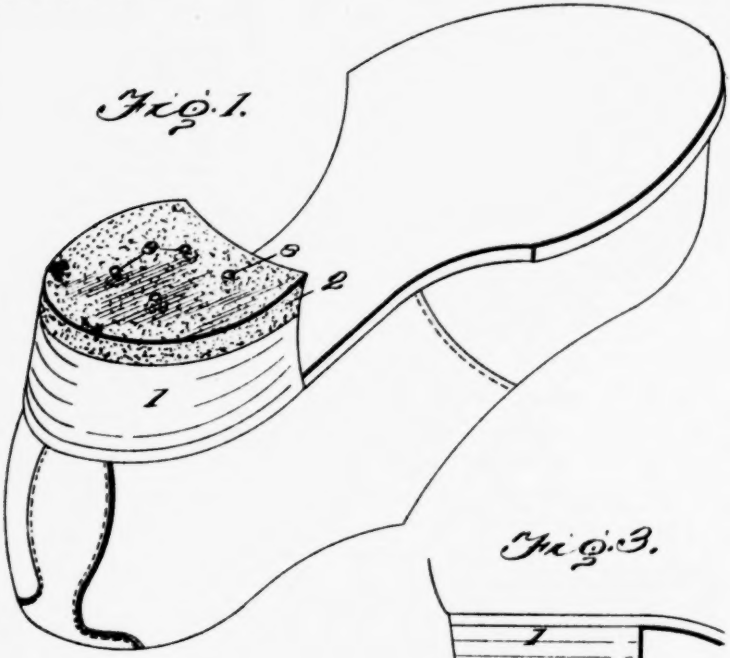


Fig. 3.

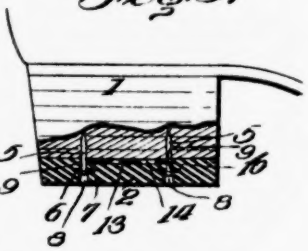


Fig. 2

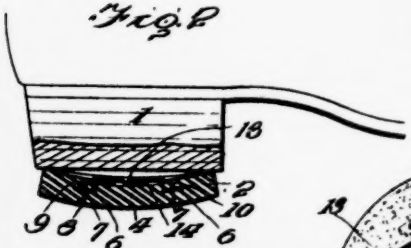


Fig. 4.

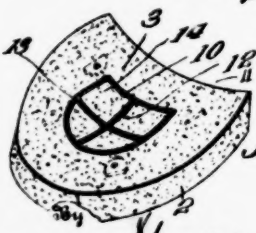


Fig. 5.

Witnesses

Inventor

J. G. Tufford.

By

Attorneys.

UNITED STATES PATENT OFFICE.

JOHN G. TUFFORD, OF ELYRIA, OHIO, ASSIGNOR OF ONE-SIXTH TO CARL H. INGWER, ONE-SIXTH TO ARTHUR G. SMITH, AND ONE-TWELFTH TO WILLIAM C. SMITH, ALL OF ELYRIA, OHIO.

RESILIENT HEEL.

1,110,730. Specification of Letters Patent. Patented Sept. 15, 1914.

Application filed July 21, 1913. Serial No. 780,280.

REISSUED

To all whom it may concern:

Be it known that I, JOHN G. TUFFORD, citizen of the United States, residing at Elyria, in the county of Lorain and State of Ohio, have invented certain new and useful Improvements in Resilient Heels, of which the following is a specification.

This invention relates to shoe heels and more particularly to an improvement in cushion heels of that type comprising an elastic lift adapted to be applied to the ordinary heel.

The ordinary form of elastic lift now in common use is flat upon both its upper and under faces so that its flat upper face will bear flat against the flat under face of the lowermost leather lift of the heel to which the cushion heel is applied. As a consequence, after the elastic or cushion lift has been applied and the shoe has been worn for a short time, the pressure to which the cushion lift is subjected will result in its edge portions being projected or spread to a greater or less degree beyond the sides of the shoe heel proper, presenting an unsightly appearance and providing a crack or space into which dirt may enter, rendering the heel uneven and weakening its connection with the shoe heel proper.

I am aware that it has been proposed to employ a cushion lift having a concave upper face to be applied to the under face of the shoe heel proper but I do not believe that up to the present time any practical and satisfactory means has been discovered and employed for attaching such a lift so that its connection with the shoe heel will be to any extent permanent. The method usually employed in securing such cushion lifts in place is to embed in the lift a plate conforming in contour to the concavity of the lift and then secure the lift in place by driving nails or screws through the plate and into the heel of the shoe, and where this method is not followed circular washers are embedded in the lift and have nails or other securing elements driven through them and into the shoe heel. In the first instance the pressure imposed upon the heel will tend to flatten out the plate thereby causing its edges to cut through the lift besides weakening or loosening the securing elements, and, in the second instance, so far as I am aware, the washers have been circular and are arranged so as to be exposed at the tread surface of the lift after the shoe has been worn for a short time.

It is therefore one aim of the present invention to provide a cushion lift so constructed that when applied to a shoe heel its edge portions will not be forced to project beyond the sides of the heel when pressure is applied and to so arrange the attaching means for the lift that the lift may wear to a maximum extent without exposing such fastening means.

Another aim of the invention is to so arrange the attaching devices that they will be located relatively remote from the edge of the heel lift, whereby the lift may wear to a maximum extent without exposing the same, and incidentally the invention contemplates so constructing the washers which constitute an element of the securing means as to further prolong the life of the lift.

The invention has as another object to so form the concave upper side of the cushion lift that when the lift is subjected to pressure any tendency for the edge portions of the lift to crowd beyond the sides of the shoe heel will be counteracted and there will be equally as great a tendency for the material of the lift to crowd or compress toward the center thereof

The result last mentioned is accomplished in part by forming the concave side of the lift with a number of separate and distinct concave areas which in fact constitute a plurality of suction cups coöperating with the under side of the shoe heel when pressure is applied and inasmuch as these concave areas are separated from each other the expansion or spreading of the portion of the lift of which they constitute the surfaces, will be accommodated so as to secure the result aimed at.

The invention aims further to construct the lift and the attaching means therefor in such a manner as not to destroy or impair the suction action resulting from the use of a lift having a concave upper surface.

In the accompanying drawings: Figure 1 is a perspective view of the lift embodying the present invention applied to a shoe heel. Fig. 2 is a front to rear sectional view through the lift in position disposed against the under side of a shoe heel and immediately prior to application thereto. Fig. 3 is a similar view through the heel illustrating the same applied. Fig. 4 is a perspective

view looking at the upper side of the lift removed. Fig. 5 is a perspective view of one of the washers comprising an element of the attaching means for the lift.

In the drawings the numeral 1 indicates the heel of a shoe and 2 the cushion lift embodying the present invention. The lift 2 is, as usual, formed from rubber, and is molded or cut so as to be of concavo convex form on any line of cross section. In marginal outline the lift is of substantially the same outline as the side of the shoe heel 1 and is, of course, to be finished to the same dimensions as the usual shoe heel, either before or after its application thereto. The concave upper side of the lift 2 is indicated by the numeral 3 and the convex under side by the numeral 4. It is preferable that the lift be of the same thickness throughout and that its marginal surface be at all points radial to the center of curvature of its concave side 3 so that when the lift is applied to the shoe heel and subjected to pressure its said marginal surface will be coincident with the side of the shoe heel.

As a means for securing the lift in place upon the under side of the shoe heel, small nails or other suitable securing elements 5 are employed and are driven through washers 6, which are embedded in the lift, and into the shoe heel. These washers 6 are of the form shown in Fig. 5 of the drawings and each is of segmental form, the chordal edge of each washer being so positioned that the arcuate edge thereof will describe approximately three-fourths of a circle. Each washer is provided with an opening 7 to accommodate the nails or other securing elements 5 and the said opening in each washer is located concentric to the arcuate edge thereof. By reference to Figs. 1 and 4 of the drawings it will be observed that the washers are so embedded and arranged within the body of the lift that their chordal edges will be presented toward the adjacent portion of the edge of the said body, so that broadly speaking, that edge portion of each washer which is nearest the edge of the body of the lift will be spaced from said edge a greater distance than if the washers were of practically circular form. At this point it may be remarked that by so forming the washers and by arranging them in the manner stated and shown, a maximum wear of the edge portions of the lift is provided for before the washers can be exposed. It will further be observed by reference to the figures of the drawings that the washers are spaced substantially equi-distant from the margin of the lift and that they are located as near the center of the lift as is practical considering a peculiar construction of the lift which will presently be described. The body of the lift 2 is formed in alinement with the opening 7 in each of the washers 6 with openings 8 and 9 which are extremely small in diameter and terminate respectively at the convex and concave sides of the lift. In fact, these openings are so minute that when the nails 5 are driven through the lift, the walls of the openings will be crowded and consequently will snugly embrace and fit the surface of the nails. It has before been stated that a suction force is exerted due to the concave upper side of the lift, and it will now be apparent that due to the snug fit of the nails in the openings 8 and 9 the partial vacuum established when pressure is exerted upon the heel will not be destroyed or impaired.

As before pointed out, the concave side of the lift is provided with a number of concave or suction areas and in forming these areas channels 10 and 11 are molded or cut in the concave face of the lift and preferably extend respectively concentric to the forward and curved edges of the lift as clearly shown in Fig. 4 of the drawings. These channels are relatively narrow and relatively shallow and in addition thereto there are channels 12 and 13 which extend respectively from front to rear and transversely of the concave surface of the lift. In this manner the central portion of said surface is divided into four suction or concave areas in addition to the main area which may be considered as surrounding the group of first mentioned areas which in the drawings are indicated at 14, and it will be apparent that if desired the channels may have different lines of extent than here shown, whereby to increase or decrease the number of suction areas 14 or to vary the arrangement thereof.

It will now be seen that when the lift is subjected to pressure each of the several suction areas 14 will be flattened and a partial vacuum created at each point of their location as well as throughout the entire surface of the upper side of the lift. The formation of the group of suction areas, however, presents this advantage, namely, that the channels resulting in their formation accommodate the marginal portions of the material of the lift of which the areas constitute the surfaces when these portions are spread due to the pressure exerted and therefore the lift is not compressed or spread bodily from its central portion toward its margin but the expansion due to compression is equalized throughout the body of the lift.

Having described the invention, what I claim is:

1. A cushion heel lift having washers embedded therein near its center portion and each of segmental form, the washers being arranged with their chordal edges presented toward the edge of the lift.

2. A cushion heel lift divided by a plural-

ity of intercommunicating channels into a group of suction areas.

3. A cushion heel lift having a concave attaching face formed with a groove having a line of extent substantially parallel to the margin of the lift and having other channels intersecting each other and communicating with the first mentioned channel.

4. A cushion heel lift having its attaching face provided with a suction area located substantially centrally thereof. and washers embedded in the lift and located in a series extending around the said area and located relatively close thereto, the washers at their sides which are located nearer the margin of the lift being straight edged.

In testimony whereof I affix my signature in presence of two witnesses.

JOHN G. TUFFORD. [L. S.]

Witnesses:
J. D. YOAKLEY,
SAMUEL N. ACKER.

2–403

Department of the Interior,
Washington, D. C., June 29, 1915.

Application of John G. Tufford, Elyria, Ohio, assignor of one-sixth to Carl H. Ingwer, one-sixth to Arthur G. Smith, and one-[fol. 344] twelfth to William C. Smith, Elyria, Ohio for Reissue of Letters Patent, No. 1,110,730, dated Sept. 15, 1914 for improvement in "Resilient Heel."

I certify that the annexed is a true copy from the Digest of Assignments in this Division of all assignments of undivided interest found of record under or relating to the aforesaid Letters Patent up to and including June 15, 1915.

Willis B. Magruder, Chief of Assignment Division.

W. G. W.

1

John G. Tufford.

Instrument dated July 16, 1913. Recorded July 21, 1913. Liber W. 92, p. 111.

(Acknowledged —— —, ——.)

Parties: John G. Tufford to Carl Ingever and Arthur J. Smith, Elyria, Ohio.

Invention: Resilient Heels.

About to make appln.

Exctd. July 16, 1913.

Pat. 1,110,730. Sept. 15, 1914.

Tufford assigns to each assignee an undivided one-sixth of his right, title and interest in said invention and letters patent therefor. Letters patent to issue in accordance herewith. Consideration $1.

Instrument dated July 16, 1913. Recorded Mar. 10, 1914. Liber I 94, p. 199.

(Acknowledged July 16, 1913, and Mar. 7, 1914.)

Parties: John G. Tufford to Carl H. Ingwer, Arthur G. Smith, both of Elyria, Ohio.

Invention: Resilient Heels.

About to make appln.

Exctd. July 16, 1913.

Pat. 1,110,730. Sept. 15, 1914.

Re-record of deed recorded in Liber W. 92, page 111, of Transfers of Patents changing assignees' names as follows: "Carl Ingever" to "Carl H. Ingwer" and "Arthur J. Smith" to "Arthur G. Smith" [fol. 345] to which is added affidavit made by Tufford March 7, 1914, in which he states that the corrections in said names were made by him, and initialed in the margin of the assignment, and that the correct names are Carl H. Ingwer and Arthur G. Smith.

Instrument dated Apr. 29, 1914. Recorded May 5, 1914. Liber X 94, p. 432.

(Acknowledged —— —, ——.)
Parties: J. G. Tufford to William C. Smith, Elyria, Ohio.
Invention: Resilient Heels.
Filed July 21, 1913. Ser. No. 780,290.
Pat. 1,110,730. Sept. 15, 1914.
Tufford assigns an undivided one-twelfth of his right, title and interest in said invention and letters patent therefor. Letters patent to issue in accordance herewith. Consideration $1,000.

Instrument dated Aug. —, 1914. Recorded Jan. 5, 1915, Liber G 96, p. 292.
(Acknowledged Oct. 9, 1914.)
Parties: John G. Tufford, Carl H. Ingwer, Arthur G. Smith, Wm. C. Smith to The I. T. S. Rubber Company, Elyria, Ohio.
Invention: Resilient Heels.
Ser. No. 780,290.
Patented Sept. 15, 1914. 1,110,730.
These assignors, stating that they own said patent and all rights thereunder, assign the whole right, title and interest in said invention and letters patent. $10,000 and other consideration.

Patent Office,
Jul. 8, 1915,
Mailed.

Paper No. 1

Div. 11, Room 154

Department of the Interior,
United States Patent Office,
Washington, July 8, 1915.

MAF/FAW.

R. S. & A. B. Lacey, City:

Please find below a communication from the Examiner in charge [fol. 346] of the application of John G. Tufford, Ser. No. 35,710 filed June 22, 1915, for Resilient Heels.

Thomas Ewing, Commissioner of Patents.

This case has been examined.
Claims 5 to 10 inclusive are rejected on Hale, 740,124, Sept. 29, 1903 (36-35), or Stern (British), 8159, Apr. 7, 1913 (36-35) in view of Yahraus, 817,355, Apr. 10, 1906 (36-35). The latter patent shows a lift having a depressed top surface and a marginal ridge 5. It also has nail receiving openings, the arrangement being such that when the securing nails are passed through the openings into the heel, the marginal portion 5 will make a tight fit with the margin of the heel.
Whether the securing nails are at the center or near the center is immaterial. The patent of Stern shows plainly that the centrally

located securing screw c forces the lift against the heel thereby flattening the lift.

H. C. Armstrong Examiner.

F. A. W.

Application Room,
Aug. 20, 1915,
U. S. Patent Office.

U. S. Patent Office,
Aug. 21, 1915,
Division I.

Serial No. 35,710

Paper No. 2. 2

In the United States Patent Office

Room No. 154

B—GS. August 17, 1915. 7218–R.

Serial No. 35,710. Filed Aug. 20, 1915. John G. Tufford. Resilient Heels. Filed June 22, 1915

Amendment A and Affidavits

Hon. Commissioner of Patents:

SIR: Responsive to official action of July 8, 1915, amendment is hereby made as follows:

Add the following claim:

A^1. [11]* 9a. A cushion heel lift formed in one integral member having its attaching face [member]* concave throughout its area and on every line of cross [fol. 347] section and its tread face convex throughout its area and on every line of cross section, the attaching face forming an extended suction area to hold the lift in intimate contact with a shoe heel when flattening pressure is applied to the convex tread face of the lift.

Per B

[Matter enclosed between rules erased in copy.]

Remarks

Insert B^6.>

Reconsideration of this application is requested for the reason that the claims set forth a new article consisting of a cushion heel or lift which is concavo-convex on every line of cross section. The British patent, which has been cited as a reference is eliminated from further consideration by the affidavits filed herewith, and the other references of record cannot be held to anticipate applicant's invention.

[*Words and figures enclosed in brackets erased in copy.]

The patent to Hale shows a heel consisting of a flat piece of rubber or other elastic material which is cut away at its center and backed with canvas. The central cut away portion or opening is filled with a flat piece of leather which is somewhat larger than the opening into which it is fitted. In theory, the leather center will cause the rubber outer portion of the heel to assume an arcuate form about the canvas backing, but it is obvious that the relative size of the opening in the rubber and the area of the leather filling must be very nicely and accurately adjusted or the only result had from an attempt to force the leather into place will be a buckling of the leather. Assuming, however, that the result in every instance is to provide a heel of the form shown in Fig. 5 of the Hale drawings, it seems to be obvious that, if a pressure be applied to the heel strong enough to flatten it against the shoe heel, the rubber edge portion will be torn away from the canvas backing and the leather center so that there will be no intimate contact between the two elements and sand or other foreign matter can easily work into the space between the shoe and the alleged cushion heel and between the rubber and leather components of said cushion heel. This reference certainly does not show a cushion heel or lift which is formed in one integral member and which, before its application to a shoe, is concavo-convex on every line of cross section and throughout its area.

The patent to Yahraus is obviously less pertinent than the Hale [fol. 348] patent. The Yahraus patent apparently is cited merely to show a heel having a marginal rib. There is no intimation in this patent of a heel which has a concavo-convex on every line of cross section, nor is there anything contained in this patent which indicates, in any way, that the patentees has any conception of such a heel as applicant has produced. This patent shows a flat heel and when pressure is applied to the center of this heel or the lift, the margin of the same will be spread so that the rib along the margin, instead of being in intimate contact with the shoe, will be spread out so as to be turned from the shoe heel or else project beyond the margin of the same. These patentees seem to depend upon the metallic reinforcing plate to effect a sealing engagement between the rib or flange and the shoe, but they do not explain with any clearness at all in what manner this metallic reinforcing plate can effect such sealing engagement. It is not seen that the references answer any of the claims presented by applicant, and it is, therefore, thought all the claims should be favorably considered and the application allowed.

Respectfully submitted, R. S. & A. B. Lacey, Attys. for John G. Tufford.

Application Room,
Aug. 20, 1915,
U. S. Patent Office.

2. B/H. 7218-R.

Affidavit

STATE OF OHIO,
County of Lorain, ss:

John G. Tufford, being duly sworn, deposes and says that he is the same John G. Tufford to whom Letters Patent No. 1,110,730, were granted September 15, 1914, and who, on June 22, 1915, filed an application, Serial No. 35,710, for a reissue of said Letters Patent; that he conceived and completed the invention disclosed in said Letters Patent and in said application for reissue prior to April 7, 1913; that prior to April 7, 1913, he made and applied to his own shoes, at Elyria, Ohio, a pair of rubber heels which were concavo-convex on every line of cross section before being applied to the shoe [fol. 349] heel and had nail receiving openings near the center thereof; that after being applied to the shoe heel the said rubber heels made by him were flat and the entire margins thereof fitted snugly to the heel of the shoe, the concave face of the rubber heel under pressure, acting as a suction area to hold the same to the shoe heel; that the said rubber heels, so made by him prior to April 7, 1913, were used by him until worn out; that he does not know and does not believe that the invention disclosed in said Letters Patent and in said application was in public use or on sale in the United States of America for more than two years prior to his original application for patent thereon, or patented or described in a printed publication in any country for more than two years prior to his said application; and that he has never abandoned the invention.

J. G. Tufford. (Seal.)

Sworn to and subscribed before me this 12 day of Aug. 1915.
J. C. Crisp, Notary Public. (Seal.)

Application Room,
Aug. 20, 1915,
U. S. Patent Office.

2. B/H. 7218-R.

Affidavit

STATE OF OHIO,
County of Lorain, ss:

Joseph W. Tufford, being duly sworn, deposes and says that he is a citizen of the United States of America, and a resident of Elyria, Ohio; that he is acquainted with John G. Tufford, of Elyria, Ohio, who, on September 15, 1914, was granted Letters Patent No. 1,110,730; that prior to April 7, 1913, the said John G. Tufford showed

him and explained to him rubber heels made by said John G. Tufford, and that said rubber heels so shown to him and explained to him by said John G. Tufford were concavo-convex on every line of cross section before being applied to the shoe heel and had nail receiving openings near the center thereof; that said rubber heels were applied to a pair of shoes which were worn by said John G. Tufford; that after being applied to the shoes, the said rubber heels were flat and the [fol. 350] entire margins thereof fitted snugly to the heel of the shoe, the concave face of the rubber heel under pressure, acting as a suction area to hold the same to the shoe heel.

Joseph W. Tufford. (Seal.)

Sworn to and subscribed before me this 12 day of Aug. 1915.
J. C. Crisp, Notary Public. (Seal.)

Application Room,
Aug. 20, 1915,
U. S. Patent Office.

2. B/H. 7218-R.

Affidavit

STATE OF OHIO,
County of Cuyahoga, ss:

Ellsworth E. Couch, being duly sworn, deposes and says that he is a citizen of the United States of America, and a resident of Berea, Ohio; that he is acquainted with John G. Tufford of Elyria, Ohio, who, on September 15, 1914, was granted Letters Patent No. 1,110,730; that prior to April 7, 1913, the said John G. Tufford showed him and explained to him rubber heels made by said John G. Tufford, and that said rubber heels so shown to him and explained to him by said John G. Tufford were concavo-convex on every line of cross section before being applied to the shoe heel and had nail receiving openings near the center thereof; that said rubber heels were applied to a pair of shoes which were worn by said John G. Tufford; that after being applied to the shoes, the said rubber heels were flat and the entire margins thereof fitted snugly to the heel of the shoe, the concave face of the rubber heel, under pressure, acting as a suction area to hold the same to the shoe heel.

Ellsworth E. Couch. (Seal.)

Sworn to and subscribed before me this 13th day of August, 1915. Adam Kanaspi, Notary Public. (Seal.)

[fol. 351] Patent Office,
Aug. 30, 1915,
Mailed.

Paper No. 3

Div. 11, Room 154

Department of the Interior,
United States Patent Office,
Washington, August 30, 1915.

B. S. and A. B. Lacey, Washington, D. C.:

Please find below a communication from the Examiner in charge of the application of John C. Tufford, for Resilient Heels, filed September 15, 1914, Serial 35,710.

Thomas Ewing, Commissioner of Patents.

In reply to amendment filed August 20, 1915.

Claims 1, 2, 3 and 4 appear allowable.

Claim 5 is again rejected on Hale of record and also on Cairn (Br.) 8,205, April 5, 1906, (36-39).

Claims 6, 7, 8, 9 and 10 are rejected on Hale.

Claim 11 is rejected on Hale and also on Cairn.

It is quite immaterial of what shape originally the parts of the heel of Hale were. As shown in Fig. 5, when ready for use it has a shape as specified and it is specifically pointed out in the description of this device (see lines 69 to 81 on page 1) that the heel of Hale is attached in the same manner as applicant's.

Claims 5 to 11, inclusive, are also rejected on Ferguson, 638,228, Dec. 5, 1899, (36–36).

The idea of an elastic heel lift having a convex-concave shape before it is placed on the heel proper is fully disclosed in this patent. Whether the suction area used by Ferguson is omitted or not, seems of no consequence.

It is not thought that the shape as specified in claims 5 to 11, inclusive, discloses any new feature in view of the state of the art.

H. C. Armstrong, Examiner, Div. 11

F. A. W.

[fol. 352] Application Room,
Sep. 25, 1915,
U. S. Patent Office.

U. S. Patent Office
Sep. 27, 1915,
Division XI.

Serial No. 35,710, Paper No. 4

1

In the United States Patent Office

Room No. 154

John G. Tufford. Resilient Heels. Filed September 15, 1914.
Serial No. 35,710

B-GS. September 24, 1915. 7218-R.

Amendment B—Filed Sept. 25, 1915

Hon. Commissioner of Patents.

SIR: Responsive to Official action of August 30, 1915, amendment is hereby made as follows:

In line 1 of page 3 of the specification, correct the spelling of "been"

Add to page 8:

Canceled per C

B[1]. It will be noted that my lift is a single integral homogeneous body free of marginal ribs or flanges so that the entire concave surface follows a single arc, the channels formed therein being so shallow as to offier no substantial interruption to the arc although they do actually increase the suction and the holding force. The concavo-convex form is not dependent upon the provisions of a spring plate which will force the same away from the shoe heel and, as the fastening devices are close to the center of the lift, a large lift may be trimmed down to fit a much smaller heel without exposing the fastening and without a cutter being damaged by contact with them. Moreover, it is not necessary for the workman to manually hold the lift in place, nor to employ mechanical devices for that purpose before inserting the fastenings. When a lift is to be applied, it is simply placed against the heel and a strong blow delivered thereon, so that the lift will be flattened against the heel, whereupon the suction will hold the lift, leaving both hands of the workman free to manipulate the trimming and fastening tools and devices.

[Matter enclosed between rules erased in copy.]

Erase claims 5 and 6.
Claim 7, line 1, erase the comma and insert:

[fol. 353] B^2. consisting of a single homogeneous body.

Claim 8, line 1, erase the comma and insert:

B^3. consisting of a single integral body.

Line 2, after "concave" insert:

B^4. and follows a single arc.

Claim 9, line 1, after "lift" insert:

B^5. consisting of a single integral body.

Claim 10, line 5, erase "margin" and insert:

Per C. entire attaching face.

Line 6, erase "margin" and insert: face.
Claim 11, line 2, erase "member" and insert: face.
Adjust the ordinals of the claims and add the following claims:

Cancelled per C.

B^6. 10. A cushion heel lift consisting of a single integral body having an attaching face concave throughout its area and on every line of cross section and free of projections whereby, when pressure is applied to the tread face of the lift, a suction will be created between the lift and the heel to hold the attaching face of the lift through its entire extent in contact with the exposed face of the heel.

11. A cushion heel lift consisting of a single integral body having an attaching face concave throughout its area and on every line of cross section and free of projections whereby when pressure is applied to the tread face of the lift, a suction will be created between the lift and the heel to hold the attaching face of the lift through its entire extent in intimate contact with the opposed face of the heel, there being minute openings through the lift near the center thereof, whereby the walls of said openings will crowd around fastenings inserted therethrough and substantial trimming of the lift will be permitted.

[Matter enclosed between rules erased in copy.]

Remarks.

The British patent to Cairn, cited in the last Official letter, seems to be irrelevant. If this reference possesses any pertinency, that

fact is not obvious, and the Examiner is requested to explain fully [fol. 354] wherein any of the claims read upon this reference in the event of further rejection upon the same.

The patent to Ferguson is not an anticipation of applicant's construction for the reason that this patentee depended upon a spring plate, shown in Fig. 3 of the patent, to impart a concavo-convex form to the heel and cause the heel to retain such form. In line 74 of the specification of this patent, it is distinctly stated that this spring plate will increase the tendency of the heel to retain its concave form. In applicant's device, the concave form is lost when pressure is applied to flatten the lift against a shoe heel, and this flattening will produce a suction which will hold the lift in postion until permanent fastenings can be inserted and while the heel is being trimmed. With the Ferguson device, it is necessary to apply a clamp in order to to hold the lift against the heel in such position that the fastening devices may be inserted. The marginal rib on this patentee's device, moreover, will move the central portion of the lift away from the shoe heel so that, if in actual use, the bowed formation of the spring plate should be overcome the edges of the cushion lift will be spread out so as to separate from the shoe heel. Moreover, the spring plate tends to cut through the rubber lift and the presence of this spring plate and the formation of the marginal rib limits the extent to which the rubber lift may be trimmed down to fit a shoe heel. It will thus be seen upon a close study of the Ferguson patent, that the patentee's structure is intended to increase the bowing or bulging action of the rubber lift, so that the central portion of this patentee's device will spring away from the shoe heel, whereas, in applicant's device, the construction is such that, when pressure is applied to the cushion lift, it will lie flat against the shoe heel and will remain in that flat condition while being trimmed and until permanent fastenings are inserted. The two devices, therefore, are the opposites of each other rather than equivalents.

The Hale device is obviously impractical. It is true that the specification of the Hale patent states that as the composite heel is forced against the heel, the area of contact will increase, but it is also true that in line 13, page 2, the patentee says that the position [fol. 355] shown in Fig. 5 is approximately the shape the cushion will assume when it is placed against the shoe heel. Assuming, however, that the cushion heel will assume the shape shown in Fig. 5, it seems to be clear that, when pressure is applied thereto to flatten it against the shoe heel, the parts thereof will be torn apart. The patentee is very clear and specific in setting forth that the outer edge rubber portion of the heel and the inner central leather portion thereof are both originally flat and that the leather portion is somewhat larger than the opening in the rubber portion into which it is forced. The forcing of the leather into the rubber is said to give it the concavo-convex form shown in Fig. 5. When pressure is applied to the cushion heel so as to flatten the same after it has been put in the position shown in Fig. 5, the flattening of the central leather part will tear the outer rubber part of the heel away from the canvas backing and, consequently, dismember and destroy

the lift. If, to avoid this condition, fastenings are inserted through the rubber portion before the lift is flattened, the central leather portion will be bowed or bulged to such an extent as to spring away from the rubber and tear loose. If, on the other hand, fastenings are inserted through the leather only, as shown in Fig. 6, it would seem that the rubber would be forced out of place, as before stated. It is not seen that this patent can be held to be an anticipation of applicant's device.

As to the immateriality of the features relied upon by applicant as imparting patentable novelty to his device, it is noted that his heel has met with remarkable favor in the trade. Notwithstanding the fact that rubber heels have been known for a long time and have been on the market for several years and very extensively used, applicant's heel has been and is being sold in very large quantities and is being very generally adopted. Specimens of it may be seen in nearly every shoe repairing shop in this city, so that, if the Examiner has any doubt as to its efficiency, he may easily convince himself that applicant's heel is a substantial advance over everything that preceded it.

The claims have been revised and are now thought to define the [fol. 356] novelty in somewhat more exact terms than previously so that favorable consideration may be given the claims now presented.

Respectfully submitted, R. S. & A. B. Lacey, Attys. for John G. Tufford.

Div. A, Room 154

Patent Office,
Oct. 2, 1915,
Mailed.

Paper No. 5

FAW/L

Department of the Interior,
United States Patent Office,
Washington, October 2, 1915.

R. S. and A. B. Lacey, Washington, D. C.:

Please find below a communication from the Examiner in charge of the application of John G. Tufford, for Resilient Heels, filed Sept. 15, 1914, Serial No. 35,710.

Thomas Ewing, Commissioner of Patents.

In reply to amendment filed September 25, 1915:

On page 8, lines 5 to 9, inclusive, applicant describes the openings 8 and 9 as "terminating respectively at the convex and concave sides of the lift." With this construction it would obviously be impossible to obtain the results described in the last amendment of September 25, 1915. The openings 8 and 9 will prevent "suction."

Claims 5 to 11, inclusive, are rejected on Nerger, 661,129, Nov. 6, 1900, (36-35). Figs. 3 and 4 show a construction as specified. The heel lift of Nerger seems to possess all the advantages claimed by applicant for his lift.

H. C. Armstrong, Examiner, Div. 11.

F. A. W.

[fol. 357] 2

Application Room,
Oct. 13, 1915.
U. S. Patent Office.

U. S. Patent Office
Oct. 14, 1915.
Division XI.

Serial No. 35,710, Paper No. 6

In the United States Patent Office

Room No. 154

John G. Tufford. Resilient Heels. Filed June 22, 1915. Serial No. 35,710

Amendment C—Filed Oct. 13, 1915

A/H October 11, 1915. 7218-R.

Hon. Commissioner of Patents.

SIR: Responsive to the official action of October 2, 1915, the following amendment is made.

Cancel without prejudice the subject matter directed to be added on page 8 of the specification, by amendment dated September 24, 1915.

Cancel claims 5 to 11 inclusive and substitute:

Sub D[2]

C[1] "5. A heel lift of resilient material comprising a body portion of concave-convex form on every line of cross section and normally held in such form by its own inherent resiliency.

6. A heel lift of resilient material comprising a body portion, the attaching face of which is concave and the tread face of which is convex on every line of cross section and normally held in such form by its inherent resiliency only, said lift being provided with nail receiving openings located near the center thereof.

7. A heel lift of resilient material comprising a body portion, the attaching face of which is concave and the tread face of which is convex on every line of cross section and normally held in such form by its inherent resiliency only,

whereby to cause the entire margin of the lift to exert a uniform pressure on the heel of a shoe when said lift is positioned on the heel and the convex tread face thereof depressed to flatten said lift.

8. A heel lift of resilient material comprising a body portion, the attaching face of which is concave and the tread face of which is convex and normally held in such form by its inherent resiliency only, the concave face of the lift being free from projections, whereby when the convex tread face [fol. 358] is depressed to flatten said lift, a suction will be created between the lift and the heel to hold the attaching face of the lift through its entire extent in contact with the exposed face of the heel."

[Matter enclosed between rules erased in copy.]

Remarks

The Examiner appears to hold that Figs. 3 and 4 of patent to Nerger No. 661,129 shows applicant's heel lift and that the heel lift shown in the Nerger patent possesses all of the advantages claimed by applicant for his lift. By reference to the longitudinal section shown in Fig. 3 of the Nerger patent, it will be seen that said lift is not concavo-convex on every line of cross-section as the upper longitudinal edge thereof is represented by a straight line. Moreover, the deepest portion of the concavity in the upper surface of the Nerger heel terminates at the breast of the heel so as to leave an opening at said breast which would either entirely prevent suction or at least permit sufficient air to escape through the breast of the lift to prevent the suction from holding the lift on the heel with sufficient firmness to prevent its being immediately sprung outwardly by the action of the spring plate embedded in said heel. Again, it will be noted by reference to the specification of the Nerger patent that the plate B thereof is formed of spring metal and is curved to conform to the curvature of the upper and lower surfaces of said lift, the object of the spring metal plate or frame B being first to retain the heel in its concavo-convex form and second to provide a central reinforcement for the rubber.

With the construction shown in the heel lift of the Nerger patent, it is obvious that when pressure is applied to flatten said lift against the heel, said pressure will be exerted against the spring action of the plate B and inasmuch as the opening in the breast of the lift will permit the escape of air, it would be impossible to retain the lift on the heel temporarily by suction. Even were the breast of the heel closed, as in applicant's device, it is thought that the resiliency of the metal frame B of the Nerger patent would be such as to overcome the force of suction and immediately cause the lift to resume [fol. 359] its original concavo-convex form as soon as the flattening pressure is relieved from the tread face thereof. In fact, Nerger in his specification states that the metal plate is constantly under tension

and that the lift will have a constant tendency to regain its normal position. If this be conceded, it follows that after the Nerger lift has been secured to the heel by nails or similar fastening devices, the outward pressure of the spring metal frame B, in its effort to retain its normal concavo-convex form, will have a tendency to exert an outward pressure on the nails or fastening devices and as the heel is subjected to constant impact, incident to walking, this tendency of the plate or frame B to resume its normal concavo-convex shape will tend to withdraw the nails from the heel and thus permit accidental displacement or entire detachment of the lift from the heel after a short period of service. Furthermore, as the plate B is embedded in the rubber and extends to a point adjacent the margin thereof, it would be impossible to trim the marginal edge of the lift to fit heels of different sizes without exposing the metal plate and dulling the knife or other tool used in the trimming operation. The spring frame or plate B of the Nerger patent, as set forth in the specification thereof, is normally concavo-convex to conform to the curvature of the heel lift and necessarily when the heel is positioned on a shoe and pressure applied to the tread face therof to flatten said lift against the shoe, the metal plate will be extended longitudinally within the rubber and either compress said rubber and destroy the fibers thereof or actually cut the rubber so that after a short period of service the rubber, of which the lift is formed, will be materially impaired.

Applicant has overcome all of these objectionable features by providing a heel lift of concavo-convex formation on every line of cross section, thus producing a true concave pocket or depression on the attaching face of the lift, which latter, when depressed or flattened, will cause a suction suffcient to hold the lift on the heel temporarily or until the workman as an opportunity to permanently secure the lift to heel, either nails or other fastening devices being employed for this purpose. Applicant's lift is devoid of spring metal plates or other reinforcements, the lift being retained normally [fol. 360] in its concavo-convex form by the inherent resiliency of the lift only. In other words, the suction produced at the attaching face has only to overcome the natural tendency of the rubber to resume its normal shape and, as demonstrated at a recent personal interview with the Principal Examiner, the suction produced by applicant's heel lift is sufficient to overcome this tendency of the lift to resume its normal concavo-convex form and to retain the lift in the flattened form a sufficient length of time to enable the workman to securely fasten the lift on the heel of a shoe. By having applicant's lift devoid of metal plates and the like, not only is a greater suction produced but the margin of the heel may be trimmed to fit heels of different sizes, that is to say, a standard heel of say No. 11 may be cut down to fit a No. 3 or 4 heel, when desired, thus rendering it unnecessary for the shop keeper to keep various sizes of heels constantly in stock.

By reference to the longitudinal sectional view shown in Fig. 2 of applicant's drawing, in conjunction with the perspective view shown in Fig. 4, it will be seen that a true depression or concavity is formed in the attaching face of applicant's lift, which depression

or concavity extends from the forward edge of the breast of the heel to the rear portion thereof, thus not only producing an extended suction area, but also causing the marginal edge around the entire circumference of the lift to snugly engage the heel when the lift is flattened, thereby holding the lift on the heel without the employment of cement and also insuring a firm contact between the marginal edge of the lift and the heel which effectually prevents the entrance of dust, sand and the like between the lift and the heel. It is thought that applicant has done something more than to merely omit the spring plate of Nerger, together with its function as by omitting said spring plate applicant's heel performs additional functions, namely, First, to permit trimming of the heel to the desired size, Second, to positively insure a sufficient degree of suction between the lift and the heel to hold the lift tempoarily in position on the shoe, Third, to prevent the tendency of the lift to bow or bulge outwardly when in position on the heel and thus avoid withdrawal of the fastening devices, Fourth, to prevent compression [fol. 361] or cutting of the rubber when the lift is depressed and, Fifth, to simplify and reduce the cost of manufacture.

Applicant was aware of the structure shown in the Nerger patent, as will be seen by reference to page 3, lines 5 to 20 inclusive, of applicant's specification, in which the structure of the Nerger patent is set forth and the objections or difficulties presented in the actual use of said heel fully set forth and it was with a view to overcoming these objections or difficulties that the present heel was devised. It is thought that this case falls fairly within the decision of the Circuit Court of Appeals—Second Circuit in the case of Meihle Printing Press & Mfg. Co. v. Whitlock Printing Press & Mfg. Co., reported in 223 Fed. Rep. in which Justice Lacombe, in handing down the opinion of the Court, stated:

"Patentable novelty is sometimes found in discovering what is the difficulty with an existing structure and what change in its elements will correct the difficulty, even though the means for introducing that element into the combination are old and their adaptation to the new purpose involves no patentable novelty."

As applicant recognized the objections or difficulties in the actual operation or use of the Nerger heel and by a careful study devised a heel lift which will overcome these difficulties, it is thought that he has made a clear step forward in the art and is entitled to protection on his structure.

The foregoing amendment has been made after a personal interview with the Principal Examiner, during which a specimen heel lift, constructed in accordance with applicant's invention and also exhibit rubber heels now on the market, were presented for inspection. If after reading the foregoing remarks, the Examiner desires a demonstration of the Nerger heel, an effort will be made to obtain one of said heels. It is thought, however, that upon a careful consideration, the Examiner will concede the allowance of the new claims herewith presented, especially in view of the fact that these

new claims set forth with clearness the differentiating features of ap-
[fol. 362] plicant's structure over the structures shown in the prior art.

Respectfully submitted, R. S. & A. B. Lacey, Attys. for Tufford.

Paper No. 7

Div. XI, Room 154

Patent Office,
Oct. 22, 1915,
Mailed.

ELT/HCA.

Department of the Interior,
United States Patent Office,
Washington, Oct. 22, 1914.

R. S. & A. B. Lacey, Washington, D. C.:

Please find below a communication from the Examiner in charge of the application of John G. Tufford, Serial No. 35,710, filed June 22, 1915, Resilient Heels.

Thomas Ewing, Commissioner of Patents.

Replying to amendment filed Oct. 13, 1915:

Claims 5 to 11 inclusive are rejected on Nerger, of record. The rubber heel lift of Nerger has an upper surface concave on any line of cross section and a tread surface concentric thereto. His object is to make the edges of the lift closely hug the margin of the heel proper by flattening the spherical arch at the center of the lift and securing such center to the heel by nails. The resilient concavo-convex lift obviously tends to cause this close adherence when flattened against the heel, but Nerger wished to increase this tendency and embedded in the lift a resilient metal plate B, which he says he preferably provides with arms b, thus inferring that they may not be provided if desired, to add its effect to that produced by the lift itself. Through the center of this plate pass the nails which flatten and secure the lift to the heel. When in place this lift is believed to have any suction effect which may accompany the use of applicant's lift, and that the plate so secured will cut or injure the rubber lift or work loose to a subtsantially greater degree than the washers employed by applicant does not appear to be a reasonable supposition.

[fol. 363] Applicant has omitted from the rubber lift the resilient plate with its function of increasing the tendency of the margins of the lift and heel to remain in contact, relying solely upon the resilience of the lift itself to maintain such contact. So far as the temporary adhesion and suction produced by forcing the lift into contact with the heel preparatory to the securing step is concerned, no such effect was disclosed in either the original or present specifications, nor does it appear operative since the presence of the holes 8 and 9 passing from one face to the other would prevent the formation of any vacuum until closed by the nails, as described. The lift of Nerger may be trimmed to fit several sizes of heels and patent-

ability cannot be conferred upon claims otherwise not patentable by the fact that applicant has so proportioned the parts that more margin may be trimmed from the lift without exposing the reinforcements through which the nails pass.

Applicant may regard this rejection as final if he so desires.

H. C. Armstrong, Examiner.

Application Room,
Oct. 27, 1915,
U. S. Patent Office.

U. S. Patent Office, Oct. 28, 1915,

Division XI.

Serial No. 35710, Paper No. 8

In the United States Patent Office

Room No. 154

John G. Tufford. Resilient Heels. Filed June 22, 1915. Serial No. 35,710

Amendment D—Filed Oct. 27, 1915

A/H. October 26, 1915. 7218-R.

Hon. Commissioner of Patents.

SIR: Responsive to the official action of October 22, 1915, the following amendment is made:

Page [7]* 8 of the specification, line 17, after "impaired." insert—

Sub E[1]

D[1] "The openings 8 and 9 merely form guides for the nails 5 and are so small that they will not permit any appreciable escape of air from the suction area of the lift when the convex face thereof is flattened to temporarily hold said lift in position on a heel prior to permanently securing the lift with [fol. 364] the nails. By reference to Figs. 2 and 4 of the drawings, it will be seen that the concave upper face of the lift lies entirely below a plane tangent to the rear upper edge and the breast corners of the lift, whereby to cause the entire margin of said lift to exert a uniform pressure on the heel of a shoe when the lift is positioned on the heel and the convex face thereof depressed to flatten said lift."

[Matter enclosed between rules erased in copy.]

[*Words and figures enclosed in brackets erased in copy.]

Cancel claims 5 to 8 inclusive and substitute:

D². "5. A heel lift of substantially non-metallic resilient material having its body portion of concavo-convex form on every line of cross section, the concave upper face lying entirely below a plane ∧ [tangent to]* the rear upper edge and the breast corners of the lift.

Per E. passing through

6. A heel lift of substantially resilient material having its body portion of concavo-convex form on every line of cross section, the concave upper face lying entirely below a plane ∧ [tangent to]* the rear upper edge and the breast corners of the lift, said lift being provided with nail receiving openings located near the center thereof.

Per E. passing through

7. A heel lift of substantially resilient material comprising a body portion, the attaching face of which is concave and the tread face of which is convex on every line of cross section and normally held in such form by its own inherent resiliency, the concave attaching face lying entirely below a plane ∧ [tangent to]* the rear upper edge and the breast corners of the lift, whereby to cause the entire margin of said lift to exert a uniform pressure on the heel of a shoe when said lift is positioned on the heel and the convex tread face thereof depressed to flatten said lift.

Per E. passing through

8. A heel lift of resilient material comprising a body portion of uniform thickness throughout its entire area and of concavo-convex form on every line of cross section, the concave upper face of the lift lying entirely below a plane ∧ [tangent to]* the upper edge and the breast corners of said lift.

Per E. passing through

[fol. 365] 9. A heel lift of resilient material comprising a body portion, the attaching face of which is concave and the tread face of which is convex, the concave face of the lift being unbroken and lying entirely below a plane ∧ [tangent to]* the rear upper edge and the breast corners of the lift, whereby when the convex tread face is depressed to flatten said lift a suction will be created between the lift and the heel to hold the attaching face of the lift throughout its entire extent in contact with the exposed face of the heel."

Per E. passing through

Insert E².

[*Words and figures enclosed in brackets erased in copy.]

Remarks

By reference to Figs. 2 and 4 of applicant's drawings, it will be noted that the upper concave attaching face of the lift lies entirely below a plane tangent to the rear upper edge and the breast corners of the lift, whereby to cause the entire margin of said lift to exert a uniform pressure on the heel of a shoe when said lift is positioned on the heel and the convex face thereof depressed to flatten said lift. In other words, applicant's lift is of concavo-convex form on every line of cross section and normally held in such form by its inherent resiliency only in contradistinction to a heel lift having a reinforcing plate permanently embedded therein to impart the desired shape to the lift. As clearly set forth in the specification, the openings 8 and 9 are extremely small and merely form guides for the nails 5, these openings in fact being so small that they will not permit any appreciable escape of air from the suction area of the lift when the concave face thereof is flattened to temporarily hold said lift in position on a heel prior to permanently securing the lift to the heel with the nails or other fastening devices.

The heel lift shown in patent to Nerger, No. 661,129, cannot be said to be concavo-convex on every line of cross section as, by reference to Fig. 3 of the Nerger patent, it will be seen that the longitudinal edge of said lift is represented by a straight line, while the deepest portion of the concavity in the upper surface of the Nerger heel terminates at the breast of the heel so as to leave an opening at said breast which would either entirely prevent suction or at least permit sufficient air to escape through the breast of the lift to prevent the suction from holding the lift on the heel with sufficient [fol. 366] firmness to prevent its being immediately sprung outwardly by the action of the spring plate embedded in said heel. Neither does the Nerger patent show a lift, the concave upper face of which lies entirely below a plane tangent to the rear edge of the breast corners of the lift so that when the convex tread surface of the lift is depressed to flatten the same, a uniform pressure will be exerted around the entire margin of the lift on the heel of the shoe.

With the construction shown in the Nerger patent, it is impossible to temporarily hold the lift in position on a shoe by suction prior to permanently securing the lift to the shoe by nails or other fastening devices, as in applicant device, owing to the spring plate B embedded therein and owing to the fact that the upper concave face does not lie entirely below a plane tangent to the rear upper edge and the breast corners of the lift. This was conclusively demonstrated during a recent oral interview with the Principal Examiner, at which time sample lifts, constructed in accordance with the Nerger patent and obtained from the patentee himself, were presented for inspection, some of said samples showing new lifts ready for attachment to a shoe, and others showing the lifts after different periods of service. At said interview, a set of molds used by Nerger in making his lift, were also presented for inspection to further show how applicant's lift differs in both construction and operation from the Nerger lift.

The claims have been carefully redrawn along the lines suggested by the principal Examiner at said interview and are thought to be allowable.

In reconsidering this application, the Examiner is respectfully requested to carefully review the remarks accompanying papers dated September 24, 1915 and October 11, 1915, in which the differences in applicant's device over the citations of record are pointed out and the advantages derived from such differences in construction fully set forth.

An early and favorable action is respectfully requested.

Respectfully submitted, R. S. & A. B. Lacey, Attys. for Tufford.

[fol. 367] Patent Office,
Nov. 16, 1915,
Mailed.

Paper No. 9

Div. XI, Room 154

ELT/FAW.

Department of the Interior,
United States Patent Office,
Washington, Nov. 16, 1915.

R. S. & A. B. Lacey, Washington, D. C.:

Please find below a communication from the Examiner in charge of the application of John G. Tufford, Serial No. 35,710, filed June 22, 1915, Resilient Heels.

Thomas Ewing, Commissioner of Patents.

Replying to amendment filed Oct. 27, 1915:

In the original application, Serial No. 780,290, filed July 21, 1913, and in the amendment filed April 21, 1914, applicant amends claims 4 and 5 by adding to these claims the phrase "the edges of the attaching face all occupying the same plane." In the amendment of June 5, 1914, see page 2, last paragraph, applicant says, "in other words, an attaching face having all of its edges occupying the same plane." In the amendment of Oct. 13, 1915, in the present application, (see page 3, lines 18 and 19), applicant says: "Even were the breast of the heel closed, as in applicant's device, etc." To judge from the above statements, applicant's heel lift was meant to be so constructed as to have all of its upper edges occupy the same plane and such construction is also indicated in Fig. 2 of the drawing. In applicant's last amendment, Oct. 27, 1915, page 1, line 11 et seq., he says: "By reference to Figs. 2 and 4 of the drawings, it will be seen that the concave upper face of the lift lies entirely below a plane tangent to the rear upper edge and the breast corners of the lift." Fig. 2 does not show such construction since a point midway between the breast corners of the lift is

shown to be in contact with the upper heel portion. According to this figure, a plane tangent to the rear edge and the breast corners would also pass through the entire front edge of the lift. The sample lift shown to the examiner in the interview referred to does [fol. 368] not correspond to the drawing, since all the points of its breast except the two corner points lie below a straight line passing through these points.

In each of the claims 5, 6, 7, 8 and 9 applicant specifies "that the concave upper face lies entirely below a plane tangent to the rear upper edge and the breast corners of the lift." These claims do not read on the drawing, and are therefore rejected.

F. A. W. H. C. Armstrong, Examiner.

Nov. 26, 1915. Division XI

U. S. Patent Office

new drawing
a/ 258

Application Room,
U. S. Patent Office,
Nov. 24, 1915

Serial No. 35,710

Paper No. 10

1

In the United States Patent Office

Room Number 154

John G. Tufford. Resilient Heels. Filed June 22, 1915. Serial No. 35710

Amendment E and Sketch—Filed Nov. 24, 1915

A-ML. Nov. 24, 1915. 7218-R

Hon. Commissioner of Patents.

SIR: In response to Official action of Nov. 16, 1915, please amend as follows:

Cancel the amendment to page 7 of the specification line 17, directed to be entered by amendment dated Oct. 26, 1915, and substitute:

E[1]. "The openings 8 and 9 merely form guides for the nails 5 and are so small that they will not permit any appreciable escape of air from the suction area of the lift when the convex face thereof is flattened to temporarily hold said lift in position on a heel prior to permanently securing the lift with the nails. By references to Figures 2 and 4 of the drawings, it will be seen that the concave upper face of the lift lies en-

tirely below a plane passing through the rear upper edge and breast corners of the lift whereby to cause the entire margin of said lift to exert a uniform pressure on the heel of a shoe when the lift is positioned on the heel and the convex face thereof depressed to flatten said lift. In other words, owing to the curvature of the concave attaching face of the lift, [fol. 369] the rear upper edge and breast corners of said concave attaching face are disposed in a plane above the upper side edges and the breast edges of the lift."

Claim 5, line 4, strike out "tangent to" and insert passing through
Claim 6, line 4, strike out "tangent to" and insert passing through
Claim 7, line 6, strike out "tangent to" and insert passing through
Claim 8, line 5, strike out "tangent to" and insert passing through
Claim 9, line 4, strike out "tangent to" and insert passing through

Add the following claim:

E². "10. A heel lift of substantially resilient material comprising a body portion, the attaching face of which is concave and the tread face convex on every line of cross section, the rear upper edge and breast corners of the concave attaching face of the lift being disposed in a plane above the upper side and breast edges of said concave attaching face.

Remarks

The matter quoted by the Examiner from the file of the original application merely shows (if it shows anything) that error crept into the prosecution of the original application. This reissue application seeks to correct the error now emphasized by the Examiner and should therefore be allowed. The quoted matter is inconsistent with the drawings in which Figure 2 shows an open space between the leather heel and the curved line representing the far back portion of the edge of the cushion lift. If the edges were all in the same plane, this open space would not appear. Moreover, the specification of the original application clearly sets forth that applicant's lift is of concavo-convex form on every line of cross-section and that its marginal surface is at all points radial to the center of curvature of its concave side. This statement in the original application shows that the concave attaching face of applicant's lift [fol. 370] is in the form of a true curve and as Figure 4 of the drawings shows that the breast of the lift is cut away on a curved line, the attaching face of the lift at the breast thereof must necessarily lie in a plane below the breast corners and rear edge of said lift or in other words, the rear upper edge and breast corners of the concave attaching face are disposed in a plane above the upper side and breast edges thereof.

The showing in Figure 2 is therefore obviously in error. The Examiner's quotation with reference to the amendment to the present case dated Oct. 13, 1915, has been carefuly considered and it is not seen how the Examiner can interpret the "Remarks" in said amendment to mean that the breast of applicant's heel is entirely closed,

inasmuch as this amendment was prepared after an oral interview with the Principal Examiner during which a specimen heel constructed in accordance with the present application was submitted for inspection. In fact, attorneys for applicant had the specimen heel before them and also the Nerger heel when preparing said amendment and as explained to the Examiner in person, it was attorneys' intention to emphasize the fact that applicant's heel had a true depression or concavity in the upper face thereof which slopes from the center of the concave attaching face towards the rear edge of the heel and breast of the heel which would cause the breast of applicant's heel to partially close said depression, as contradistinguished to the flat face at the breast of the Nerger heel. In the "Remarks" accompanying said amendment, the follow- statement is made which clearly shows that attorneys did not intend to convey the impression that the breast of applicant's heel was entirely closed. "Moreover, the deepest portion of the concavity in the upper face of the Nerger heel terminates at the breast of the heel so as to leave an opening at said breast * * *" "By reference to the longitudinal sectional view shown in Figure 2 of applicant's construction in conjunction with the perspective view shown in Figure 4, it will be seen that a true depression or concavity is formed in the attaching face of applicant's lift which depression or concavity extends from the forward edge of the breast of the heel to the rear por- [fol. 371] tion thereof." Furthermore, the latter part of the "Remarks" accompanying said amendment refers to an interview with the Principal Examiner and also to the specimen heel lift exhibited at said interview.

In order that the record may be clear, it is desired to state that by the expression "Even were the breast of the heel closed as in applicant's device," used in the "Remarks" accompanying the amendment dated Oct. 13, 1915, attorneys meant and endeavored to bring to the attention of the Examiner that, owing to the true concavity or depression in the upper face of applicant's lift, the breast of said lift was more closed than the breast of the Nerger lift.

The Examiner's quotation from the last amendment, that is amendment dated Oct. 27, 1915, with his comment thereon also demonstrates that error exists in the original patent. As the Examiner takes no exception to the mention of Figure 4, the correctness of applicant's reference to this Figure must be taken as admitted and the Examiner's criticism of Figure 2 merely calls attention to an error in that Figure. As it is quite clear that Figure 2 does not show a correct sectional view of Figure 4, permission is requested to change Figure 2 in accordance with the sketch filed herewith. Permission is also requested to change Figures 2 and 3 of the drawings in accordance with the sketch, that is to say, to show the breast of the heel of the shoe slightly curved to agree with Figures 1 and 4. The construction of the heel of the shoe forms no part of applicant's invention as the resilient lift may be applied to heels of different shapes but it is desired to make this change in order that several Figures of the drawing may agree.

New claim 10 clearly sets forth that the rear upper edge and breast corners of the attaching face of the lift are disposed in a plane above

the upper side edges of said attaching face and is clearly readable on Figure 2 of the drawing even without any correction made thereto, but, as before stated, Figure 2 in its present form does not clearly illus- [fols. 372] trate applicant's invention and for this reason, permission to correct the drawing in accordance with the sketch filed herewith is requested. New claim 10 as well as claims 5 to 9 inclusive are thought to be allowable and favorable action is respectfully requested.

Respectfully submitted. R. S. & A. B. Lacey, Attys. for Tufford.

(Here follows diagram marked side folio pages 373 and 374)

[fols. 375 & 376] Serial No. 35,710, Paper No. 11

Account.

In the United States Patent Office

Room 154

John G. Tufford. Resilient Heels. Filed June 22, 1915. Serial No. 35,710

Letter and Print—Filed Nov. 24, 1915

Account.

A/MOD. Nov. 24, 1915. 7218-R.

Hon. Commissioner of Patents.

SIR: In the above entitled application the Chief Draftsman is respectfully requested to correct Figures 2 and 3 of the drawings in accordance with the corrections indicated upon the sketch accompanying the amendment dated Nov. 24, 1915, charging the service to our account.

A photographic print is filed herewith. As this is a reissue application it is respectfully requested that the correction of the drawing be made special.

Respectfully submitted, R. S. & A. B. Lacey, Attys. for Tufford.

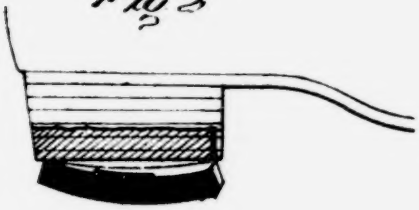
O. K. F. A. W. Div. 11.

[Endorsed:] Lacey, R. S. A. B. C. U. S. Patent Office. Number 191,807. Received Nov. 24, 1915. Chief Clerk. Received in Div. C. Nov. 24, 1915. Correction Ordered Dec. 1, 1915. Corrected Dec. 1, 1915. Account 1.[00]. Book 262, Page 114. Div. C for Div. 11.

(Here follows diagram marked side folio pages 377 and 378)

373-374

Fig 2



John G Tufford
Resilient Heel
Filed June 22 1915
Serial No 35710
Room 154

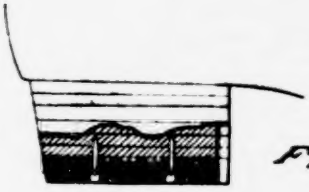


Fig 3.

J G Tufford

377=378

35,710

Fig. 1.

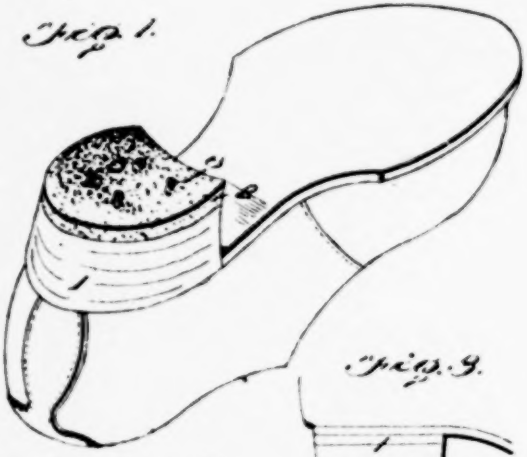


Fig. 2.

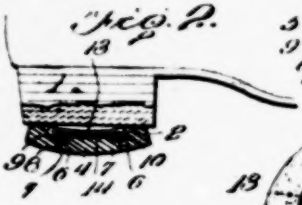


Fig. 3.

Fig. 4.

Fig. 5.

Fig. 11.

Witness

Inventor

M. Tiffford.

By

Attorney

[fol. 379] Serial No. 35,710

Patent will issue Dec. 28, 1915.

Department of the Interior,
United States Patent Office,
Washington, December 1, 1915.

John G. Tufford, Assor.

SIR: Your application for Reissue of Patent No. 1,110,730 for improvement in Resilient Heels, has been examined and allowed.

The patent will be forwarded to you as soon as practicable, in due order of business.

Very respectfully, Thomas Ewing, Commissioner of Patents.

R. S. & A. B. Lacey, Washington, D. C.

Abstract Continued from June 15, 1915.

No further Assignments Found of record affecting this application: Serial No. 35,710. Inventor, J. G. Tufford.

Examined up to and including Nov. 20, 1915.

This certificate dated Dec. 2, 1915.

Willis B. Magruder, Chief of Div. D.

Remarks

No further Assignments appear to have been received for record including Nov. 22, 1915.

For Issue Division. For Issue Division.

No. 12

UNITED STATES CIRCUIT COURT OF APPEALS FOR THE FIRST CIRCUIT

Honorable Commissioner of Patents, Washington, D. C.

SIR: In compliance with the Act of February 18, 1922 (41 Stat. L., —), you are advised that there was filed on the 14th day of March, 1921, in this court an action, suit, or proceeding No. 1505, entitled: The I. T. S. Rubber Company, Plaintiff, Appellant (Address, Elyria, Ohio) versus (Name:) Essex Rubber Company, De-
[fol. 380] fendant, Appellee (Address: New Jersey Corp. having place of business in Boston, Mass.), brought upon the following patents: Patent No. 14049; Date of Patent: January 11, 1916; Patentee: John G. Tufford.

In the above-entitled case the following decision has been rendered or decree issued:

The decree of the District Court is reversed and the case is remanded to that court for further proceedings not inconsistent with the opinion passed down this day, with costs to the appellant.

In witness whereof I have affixed my hand this tenth day of June, 1922, at Boston, Mass.

Arthur I. Charron, Clerk of said Court.

No. 13

UNITED STATES DISTRICT COURT, NORTHERN DISTRICT OF ILLINOIS, EASTERN DIVISION

Honorable Commissioner of Patents, Washington, D. C.

SIR: In compliance with the Act of February 18, 1922 (41 Stat. L., —), you are advised that there was filed on the 16th day of February, 1921, in this court an action, suit, or proceeding, No. 1993, entitled: (Name:) The I. T. S. Rubber Company, Plaintiff (Address: ——), versus (Name:) United States Rubber Company, Defendant (Address: ——), brought upon the following patents: Patent No. 14049, Reissue; Date of Patent: Jan. 11, 1916; Patentee: John G. Tufford.

In the above-entitled case the following decision has been rendered or decree issued: February 28, 1922, perpetual injunction against Defendant (interlocutory decree), particularly as to claims 5 to 9, inclusive, of reissue No. 14049.

[fol. 381] In witness whereof I have affixed my hand this 1st day of June, 1922, at Chicago, Illinois.

John H. R. Jamar, Clerk of said Court.

[MEMO.—Bound in here in original file-wrapper is Letters Patent No. 14,049, granted to J. G. Tufford, reissued January 11, 1916, but is not here reproduced as it appears in this record as "Plaintiff's Exhibit 12", pages 221 to 226.]

Classification: 1915, Class 36.

Contents

Print, —.
Application papers O. K.
1. Rejection and Affidavits, Jul. 8, 1915.
2. Amendment A, Aug. 20, 1915.
3. Rejection, Aug. 30, 1915.
4. Amendment B, Sept. 25, 1915.
5. Rejection, Oct. 2, 1915.
6. Amendment C, Oct. 13, 1915.
7. Rejection, Oct. 22, 1915.
8. Amendment D, Oct. 27, 1915.
9. Rejection and Sketch, Nov. 16, 1915.
10. Amendment E, Nov. 24, 1915.
11. Letter and Print, Nov. 24, 1915.
12. Notice of Suit, June 12, 1922.
13. " " " " 29, "
Title: Improvement in Resilient Heels.
(Cls. 10.) (36–35.)

Defendant's Exhibit D

Department of the Interior.
United States Patent Office.

To all persons to whom these presents shall come, Greeting:

This is to certify that the annexed is a true copy from the records of this office of the File Wrapper and Contents, in the matter of the Letters Patent of John G. Tufford, Assignor of One-sixth to Carl H. [fol. 382] Ingwer, One-sixth to Arthur G. Smith and One-sixth to William C. Smith, Number 1,110,730, Granted September 15, 1914, for Improvement in Resilient Heels.

In Testimony Whereof I have hereunto set my hand and caused the seal of the Patent Office to be affixed, in the District of Columbia, this 3rd day of October, in the year of our Lord one thousand nine hundred and twenty-two and of the Independence of the United States of America the one hundred and forty-seventh.

Wm. A. Kinnan, Acting Commissioner of Patents. (Seal.)

Div. 11.
Number (Series of 1900), 780,290 — 1913 Patent No. 1110730 — Div. 11. (Ex'r's Book) 57/219.

H. Ingwer

Name: John G. Tufford, Assor. of 1/6 to Carl Ingever and 1/6 to Arthur J. G. Smith, both of Elyria, Ohio, and 1/12 to William C. Smith, all of Elyria, Ohio,
Of Elyria,
County of ——,
State of Ohio.
Invention: Resilient Heels.
Reissued Jan. 11, 16, No. 14049.
Division of App. No. —, filed —— —, ——.

Parts of application filed.	Original	Renewed
Petition,	July 21, 1913.	—— —, 191–.
Affidavit,	" " 1913.	—— —, 191–.
Specification,	" " 1913.	—— —, 191–.
Drawing, 1 sheet,	" " 1913.	—— —, 191–.
Photo Copy,	—— —, 191–.	—— —, 191–.
First Fee, Cash, $15.	July 21, 1913.	—— —, 191–.
" " Cert.,	—— —, 191–.	—— —, 191–.
Appl. filed complete July 21, 1913.		—— —, 191–.
Examined and Passed for Issue July 15, 1914.		—— —, 191–.
H. C. Armstrong, Exr., Div. 11.		Exr. Div. —.
Notice of Allowance: July 20, 1914.		—— —, 191–.
By Commissioner.		
[fol. 383] Final Fee, Cash, $20, Aug. 18, 1914.		—— —, 191–.
Final Fee, Cert., —— —, 191–.		—— —, 191–.
Patented September 15, 1914.		—— —, 1941.

Attorney: R. S. and A. B. Lacey, City.
Associate Attorney: —— ——
(No. of Claims Allowed: 4). Title as Allowed: Resilient Heels.
(Cl. 36–35.)

U. S. Patent Office.
Jul. 23, 1913.
Division XI.

7003. Serial No. 780,290. Paper No. 1

Application—Filed July 21, 1913

$15 Received. Jul. 21, 1913. D. Chief Clerk, U. S. Patent Office

Petition

5516-Y. MBW.

To the Commissioner of Patents:

Your petitioner (1) John G. Tufford, citizen of the United States residing at Elyria, in the County of Lorain, and State of Ohio, P. O. Address 1217 East Avenue, Elyria, Lorain County, Ohio, prays that Letters Patent may be granted to him for improvements in Resilient Heels, set forth in the annexed Specification.

And he hereby appoints the firm of R. S. & A. B. Lacey, of Washington, D. C., Robert S. Lacey, Anderson B. Lacey, Samuel N. Acker and Frederic B. Wright, constituting said firm (Registration No. 496), his attorneys with full power of substitution and revocation, to prosecute this application, to make alterations and amendments therein, to sign the drawings, to receive the Letters Patent, and to transact all business in the United States Patent Office connected therewith.

Signed at Washington, in the County of and State of D. C. this 16th day of July 1913.

John G. Tufford. (Seal.)

Specification

To all whom it may concern:

Be it known that I, John G. Tufford, citizen of the United States residing at Elyria, in the County of Lorain, and State of Ohio, have invented certain new and useful improvements in Resilient Heels, of [fol. 384] which the following is a specification:

This invention relates to shoe heels and more particularly to an improvement in cushion heels of that type comprising an elastic lift adapted to be applied to the ordinary heel.

The ordinary form of elastic lift now in common use is flat upon both its upper and under faces so that its flat upper face will bear flat against the flat under face of the lowermost leather lift of the heel to which the cushion heel is applied. As a consequence, after the elastic or cushion lift has been applied and the shoe has been worn for a short time, the pressure to which the cushion lift is subjected will result in its edge portions being projected or spread to a greater or less degree beyond the sides of the shoe heel proper, presenting an unsightly appearance and providing a crack or space

into which dirt may enter, rendering the heel uneven and weakening its connection with the shoe heel proper. I am aware that it has been proposed to employ a cushion lift having a concave upper face to be applied to the under face of the shoe heel proper but I do not believe that up to the present time any practical and satisfactory means has been discovered and employed for attaching such a lift so that its connection with the shoe heel will be to any extent permanent. The method usually employed in securing such cushion lifts in place is to embed in the lift a plate conforming in contour to the concavity of the lift and then secure the lift in place by driving nails or screws through the plate and into the heel of the shoe, and where this method is not followed circular washers are embedded in the lift and have nails or other securing elements driven through them and into the shoe heel. In the first instance the pressure

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imposed upon the heel will tend to flatten out the plate thereby causing its edges to cut through the lift besides weakening or loosening the securing elements, and, in the second instance, so far as I am aware, the washers have been circular and are arranged so as to be exposed at the tread surface of the lift after the shoe has been worn for a short time. It is therefore one aim of the present in- [fol. 385] vention to provide a cushion lift so constructed that when applied to a shoe heel its edge portions will not be forced to project beyond the sides of the heel when pressure is applied and to so arrange the attaching means for the lift that the lift may wear to a maximum extent without exposing such fastening means.

Another aim of the invention is to so arrange the attaching devices that they will be located relatively remote from the edge of the heel lift, whereby the lift may wear to a maximum extent without exposing the same, and incidentally the invention contemplates so constructing the washers which constitute an element of the securing means as to further prolong the life of the lift.

The invention has as another object to so form the concave upper side of the cushion lift that when the lift is subjected to pressure any tendency for the edge portions of the lift to crowd beyond the sides of the shoe heel will be counteracted and there will be equally as great a tendency for the material of the lift to crowd or compress toward the center thereof.

The result last mentioned is accomplished in part by forming the concave side of the lift with a number of separate and distinct concave areas which in fact constitute a plurality of suction cups cooperating with the under side of the shoe heel when pressure is

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applied and inasmuch as these concave areas are separated from each other the expansion or spreading of the portion of the lift of which they constitute the surfaces, will be accommodated so as to secure the result aimed at.

The invention aims further to construct the lift and the attaching means therefor in such a manner as not to destroy or impair the

suction action resulting from the use of a lift having a concave upper surface.

Canceled—A

Still further, the invention contemplates so forming the upper or attaching side of the lift that when it is desired to employ cement [fol. 386] in assisting in securing the lift in place, pockets will be formed to receive the cement prior to the application of the lift to the shoe heel, thereby insuring the application of a sufficient quantity of cement to the surfaces to be united without, however, rendering it likely that the cement will ooze at the edges of the lift and shoe heel.

[Matter enclosed between rules erased in copy.]

In the accompanying drawings:

Fig. 1 is a perspective view of the lift embodying the present invention applied to a shoe heel.

Fig. 2 is a front to rear sectional view through the lift in position disposed against the under side of a shoe heel and immediately prior to application thereto.

Fig. 3 is a similar view through the heel illustrating the same applied.

Fig. 4 is a perspective view looking at the upper side of the lift removed.

Fig. 5 is a perspective view of one of the washers comprising an element of the attaching means for the lift.

4

In the drawings the numeral 1 indicates the heel of a shoe and 2 the cushion lift embodying the present invention. The lift 2 is, as usual, formed from rubber, and is molded or cut so as to be of concavo convex form on any line of cross section. In marginal outline the lift is of substantially the same outline as the side of the shoe heel 1 and is, of course, to be finished to the same dimensions as the usual shoe heel, either before or after its application thereto. The concave upper side of the lift 2 is indicated by the numeral 3 and the convex under side by the numeral 4. It is preferable that the lift be of the same thickness throughout and that its marginal surface be at all points radial to the center of curvature of its concave side 3 so that when the lift is applied to the shoe heel and subjected to pressure its said marginal surface will be coincident with the side of the shoe heel.

As a means for securing the lift in place upon the under side of the shoe heel, small nails or other suitable securing elements 5 [fol. 387] are employed and are driven through washers 6, which are embedded into the lift, and into the shoe heel. These washers 6 are of the form shown in Fig. 6 of the drawings and each is of segmental form, the chordal edge of each washer being so positioned

that the arcuate edge thereof will describe approximately three-fourths of a circle. Each washer is provided with an opening 7 to accommodate the nails or other securing elements 5, and the said opening in each washer is located concentric to the arcuate edge thereof. By reference to Figs. 1 and 4 of the drawings it will be observed that the washers are so embedded and arranged within the body of the lift that their chordal edges will be presented toward the adjacent portion of the edge of the said body, so that broadly speak-

5

ing, that edge portion of each washer which is nearest the edge of the body of the lift will be spaced from said edge a greater distance than if the washers were of practically circular form. At this point it may be remarked that by so forming the washers and by arranging them in the manner stated and shown, a maximum wear of the edge portions of the lift is provided for before the washers can be exposed. It will further be observed by reference to the figures of the drawings that the washers are spaced substantially equi-distant from the margin of the lift and that they are located as near the center of the lift as is practical considering a peculiar construction of the lift which will presently be described. The body of the lift 2 is formed in alignment with the opening 7 in each of the washers 6 with openings 8 and 9 which are extremely small in diameter and terminate respectively at the convex and concave sides of the lift. In fact, these openings are so minute that when the nails 5 are driven through the lift, the walls of the openings will be crowded and consequently will snugly embrace and fit the surface of the nails. It has before been stated that a suction force is exerted due to the concave upper side of the lift, and it will now be apparent that due to the snug fit of the nails in the openings 8 and 9 the partial vacuum established when pressure is exerted upon the heel will not be destroyed or impaired.

[fol. 388] As before pointed out, the concave side of the lift is provided with a number of concave or suction areas and in forming these areas channels 10 and 11 are molded or cut in the concave face of the lift and preferably extend respectively concentric to the forward and curved edges of the lift as clearly shown in Fig. 4 of the drawings. These channels are relatively narrow and relatively shallow and in addition thereto there are channels 12 and 13 which

6

extend respectively from front to rear and transversely of the concave surface of the lift. In this manner the central portion of said surface is divided into four suction or concave areas in addition to the main area which may be considered as surrounding the group of first mentioned areas which in the drawings are indicated at 14, and it will be apparent that if desired the channels may have different lines of extent than here shown, whereby to increase or decrease the number of suction areas 14 or to vary the arrangement thereof.

It will now be seen that when the lift is subjected to pressure each of the several suction areas 14 will be flattened and a partial vacuum

created at each point of their location as well as throughout the entire surface of the upper side of the lift. The formation of the group of suction areas, however, presents this advantage, namely, that the channels resulting in their formation accommodate the marginal portions of the material of the lift of which the areas constitute the surfaces when these portions are spread due to the pressure exerted and therefore the lift is not compressed or spread bodily from its central portion toward its margin but the expansion due to compression is equalized throughout the body of the lift.

Canceled per A

When it is desired to employ cement a suitable quantity is poured into the concavity of the lift and the lift is then applied to the under side of the heel and there held by pressure until the cement has set or hardened, if the cement is to be employed alone, or the nails 5 are driven into place if the cement is to serve as an auxiliary securing [fol. 389] means. It will be understood that the cement will flow into the grooves in the lift and also settle in the concavities of the several suction areas so that if the necessary quantity is deposited in the

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[Matter enclosed between rules erased in copy.]

7

central portion of the lift when pressure is applied to the under side of the lift the flattening out of the concave surface will serve to distribute the cement over practically the entire area of the surface without, however, causing the same to ooze from between the surfaces of the lift and heel at the edges thereof.

8

Having described the invention, what I claim is:

1

A cushion heel lift having washers embedded therein near its center portion and each of segmental form, the washers being arranged with their chordal edges presented toward the edge of the lift.

Canceled per B

2

A cushion heel lift having washers embedded therein near its center portion and each of segmental form, the washers being arranged with their chordal edges presented toward the edge of the lift, the lift and the washers being formed with alined openings, the up-

per side of the lift being concave and the openings in the lift being of smaller diameter than the openings in the washers whereby a securing element of substantially the same diameter as the opening in the washer will be snugly embraced by the wall of the corresponding opening in the lift.

[Matter enclosed between rules erased in copy.]

Cancelled per A

3

A cushion heel lift having its attaching face divided into a plurality of suction areas.

4

A cushion heel lift having its attaching face provided with a channel out of communication with the marginal surface of the lift.

[fol. 390]

5

A cushion heel lift having a concave attaching face provided with a channel.

6

A cushion heel lift having a concave attaching face divided by a plurality of channels into a group of suction areas.

7

A cushion heel lift having a concave attaching face formed with a depression.

[Matter enclosed between rules erased in copy.]

Cancelled per B

8

3 [a].* A cushion heel lift having a concave attaching face formed substantially centrally located
Per A. with a $\wedge$ depression and with openings for the passage of securing elements surrounding the said depression.

[Matter enclosed between rules erased in copy.]

[*Words and figures enclosed in brackets erased in copy.]

[9]*

2 B [4 a].* A cushion heel lift divided by a plurality of intercommunicating channels into a group of suction areas.

Canceled per A

10

A cushion heel lift having a concave attaching face formed with a groove having a line of extent substantially parallel to the margin of the lift.

[Matter enclosed between rules erased in copy.]

[11]*

3 B [5 a].* A cushion heel lift having a concave attaching face formed with a groove having a line of extent substantially parallel to the margin of the lift and having other channels intersecting each other and communicating with the first mentioned channel.

Insert A[1].>

In testimony whereof I affix my signature in presence of two witnesses.

John G. Tufford. (Seal.)

J. D. Yoakley, Samuel N. Aeker.

[fol. 391] Oath

DISTRICT OF COLUMBIA,
City of Washington, ss:

I, John G. Tufford, the above-named petitioner, being sworn, depose and say that I am a citizen of the United States and resident of Elyria, in the County of Lorain, and State of Ohio that I verily believe myself to be the original, first, and sole inventor of the improvements in Resilient Heels, described and claimed in the annexed specification; that I do not believe that the same was ever known or used before my invention or discovery thereof, or patented or described in any printed publication in any country before my invention or discovery thereof, or more than two years prior to this application, or in public use or on sale in the United States for more than two years prior to this application; that said invention has not been patented in any country foreign to the United States on an application filed by me or my legal representatives or assigns more than twelve months prior to this application; and that no application for patent on said improvements has been filed by me

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[*Words and figures enclosed in brackets erased in copy.]

or my representatives or assigns in any country foreign to the United States, [except as follows: (1)]*

John G. Tufford. (Seal.)

Sworn to and subscribed before me this 16th day of July, 1913. J. D. Yoakley, Notary Public. (Seal.)

Patent Office,
Aug. 13, 1913.
Mailed.

Paper No. 2

Div. XI, Room 154

JST/FAW.

Department of the Interior,
United States Patent Office,
Washington, Aug. 13, 1913.

R. S. and A. B. Lacey, Washington, D. C.:

Please find below a communication from the Examiner in charge of the application of John G. Tufford, Serial No. 780,290, filed July 21, 1913, Resilient Heels.

E. B. Moore, Commissioner of Patents.

[fol. 392] This application has been examined.

The numeral 11 is not on the drawing. The lead line of numeral 12 and Fig. 4 should be changed from the face of the channel.

Division is required between claims 1 and 2, and claims 3 to 11, inclusive.

The former claims are specific to a heel having washers of a particular shape and being located at certain points in a heel, while claims 3 to 11, inclusive, are specific to a heel having on its concave attaching face a number of suction areas formed by a number of channels in the face.

Claim 3 seems to be met by Bray, June 4, 1901, 675,619 (36-35), and Foster et al., Oct. 18, 1910, 973,026 (36-35).

Claims 4, 5, and 6 are met by Foster et al. and Freeman (Br.), Nov. 6, 1902, 24,267 (36-Heels).

Claims 7, 8, 9, 10, and 11, seem to be met by Foster et al., Freeman, and Bray.

The subject-matter specified in claims 1 and 2 seems to be fully met by Herbst, Sept. 1, 1908, 897,860 (36-45), Whitcher, Dec. 24, 1907, 874,471 (36-35), and Yahraus, Apr. 10, 1906, 817,355 (36-35).

H. C. Armstrong, Examiner.

F. A. W.

[*Words and figures enclosed in brackets erased in copy.]

Application Room,
Dec. 15, 1913,
U. S. Patent Office.

U. S. Patent Office,
Dec. 16, 1913,
Division XI.

Serial No. 780,290, Paper No. 3

In the United States Patent Office

Room No. 154

John G. Tufford. Resilient Heels. Filed July 21, 1913. Serial No. 780,290

Amendment A—Filed Dec. 15, 1913

FGS—GS. December 15, 1913. 5516—Y.

Hon. Commissioner of Patents.

SIR: Responsive to Official action of Aug. 13, 1913, the following amendment is made:

Will the Examiner kindly apply the numeral 11 to the channel [fol. 393] which is concentric to the convex edge of the heel in Fig. 4 of the drawings, and extend the lead line from the numeral 12 to the channel which extends longitudinally of the heel in the said figure.

Page 4, erase the paragraph beginning in line 9.

Erase the last paragraph of the specification beginning on page 7.

Cancel claims 3, 4, 5, 6, 7 and 10, and change the ordinals of claims 8, 9 and 11 to 3, 4 and 5 respectively.

Enter the following claims:

Canceled per C

A[1].

Insert B[1].

[6.]* 4b A cushion heel lift having a concave ataching face and a concave tread face [.]* ^ B[1]

[7.]* 5. B A cushion heel lift having a concave attaching face and a convex tread face and having its edges radial to the curvature of the said faces, ^ B[1]

[Matter enclosed between rules erased in copy.]

4 C [8, 6, B]*. A cushion heel lift having its ataching face provided with a suction area located substantially centrally thereof, and washers embedded in the lift and located in a series extending around the said area and located relatively close thereto, the washers at their sides which are located nearer the margin of the lift being straight edged.

[*Words and figures enclosed in brackets erased in copy.]

Claim 3, [line 2, before "depression"]* insert: substantially centrally located.

Remarks

Attorneys consider that claims 1 and 2 as well as the new claim 8, presented above, should be allowed to remain in this case together with the other claims. The applicant's heel lift is provided with a substantially centrally located suction area around which, and closely positioned with respect thereto, are arranged the washers which have their sides nearer the margin of the lift straight edged. By this arrangement the marginal portion of the lift is left of even thickness and of uniform composition throughout so that should it be desired to fit the lift to a heel of a size smaller than that for which it was originally designed, this may be done by cutting away the said marginal portion without destroying the suction area or disturbing the [fol. 394] washers. This arrangement cannot be found in the citations and it is obvious that the new result gained flows from the specific form of the washers and their location relative to the suction area of the lift. For the foregoing reasons, claim 3, as amended, is also thought to be allowable.

As concerns claims 4 and 5, attorneys find in the citations a heel lift provided upon its attaching face with a channel or groove, but fail to find the attaching face of such a lift provided with intercommunicating channels dividing the surface into a number of suction areas. Particularly do they fail to find the specific arrangement set forth in claim 5. In this arrangement there is provided a group of suction areas substantially centrally located.

New claims 6 and 7 call for a heel lift of this type having a concave attaching face and a convex tread face. The advantage resulting from such a structure is that when the lift is attached to the ordinary heel, the attaching surface will lie flat against the ordinary heel lift and the tread surface of the lift of the invention will be flat also, so that it will be of the same degree of resiliency throughout, although having the suction feature. This is not accomplished in the cited structures.

Favorable action on the merits of the claims now standing, and a waiver of the requirement for division is respectfully requested.

Respectfully submitted, R. S. & A. B. Lacey, Attys. for John G. Tufford.

[*Words and figures enclosed in brackets erased in copy.]

Patent Office,
Jan. 22, 1914.
Mailed.

Div. XI, Room 154

Paper No. 4

Department of the Interior,
United States Patent Office,
Washington, Jan. 22, 1914.

R. S. & A. B. Lacey, Washington, D. C.:

Please find below a communication from the Examiner in charge of the application of John G. Tufford, Serial No. 780,290, filed July 21, 1913, Resilient Heels.

Thomas Ewing, Commissioner of Patents.

[fol. 395] Replying to amendment filed Dec. 15, 1913:

The numeral 11 with its lead line has been placed on Fig. 4 and the lead line of numeral 12 has been extended as requested.

Claim 1 is thought allowable.

Claim 2 is rejected as an aggregation. There seems to be no co-operation between the washers, the concaved surface of the lift and the size of the opening in the lift relatively to the size of the securing means driven through these openings. The use of a lift with a concave upper surface is old in the art, as fully shown in Nerger, 661,129, Nov. 6, 1900 (36-35), and the use of securing means greater in diameter than the opening in which they are to be positioned is shown in Rosenberg, 1,049,271, Dec. 31, 1912 (36-35). See also Figs. 2 and 4 of Pratt, 769,324, Sept. 6, 1904 (36-35).

Claim 3 is rejected on Nerger cited above, and also on Zickerman, 634,435, Oct. 3, 1899 (36-35). No invention would be required to provide the cushion heel of Nerger with openings for the passage of securing means. What does applicant mean by "attaching face formed with a depression"?

Claim 4 is rejected on Pratt, cited above (see Fig. 3), as well as on Yahraus, of record. In the device of Pratt suction areas are cut out by channels and in Yahraus such suction areas are separated by ridges.

Claim 5 is rejected on Yahraus.

Claims 6 and 7 are rejected on Nerger.

Claim 8 seems allowable.

This case is thought to disclose three independent features, viz. the washers of peculiar shape, as specified in claims 1 and 8, a heel lift having an upper concave and a lower convex surface, and a heel lift having a plurality of suction areas in its upper face. These three features do not in any way cooperate with each other to give new results. The washers specified would operated in any kind [fol. 396] of rubber lift in the same manner as they do in applicant's lift. The same can be said with regard to the suction areas. They do not in any way depend upon their action on the shape of the

heel, nor the size of the openings in the lift nor the size or shape of the washers. It is thought that the washers of the shape as specified in claim 1 and located as specified in claim 8 constitute applicant's invention. These two claims are considered allowable. The subject matter specified in the other claims should be embodied in separate applications, as indicated above. These features are, however, not considered patentable over the references.

H. C. Armstrong, Examiner.

F. A. W.

Application Room,
Apr. 21, 1924.
U. S. Patent Office.

U. S. Patent Office, Apr. 22, 1914, Division XI.

Amendment B

Serial No. 780,290, Paper No. 5—Filed April 21, 1914

In the United States Patent Office

Room No. 154

John G. Tufford. Resilient Heels. Filed July 21, 1913. Serial No. 780,290.

GGS-GS.

April 18, 1914. 5516-Y.

Hon. Commissioner of Patents.

SIR: Responsive to Official action of January 22, 1914, amendment is hereby made as follows:

Cancel claims 2 and 3 and renumber the remaining claims as 1 to 6 inclusive.

In each of claims 4 and 5, last line, change the period to a comma and add:

B[1] the edges of the attaching face all occupying the same plane.

It is not believed to be proper to require division along the lines suggested by the Examiner, but, on the other hand, it is believed that all of the claims now standing in the case are drawn to one invention. The Examiner is certainly aware of the fact that it is common practice to claim in one application a combination and also details of structure. Merely because the allowed claims 1 and 8 include elements in addition to those recited in the other claims does not indicate that two inventions are involved. There is a com- [fol. 397] bination between the suction areas and the washers, as concerns their relative location, and the arrangement of the suction areas themselves is also novel.

As concerns claim 2, this claim states that the lift is divided by a plurality of intercommunicating channels into a group of suction areas. This claim is rejected on the patents to Pratt and Yahraus. Certain of the concentric grooves in the patent to Pratt are in communication with each other, but while the central space may in itself be considered as a suction area, the annular spaces surrounding it can hardly be so considered. Yahraus does not show a surface divided by grooves into suction areas, nor is the attaching face of his heel lift concave in the sense that is the applicant's. The same remarks apply to claim 3.

It is thought that the amendments made to claims 4 and 5 will render these claims allowable, inasmuch as Nerger shows a heel lift which while it has, in one sense of the word, a concave attaching face, does not have the side, rear and front edges of its said face all occupying the same plane. For this reason it is not apparent that Nerger contemplated providing his heel lift with a suction area, and in fact there could be no suction action in the use of the construction shown. It is believed that the Examiner will upon reconsideration find the application to be in condition for allowance.

Respectfully submitted. R. S. & A. B. Lacey, Attys. for John C. Tufford.

Patent Office,
May 23, 1914.
Mailed.

Paper No. 6

Div. XI

Room 154

ELT/FAW.

Department of the Interior,
United States Patent Office,
Washington, May 23, 1914.

R. S. & A. B. Lacey, Washington, D. C.:

Please find below a communication from the Examiner in charge of the application of John G. Tufford, Serial No. 780,290, filed July 21, 1913, Resilient Heels.

Thomas Ewing, Commissioner of Patents.

[fol. 398] Replying to amendment filed Apr. 21, 1914:

Claims 1 and 3 seem allowable.

Claim 2 is rejected on Bailey, 954,413, Apr. 12, 1910 (36-35), where a number of intercommunicating channels are shown which divide the cushion lift into a plurality of suction areas.

Claims 4 and 5 are rejected on Nerger, of record, and on Hale, 740,124, Sept. 29, 1903 (36-35). Whether or not the edges of the attaching face occupy the same plane seems quite immaterial. This

would depend somewhat on the shape and style of the heel. The patent of Hale shows the attaching edges so located.

Claim 6 appears allowable.

H. C. Armstrong, Examiner.

FAW/Am.

Application Room,
Jun. 5, 1914.
U. S. Patent Office.

U. S. Patent Office,
Jun. 6, 1914,
Division XI.

Serial No. 780,290, Paper No. 7

In the United States Patent Office

Room No. 154

John G. Tufford. Resilient Heels. Filed July 21, 1913. Serial No. 780,290

Letter—Filed June 5, 1914

FGS-GS. June 4, 1914. 5516-Y.

Hon. Commissioner of Patents.

Sir: Responsive to Official action of May 23, 1914.

A careful reconsideration of the rejected claims of this application must be requested inasmuch as the citations are not seen to be anticipations nor to negative the patentability of the applicant's structure over the prior art.

It is noted that claim 2 is rejected on Bailey, in which patent, the Examiner states, a number of inter-communicating channels are shown which divide the cushion lift into a plurality of suction areas. If the Examiner is referring to Figs. 1 and 5 of this patent, attorneys would reply to his rejection by stating that the channels or depressions do not appear to communicate with each other nor do they constitute suction areas for the reason that a suction area [fol. 399] must present a true concave surface. These channels or depressions, however, open at the forward edge of the heel and rear edge of the sole in the said Figs. 1 and 5 respectively, and there could therefore be no suction created on application of pressure to these parts. If the Examiner is referring to Fig. 2 of the patent in question, then attorneys would answer the rejection by stating that this figure and Fig. 4 illustrate the members 9 projecting above the plane of the surface upon which they are formed, and while they may be located upon a depressed surface or, in other words, within a very shallow depression, it is not apparent that suction force would be created to any extent whatsoever nor that any results in any way similar to those obtained by the applicant could be secured.

As concerns the rejection of claims 4 and 5, it may be stated that the applicant shows a shoe heel having a true concave attaching face or, in other words, an attaching face having all of its edges occupying the same plane. It is quite obvious that this is not true of the

Nerger structure, as a reference to Figs. 3 and 4 of that patent will clearly illustrate. Hale also fails to meet this feature of applicant's invention. In the absence of references anticipating these features of the applicant's invention in the terms claimed, it is believed that the claims in question should be allowed.

Respectfully submitted, R. S. & A. B. Lacey, Attys. for John G. Tufford.

Patent Office,
Jun. 26, 1914,
Mailed.

Paper No. 8

ELT/FAW.

Department of the Interior,
United States Patent Office,
Washington, June 26, 1914.

R. S. & A. B. Lacey Washington, D. C.:

Please find below a communication from the Examiner in charge of the application of John G. Tufford, Serial No. 780,290, filed July 21, 1913, Resilient Heels.

Thomas Ewing, Commissioner of Patents.

[fol. 400] Replying to letter filed June 5, 1914:

Claims 1, 2, 3 and 6 are thought allowable.

Claims 4 and 5 are finally rejected on the references of record, and in particular on Hale.

H. C. Armstrong, Examiner.

F. A. W./A

Application Room,
Jul. 7, 1914,
U. S. Patent Office.

U. S. Patent Office,
Jul. 8, 1914,
Division XI.

Serial No. 780,290, Paper No. 9

2

In the United States Patent Office

Room No. 154

John G. Tufford. Resilient Heels. Filed July 21, 1913. Serial No. 780,290.

Amendment C—Filed July 7, 1914

FGS-GS. July 6, 1914. 5516-Y.

Hon. Commissioner of Patents.

SIR: Responsive to Official action of June 26, 1914, amendment is hereby made as follows.

Cancel claims 4 and 5 and change the ordinal of claim 6 to 4.

Remarks

The application is now in condition for the issuance of a notice of allowance.

Respectfully submitted, R. S. & A. B. Lacey, Attys. for John G. Tufford.

Serial No. 780,290

G. F. T.

Department of the Interior,
United States Patent Office,
Washington, July 20, 1914.

John G. Tufford, Assor.

SIR: Your application for a patent for an improvement in Resilient Heels, filed July 21, 1913, has been examined and allowed.

The final fee, twenty dollars, must be paid not later than six months from the date of this present notice of allowance.

If the final fee be not paid within that period, the patent on this application will be withheld, unless renewed with an additional fee of $15, under the provisions of Section 4897, Revised Statutes.

[fol. 401] The office delivers patents upon the day of their date, and on which their term begins to run. The printing, photolithographing, and engrossing of the several patent parts, preparatory to final signing and sealing, will require about four weeks, and such work will not be undertaken until after payment of the necessary fee.

When you send the final fee you will also send, distinctly and plainly written, the name of the inventor, title of invention, and serial number as above given, date of allowance (which is the date of this circular), date of filing, and, if assigned, the names of the assignees.

If you desire to have the patent issue to assignees, an assignment containing a request to that effect, together with the fee for recording the same, must be filed in this office on or before the date of payment of final fee.

After issue of the patent uncertified copies of the drawings and specifications may be purchased at the price of five cents each. The money should accompany the order. Postage stamps will not be received.

Final fees will not be received from other than the applicant, his assignee or attorney, or a party in interest as shown by the records of the Patent Office.

Respectfully, Thomas Ewing, Commissioner of Patents.

☞In remitting the final fee give the serial number at the head of this notice.

☞Uncertified checks will not be accepted.

R. S. and A. B. Lacey, Washington, D. C.
Pay in Final Jul. 28, 1914. A. B. Lacey.

$20 Received Aug. 18, 1914. S. Chief Clerk, U. S. Patent Office

Memorandum of Fee Paid at United States Patent Office

(Be careful to give correct Serial No.)

Serial No. 780,290. —— —, 1914.
Inventor: J. G. Tufford.
[fol. 402] Patent to be issued to Saeur & Assignees.
Name of invention, as allowed: Resilient Heel.
Date of payment: Augt. 18, 1914.
Fee: Final.
Date of filing: July 21, 1914.
Date of circular of allowance: July 20, 1914.
The Commissioner of Patents will please apply the accompanying fee as indicated above.

R. S. & A. B. Lacey, Attorneys, by W. N. W.

Send Patent to R. S. & A. B. Lacey, U. S. and Foreign Patents Washington, D. C.

[Memo.—Bound in here in original file wrapper is a printed Patent Office copy of Tufford patent, No. 1,110,730, dated September 15, 1914, granted to J. G. Tufford, but is not here reproduced as it is printed on pages 337 to 342.]

Contents

1913

1. Application papers. O. K. W. R.
2. Rejection, Aug. 13, 1913.
3. Amendment A, Dec. 15, 1913.
4. Rejection, Jan. 22, 1914.
5. Amendment B, Apr. 21, 1914.
6. Rejection, May 23, 1914.
7. Letter, June 5, 1914.
8. Final Rejection, Jun. 26, 1914.
9. Amendment C, July 7, 1914.

[fols. 403-405] Defendant's Exhibit E

Prior Patents Cited in File Wrapper of Tufford Reissue Patent in Suit and O'Sullivan Patent of January 24, 1899

United States Patents

O'Sullivan Patent No. 618,127, dated January 24, 1899, granted to H. O'Sullivan 405
Ferguson Patent No. 638,228, dated December 5, 1899, granted to C. S. Ferguson 409

No. 618,127. 406 Patented Jan. 24, 1899.

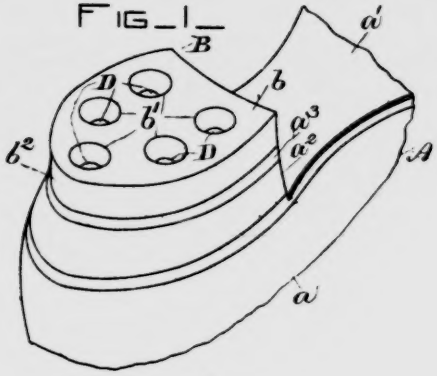
H. O'SULLIVAN.

HEEL FOR BOOTS OR SHOES.

(Application filed Nov. 21, 1898.)

(No Model.)

FIG. 1.



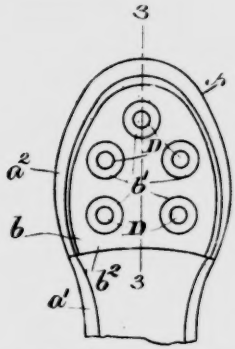


FIG. 2.

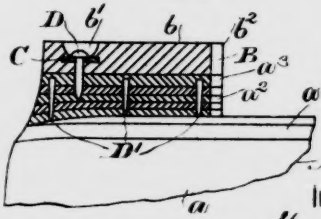


FIG. 3.

WITNESSES

C. Ketcham

G. E. Ostyli

INVENTOR

Humphrey O'Sullivan.

By his attorneys,

Philipp & Anderson.

UNITED STATES PATENT OFFICE.

407-409

HUMPHREY O'SULLIVAN, OF LOWELL, MASSACHUSETTS, ASSIGNOR TO O'SULLIVAN BROTHERS, OF SAME PLACE

HEEL FOR BOOTS OR SHOES.

SPECIFICATION forming part of Letters Patent No. 618,127, dated January 24, 1899.

Application filed November 21, 1898. Serial No. 697,042. (No model.)

To all whom it may concern:

Be it known that I, HUMPHREY O'SULLIVAN, a citizen of the United States, residing at Lowell, in the county of Middlesex and State of Massachusetts, have invented certain new and useful Improvements in Heels for Boots or Shoes; and I do hereby declare the following to be a full, clear, and exact description of the invention, such as will enable others skilled in the art to which it appertains to make and use the same.

My invention relates to heels for boots and shoes; and it consists in improved means, hereinafter described and claimed, of securing elastic cushions to heels in such a manner as to unite the edges of such cushions to the heels as closely as the edges of the contiguous lifts of a heel are commonly united to each other. Such cushions are commonly of rubber, and the securing means are placed at such distance from their sides and ends as to allow them in walking to separate slightly from the leather top lifts of the heel proper, leaving a crack which takes in the mud and filth of the streets and keeps the heels dirty. I avoid this by uniting the rubber cushion to a lift of leather by means of a cement insoluble in water, as the well-known rubber cement, so that when said lift is secured to the heel of the shoe there is no separation of the cushion and said lift, and when the latter is united to what was previously the top lift of the heel these two leather lifts are secured to each other as firmly as they would be if the cushions were not used.

In the accompanying drawings, illustrating the preferred form of my invention, Figure 1 is an isometric view of the lower rear part of a shoe, including the heel, with my invention applied thereto; Fig. 2, a reduced plan of the parts shown in Fig. 1; Fig. 3, a vertical longitudinal section of the heel of a shoe on the line 3 3 in Fig. 2, adjacent parts of the sole and upper of the shoe being shown in elevation, the parts being represented as inverted in all said figures.

The shoe A is of any usual construction, except as hereinafter stated, having an upper a, sole a', and heel a^2, the body of said heel being formed in the usual manner of lifts of leather.

The cushion or top lift B is of a suitable shape to conform to the outline of the heel, and consists of a leather lift a^3, to which is secured by rubber cement or other cement insoluble in water a thick lift b^2, of elastic material, as india-rubber. The elastic lift b^2 may be solid, but as represented in the drawings is provided in its wearing-surface b with suction-recesses b', the object of which is to cause the heel to adhere slightly to the surface walked upon. No claim is made in this application, however, to an elastic heel provided with suction-recesses, as such a heel is shown, described, and claimed in a pending application, Serial No. 619,971, filed by James O'Sullivan and myself as joint inventors January 20, 1897.

The principal means of securing the elastic cushion B to the heel are the nails D', which unite the different lifts of the body of the heel proper, a^2, the large ends or heads of these nails D' being allowed to project from the body of the heel proper far enough to enter the leather lift a^3 of the cushion B, which is hammered or crowded upon the heads of said nails in the usual manner followed in what is called "blind" nailing. The cushion B may further be secured in place by means of washers placed in the bottoms of the suction-recesses b', as shown in said application Serial No. 619,971, or secured in the body of said cushion B concentrically with said recesses and by nails D or screws driven through said washers and through the leather lift a^3 of said cushion into the heel a^2.

Having thus described my invention, I claim as new and desire to secure by Letters Patent of the United States—

As an article of manufacture a heel for boots or shoes, comprising an elastic top lift having burs or washers embedded therein, and a leather lift, the top lift and leather lift being united by insoluble cement, the whole being adapted to be secured to the heel of a boot or shoe by nails passing through said embedded washers, substantially as described.

In testimony whereof I affix my signature in presence of two witnesses.

HUMPHREY O'SULLIVAN.

Witnesses:
FRANK H. PURRINGTON,
HORACE VAN EVEREN.

No. 638,228. Patented Dec. 5, 1899.

C. S. FERGUSON.

RUBBER HEEL ATTACHMENT FOR BOOTS OR SHOES.

(Application filed Aug. 7, 1899.

(No Model.)

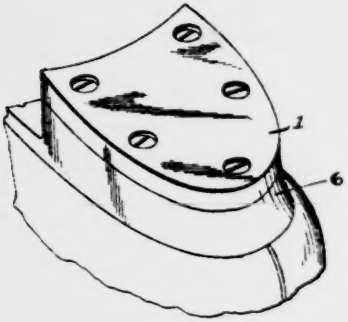
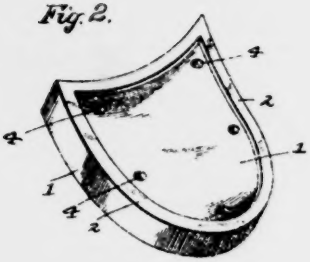


Fig. 1.

Fig. 2.



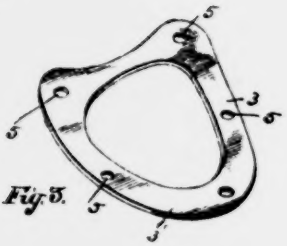


Fig. 3.

Fig. 5.

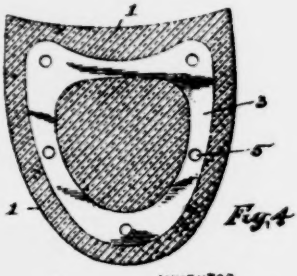


Fig. 4.

WITNESSES.

A. B. Bradshaw

J. H. Travel

INVENTOR

Cara S. Ferguson

BY

C. O. Shepherd

ATTORNEY

UNITED STATES PATENT OFFICE.

CARA S. FERGUSON, OF COLUMBUS, OHIO, ASSIGNOR OF ONE-HALF TO HENRY C. WERNER, OF SAME PLACE.

RUBBER HEEL ATTACHMENT FOR BOOTS OR SHOES

SPECIFICATION forming part of Letters Patent No. 638,228, dated December 5, 1899.

Application filed August 7, 1899. Serial No. 726,360. (No model.)

To all whom it may concern:

Be it known that I, CARA S. FERGUSON, a citizen of the United States, residing at Columbus, in the county of Franklin and State of Ohio, have invented a certain new and useful Improvement in Rubber Heel Attachments for Boots or Shoes, of which the following is a specification.

My invention relates to the improvement of rubber heels for shoes and boots; and the objects of my invention are to provide an improved heel of this class adapted to be attached to an ordinary boot or shoe heel, to so construct the same as to insure the retention of a close and desirable contact of the rubber with the surface of the leather heel, and to produce other improvements the details of construction and arrangement of which will be more fully pointed out hereinafter. These objects I accomplish in the manner illustrated in the accompanying drawings, in which—

Figure 1 is a detail view in perspective of a shoe-heel having my improved attachment connected therewith. Fig. 2 is a detail view in perspective of the rubber heel attachment. Fig. 3 is a similar view in perspective of an intermediate spring-frame or washer which I employ in the manner hereinafter described. Fig. 4 is a central horizontal section of the heel attachment, and Fig. 5 is a transverse section of the same.

Similar numerals refer to similar parts throughout the several views.

In carrying out my invention I cause to be molded or otherwise produced a rubber heel-section 1, which, as indicated in the drawings, is of a concavo-convex form. The upper side of the rubber heel section or body is formed with a raised marginal portion, which is indicated at 2, this raised portion being continuous about the margin or outline of the heel-section. In molding the rubber heel I inclose or embed in the body thereof a metallic spring-frame or washer 3, which, although smaller, has somewhat the outline of the heel-section 1 and which is normally curved or bent to correspond to the curvature of said heel-section.

As indicated at 4, I form at desirable points in the heel-section 1 openings, which, as shown at 5, are continued through the internal spring-frame 3, these openings being designed to receive the screws, nails, or other attaching devices through the medium of which the heel-section 1 is secured to the outer lift of the usual leather heel 6.

It is obvious that when the concavo-convex heel-section is screwed tightly against the leather heel surface said heel-section will thus be forced to assume the straight or horizontal form of the leather heel-lifts, and owing to the natural tendency of said heel-section to assume its normal curved form it will be seen that the tendency of the raised marginal portion 2 will be to cling closely to the surface of the leather, thereby overcoming the usual tendency of rubber heel attachments toward lifting up or separating from the leather at the edges. It will be observed that the curved spring-frame 3, which is embedded, as described, in the rubber heel-section, will assist in imparting the desired curvature to the rubber and increase the tendency toward the latter's retaining its concaved form.

Although I have described the rubber heel attachment as being so secured to the leather heel-surface as to bring the raised marginal portion 2 in contact with the leather, it is obvious that said heel attachment might be inverted, if so desired.

From the construction shown and described it will be observed that a desirable form of rubber heel attachment is provided for boot and shoe heels which will at all times cling closely to the boot or shoe heel surface and that the usual tendency of rubber heel attachments to rise or separate from the leather heel at the edges will be entirely obviated.

Having now fully described my invention, what I claim, and desire to secure by Letters Patent, is—

1. A rubber heel attachment for boot and shoe heels consisting of a heel section or body 1 molded to a concavo-convex form and provided with a raised marginal portion and openings therethrough, substantially as specified.

2. In a rubber heel attachment for boot and shoe heels, the combination with an elastic heel-section 1 molded to a concavo-convex form, of a correspondingly-concaved spring metallic frame embedded within said heel-section and provided with openings registering with those of said heel-section, substantially as specified.

CARA S. FERGUSON.

In presence of—
A. L. PHELPS,
C. C. SHEPHERD.

No. 661,129. Patented Nov. 6, 1900.

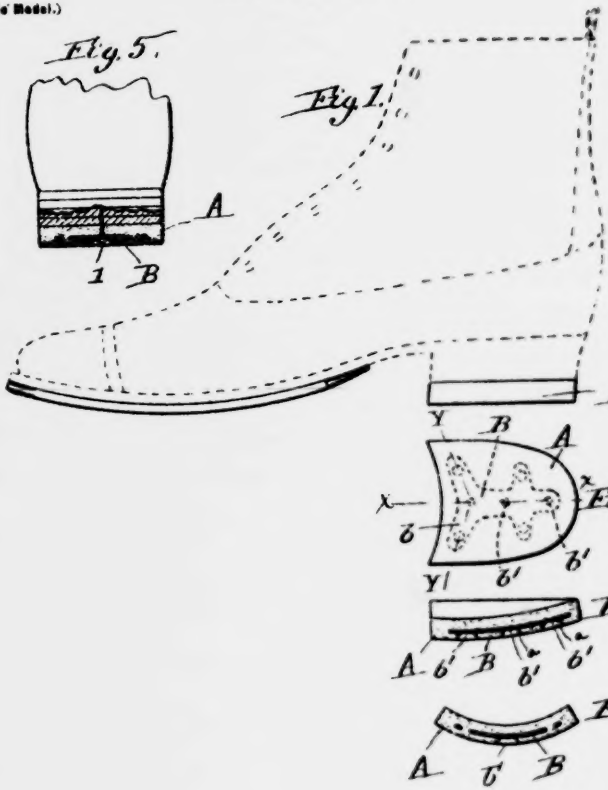
414

F. NERGER.

HEEL.

(Application filed Jan. 15, 1900.)

(No Model.)



Witnesses:
Henry C. Brauns.
A. F. Durand

Inventor:
Fred Nerger.
by Chas. L. Page Atty.

UNITED STATES PATENT OFFICE.

FREDRICK NERGER, OF CHICAGO, ILLINOIS.

HEEL.

SPECIFICATION forming part of Letters Patent No. 661,129, dated November 6, 1900.

Application filed January 15, 1900. Serial No. 1,503. (No model.)

To all whom it may concern:

Be it known that I, FREDRICK NERGER, a citizen of the United States, residing at Chicago, county of Cook, State of Illinois, have invented a certain new and useful Improvement in Rubber Heel-Lifts, of which the following is a specification.

My invention relates to a construction of rubber heel-lift for boot and shoe heels involving a top or lift of concavo-convex form and attached to the boot or shoe by nails or screws passing through a spring-metal frame embodied in the rubber lift.

So far as I am aware the only rubber heel-lift involving the foregoing matters and proposed prior to my invention contemplates a concavo-convex rubber lift provided with a raised marginal portion on its concave side and a centrally open spring-metal frame embodied in the lift and practically forming a continuous spring-metal strip arranged near the edge or margin of the lift and provided with holes for the fastening nails or screws, in which way the lift is secured near its edge portions only.

The objects of my invention are to avoid such central bulging of the lift as will be incident to securing it near its edge portions only, to flatten down the concavo-convex lift from the center and centrally tack or screw it down, whereby it flattens down and at the same time leaves its edge portions free, and to further maintain such flattened condition of the lift by widening the central reinforcement to a suitable extent.

To the attainment of the foregoing and other useful ends my invention consists in matters hereinafter set forth and claimed.

In the accompanying drawings, Figure 1 illustrates a shoe provided with a rubber heel-lift embodying the principles of my invention. Fig. 2 is a plan of the rubber heel-lift, showing the metal plate in dotted lines. Fig. 3 is a section on line $x\,x$ in Fig. 2. Fig. 4 is a section on line Y Y in Fig. 2. Fig. 5 is a view similar to Fig. 4, but showing the lift attached to the heel of a boot or shoe.

The rubber heel-lift A is of sufficient thickness to provide a suitably elastic cushion and corresponds in outline to the outline of the usual boot or shoe heel. The upper surface of said lift is concave and its under or tread surface is preferably convex. (See Figs. 3 and 4.) As illustrated, the said heel-lift is provided with a metal plate B, which is embedded in the rubber and which is curved to conform to the curvature of the upper and lower surfaces of said lift. The said plate is preferably composed of some springy metal, is preferably formed with lateral arms b, and is provided with nail or tack openings b'. The under or tread side of the rubber heel-lift can be provided with countersinks a, which are coincident with the nail-openings b' and which receive the heads of the nails l, as shown in Fig. 5. Thus formed the rubber heel-lift can be attached to the heel of a boot or shoe by applying its concave surface to such heel and driving nails or tacks through the centrally-arranged openings b' in the plate B. The nails or tacks when driven home will cause the rubber lift to flatten against the under side of the heel proper. Such flattening or flexing of the heel-lift will of course place both the rubber and metal plate under tension—that is to say, the lift will have a constant tendency to regain its normal shape—and its edges or marginal portions will therefore hug or press tightly against the under side of said heel. In this way the side portions of the heel-lift, though free or unattached, will be held in contact with the heel proper and there will be no danger of a falling away or splitting off of said lift at its edges. The central arrangement of the tack or screw holes b' permits the lift to be flattened out and securely attached at its central portion and, together with the dished or curved form of the steel and rubber, renders it unnecessary to make provision for attaching the side or marginal portions of the heel-lift.

From the foregoing it will be seen that the centrally and longitudinally arranged transversely-curved spring-plate B permits nails or screws to be applied along a central line, while at the same time when the nails or screws are forced into the heel the width of the plate at opposite sides of such line will provide a width of yielding spring clamping-bearing of sufficient power to cause the lift to flatten down, the nails or screws, in con-

junction with a centrally-arranged bearing, serving to prevent the lift from bulging out along its longitudinal middle portion. The lateral extension of the spring-plate, as by its lateral arms *b*, serves to provide the normally concavo-convex lift with a central spring clamp or bearing portion having lateral spring clamping portions of less spring resistance, thereby providing a matter of further improvement. It will also be seen that the normally concavo-convex elastic or rubber lift is secured upon the boot or shoe heel by a set of nails or screws passing through the longitudinal middle portion of the lift and that such lift, broadly considered, has its longitudinal middle portion reinforced at points where the nails or screws are to be driven through the lift, thereby preventing the lift from breaking away from the nails or screws at the point where it tends to bulge out when flattened down in opposition to its general spring resistance; also, that the portions of the lift between its margin and such nails and screws inserted through its middle portion are free and unattached, although flattened down, and that owing to the springy nature of the rubber such portions will be flattened down and held in opposition to a general spring resistance.

What I claim as my invention is—

1. A normally concavo-convex rubber lift for boot and shoe heels, provided with a longitudinally and centrally arranged spring clamping-plate embedded in the lift and provided with openings for nails or screws, substantially as described.

2. A normally concavo-convex rubber lift for boot and shoe heels provided with a longitudinally and centrally arranged transversely-curved spring clamping-plate embedded in the lift and provided with holes for nails or screws, substantially as set forth.

3. A normally concavo-convex rubber lift for boot and shoe heels provided with a longitudinally and centrally arranged spring-plate having laterally-extending arms and embedded in the rubber lift, the plate being provided with suitable holes for nails or screws, substantially as described.

4. The combination with a boot or shoe heel of a normally concavo-convex rubber lift; a set of nails or screws securing the lift to the boot or shoe heel and passing through the longitudinal middle portion of the lift having its middle portion reinforced to prevent the lift from breaking away from the heads of the nails or screws, the lift thus secured being flattened down upon the boot-heel in opposition to spring resistance between its margin and the securing nails or screws and being unattached between said margin and its middle portion thus held down upon the heel by said nails or screws.

FRED. NERGER.

Witnesses:
HENRY C. BRAUNS,
ARTHUR F. DURAND.

No. 740,124. PATENTED SEPT. 29, 1903.

J. C. HALE.

HEEL FOR BOOTS OR SHOES.

APPLICATION FILED APR. 1, 1903.

NO MODEL.

Fig. 1.

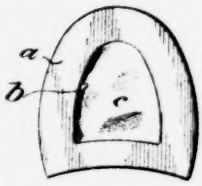


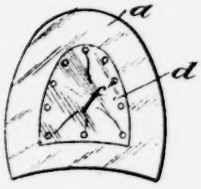
Fig. 2.

Fig. 3.

Fig. 4.

Fig. 5.

Fig. 6.



Witnesses:
Fred. C. Haynard.
A. W. Pittman

Inventor:
John Clellan Hale,
By his Attorney,
F. A. Richards

UNITED STATES PATENT OFFICE.

JOHN CLELLAN HALE, OF ALEXANDRIA, SCOTLAND, ASSIGNOR TO RUDOLPH MEIER HOWISON, OF LONDON, ENGLAND.

HEEL FOR BOOTS OR SHOES.

SPECIFICATION forming part of Letters Patent No. 740,124, dated September 29, 1903.

Application filed April 1, 1903. Serial No. 150,524. (No model.)

To all whom it may concern:

Be it known that I, JOHN CLELLAN HALE, a subject of the King of Great Britain and Ireland, residing in Alexandria, Scotland, have invented certain new and useful Improvements in Heels for Boots or Shoes, of which the following is a specification.

This invention relates to an improved heel for boots and shoes; and it has for its object to construct a composite heel of leather and rubber in such a manner as to avoid the disadvantages attending the employment of heels of this class. With these heels as at present constructed it is found that there is considerable difficulty in securing and maintaining a perfect and complete contact between the outer surface of the heel of the boot and the inner face of the supplementary heel. Not only does the aforesaid disadvantage arise when applying the supplementary heel to a new boot, and consequently when the surface of the heel is more or less flat, but when the heel is applied to an old or worn surface the disadvantage is increased to such an extent as to leave open spaces between the respective parts, which permit the heel to engage with any projection or unevenness of the ground, causing the wearer to trip, and the heel thus becomes a source of danger instead of a protective device. This, in addition to reducing the utility of such heels, permits the entry between the surfaces of dirt or other foreign matter, which destroys the material and further causes discomfort to the wearer. Further, although an approximately perfect contact is established between the respective surfaces when new, yet under the wear it is found that the heels have a gradually-increasing tendency to curl up, leaving the boot-heel proper at the outer edges.

It is the object of the present invention to construct a heel of this class in such a manner as to avoid the aforesaid disadvantages by insuring close, firm, and permanent contact between the whole of the respective surfaces of the heel and the boot whether the latter be new or worn.

The improved heel consists of a flat piece of rubber or other elastic or comparatively elastic material of an outline conforming more or less to the outline of the surface to which it is to be applied. The rubber or the like is perforated or recessed and is backed with canvas or other like material, the object of which is to limit the expansion of the rubber plate upon the under side. In the opening or cavity is tightly fitted a piece of leather or other substance. The dimensions of the leather being necessarily somewhat in excess of the dimensions of the cavity destined to receive it when in position, the leather exerts a side pressure in all directions, which causes the surrounding material to curve or belly outward. Under these circumstances the surfaces of the heel with the leather in position instead of being flat are respectively concave and convex, the concave surface being that presented to the boot-heel.

It is evident that if the boot-heel, as above described, be pressed down upon a flat surface the marginal edges thereof will first come into contact with the said flat surface, the area of contact increasing as the composite heel is forced against the boot-heel until eventually the two surfaces are pressed together and maintained in close and firm contact. By this means not only is the heel much firmer under the wearer's weight, but the entry of foreign matter in the manner previously referred to is prevented and the life of the heel considerably increased.

In order that the invention may be the better understood, drawings are appended, in which—

Figures 1 and 2 illustrate the component members of a heel. Fig. 3 is a side elevation of the central portion thereof. Fig. 4 is a sectional view showing the central portion of the heel ready for insertion in its retaining cavity or recess. Fig. 5 is a sectional view illustrating the action of the central portion of the heel. Fig. 6 is a view showing the general appearance of the heel with the central portion in place.

Referring to the drawings, Figs. 1 to 6, *a* represents a plate of rubber perforated at *b* and provided with a backing of canvas or other material *c*.

d is a piece of leather conforming in outline to the outline of the cavity in the leather, but of somewhat greater dimensions, as clearly shown in Fig. 4. The walls of the cavity in

the instance referred to are square with the surface of the rubber, as are also the edges of the leather *d*. It is obvious that if the leather *d* be placed in the cavity in the rubber the softer material will yield in all directions. By this means the area of the outer surface of the rubber will be increased relatively to that of its under surface, the expansion of which is prevented by the canvas backing, and consequently it will assume a curved or bellied shape, which will increase as the leather is forced home until approximately that illustrated in Fig. 5. In the figure referred to the heel is shown as applied to the outer surface of a boot-heel *e*, to which it is secured by means of nails or the like, *f*, driven through the leather center, as shown in Fig. 6.

When placing the central leather plate in position in order to insure its proper and complete introduction into the recess, so that the under surface of the said plate bears against the canvas backing forming the bottom of the recess, I first place the aforesaid central disk within the recess and push same home as far as it will go. It will be found that whatever the direct pressure exerted upon the central plate when such pressure is reduced there will always be a space left between the backing and the inner face of the central plate. In other words, the disk will not be properly bedded upon the backing. To overcome this, I bend the rubber of the outer plate backward at the point of junction between the edges of the recess and the walls of the inner plate. This not only permits the central disk to be bedded upon the backing, but also when the rubber is permitted to assume its normal position the said central plate will be prevented from displacement, and when the heel is nailed in position an effective and permanent contact will be established between the whole of the surfaces irrespective of the fact that the boot-heel proper may have been considerably worn before the outer heel was applied.

Having thus described my invention, I claim—

1. A boot-heel of the kind specified, comprising a plate of elastic material having a central opening, a backing of fabric secured to said plate and forming a bottom for said opening, and a plate of leather of larger dimensions than said opening and adapted to be placed thereinto.

2. A boot-heel of the kind specified, comprising a plate of rubber having a central opening, a backing of fabric secured to said plate and forming a bottom for said opening, and a plate of leather of larger dimensions than said opening and adapted to be placed thereinto.

In witness whereof I have hereunto set my hand in the presence of two witnesses.

JOHN CLELLAN HALE.

Witnesses:
J. MORRISON GILCHRIST
JOHN M. LENINDALE.

No. 817,355. PATENTED APR. 10, 1906.

C. YAHRAUS & F. A. HAMMER.

422 RUBBER HEEL FOR BOOTS AND SHOES.

APPLICATION FILED NOV. 14, 1904

Fig. 1.

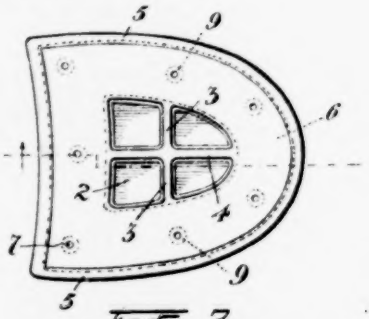


Fig. 3.

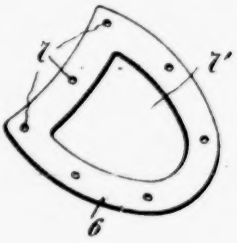


Fig. 2

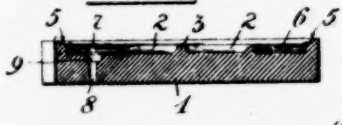


Fig. 4.

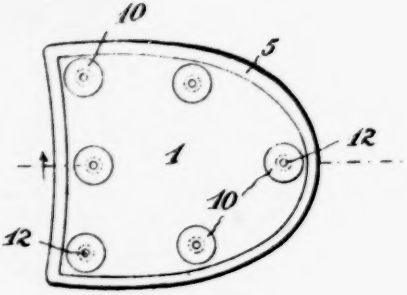
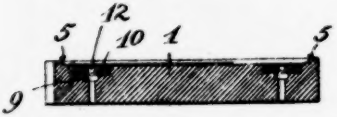


Fig. 5



Witnesses
C. Hunter
C. W. Grisbauer

Inventors
Charles Yahraus
& Frank A. Hammer
by A. Blackmon
Attorney

UNITED STATES PATENT OFFICE.

CHARLES YAHRAUS AND FRANK A. HAMMER, OF WOONSOCKET, RHODE ISLAND.

RUBBER HEEL FOR BOOTS AND SHOES.

No. 817,355. Specification of Letters Patent. Patented April 10, 1906.

Application filed November 14, 1904. Serial No. 232,710.

To all whom it may concern:

Be it known that we, CHARLES YAHRAUS and FRANK A. HAMMER, citizens of the United States, residing at Woonsocket, in the county of Providence and State of Rhode Island, have invented certain new and useful Improvements in Rubber Heels for Boots and Shoes; and we do declare the following to be a full, clear, and exact description of the invention, such as will enable others skilled in the art to which it appertains to make and use the same.

This invention relates to improvements in rubber heels for boots and shoes.

The object of the invention is to provide an elastic heel having arranged therein and connected thereto one or more attaching and strengthening plates, said plates being attached to the heel in such manner that they cannot become separated.

A further object is to provide a heel of this character having means whereby the outer edge of the same will have a perfectly tight engagement with the heel, thereby excluding water and all foreign matter from between the rubber heel and the heel of the shoe.

With these and other objects in view the invention consists of certain novel features of construction, combination, and arrangement of parts, as will be hereinafter described and claimed.

In the accompanying drawings, Figure 1 is a plan view of the inside of the heel. Fig. 2 is a vertical longitudinal sectional view of the same. Fig. 3 is a detail perspective view of the attaching-plate removed from the heel. Fig. 4 is a view similar to Fig. 1, showing a modified construction of heel; and Fig. 5 is a vertical longitudinal sectional view of the same.

Referring more particularly to Figs. 1, 2, and 3 of the drawings, 1 denotes the body portion of the heel, which is constructed of rubber or other elastic material and has formed on its inner or upper face a centrally-disposed depression 2, which is divided by longitudinally and transversely disposed ribs 3 and 4 into four compartments or air-chambers, as shown. Around the edge of said face is formed an upwardly-projecting sealing-flange 5.

Secured to the inner face of the heel and countersunk into the same is a metallic plate 6, in the central portion of which is formed an opening 7, which corresponds to the shape of and alines with the depression on the heel. In the plate 6 are formed nail-holes 7, which are arranged in alinement with the nail-holes 8, formed in the body portion of the heel 1. The inner end of the nail-holes 8 are enlarged to form a seat 9 for the head of the nail after the same has been driven through the holes 8, the flexible walls of the holes 8 giving or yielding to permit the heads of the nails to pass therethrough, and after said heads have entered the enlarged seat 9 the walls of the holes 8 will again contract, thus preventing the nails from working loose. A suitable tool is employed for driving the nails through the holes 8 in the heel. The plate 6 is adapted to lie flush with the inner face of the heel within the sealing-flange 5, so that when said heel is applied to the shoe the sealing-flange 5 will be brought into tight engagement with the sole of a shoe, thus preventing the entrance of water or foreign matter between said heel and the sole of the shoe.

In forming the heel as herein shown and described the plate 6, which has been formed in the desired shape, is treated with a chemical solution, such as oil of vitriol, and is then copper-plated by electricity or by being immersed in a solution of sulfate of copper, which process causes the rubber to adhere firmly to the metal plate. After the plate has been thus chemically prepared the same is treated with a thin solution of dissolved unvulcanized rubber. The rubber-coated plate is then placed in a mold and layers of unvulcanized rubber placed thereon to the desired thickness, the top portion of the mold containing the nail hole forms is then applied, and the rubber is then shaped and vulcanized together under heat and heavy pressure into a compact mass, the plate 6 being thus vulcanized securely to the upper surface or face of the heel, from which it will be impossible to remove the same.

By coating the plate 6 with a solution of unvulcanized rubber and then vulcanizing the plate thus treated in the heel the plate is held firmly in place and does not wear out the surrounding rubber by moving back and forth in walking, as would be the case were the plate merely embedded without coating in the body of the heel.

The arrangement of the plate upon the inner face of the heel will permit the rubber body portion of the same to wear down the entire thickness, the heel being held onto the sole of the shoe by means of its vulcanized connection with the plate, the nails being employed to hold the plate in place on the shoe.

By forming the depression 2 in the upper face of the shoe increased elasticity or cushioning properties is given to the heel. The ribs or bars 3 and 4, which divide said depression into compartments, will form supports or braces, which will prevent the tread of the heel from becoming concaved from shrinkage or other causes, thus keeping the tread of the heel square and level while the same is being worn away by use.

In Figs. 4 and 5 of the drawings is shown a modified arrangement of the attaching-plates, the same being shown in these figures in the form of rubber-coated disks 10, each of which is provided with a centrally-disposed nail-hole 12. Said hole 12 is adapted to aline with nail-holes formed in the body of the heel, as shown and described in connection with the first figures of the drawings. In this latter form the heel is provided with an upwardly-projecting marginal sealing-flange 5, as hereinbefore described. The disks 10 may be in any suitable shape, but are here shown as of circular form, the same being chemically treated and prepared in the same manner as described in connection with the single plate 6 and are countersunk and vulcanized to the inner face of the heel in the same manner as described in connection with said Fig. 3.

From the foregoing description, taken in connection with the accompanying drawings, the construction and operation of the invention will be readily understood without requiring a more extended explanation.

Various changes in the form, proportion, and the minor details of construction may be resorted to without departing from the principle or sacrificing any of the advantages of this invention.

Having thus described our invention, what we claim as new, and desire to secure by Letters Patent, is —

A heel for boots and shoes consisting of an elastic body portion provided with a series of nail-holes therein and having formed on its inner face a depression having an upwardly-projecting sealing-flange formed around the edge of said inner face, a rubber-coated plate seated in said depression and vulcanized into the body of the heel, said plate having formed therein a series of nail-holes which aline with the nail-holes in the body of the heel, substantially as described.

In testimony whereof we have hereunto set our hands in presence of two subscribing witnesses.

CHARLES YAHRAUS.
FRANK A. HAMMER.

Witnesses:
FRANK D. BRIGGS,
ALBERT H. SHERMAN.

Nerger Patent No. 661,129, dated November 6, 1900, granted to F. Nerger 413
Hale Patent No. 740,124, dated September 29, 1903, granted to J. C. Hale 417
Yahraus et al. Patent No. 817,355, dated April 10, 1906, granted to C. Yahraus et al. 421

British Letters Patent

Stern Patent No. 8159, dated April 7, 1913, granted to Paul Stern 425
Cairns Patent No. 8205, dated April 5, 1906, granted to John Cairns 429

(Here follow specifications marked side folio pages 406-409, 410-413, 414-417, 418-421, and 422-424, respectively.)

[fol. 425] No. 8159, A. D. 1913

Date of Application, 7th Apr., 1913; Accepted 19th Feb., 1914

Complete Specification

Improved Fastening for Rubber Heels

I, Paul Stern, of 2, Forray-Gasse, Arad, Hungary, Merchant, do hereby declare the nature of this invention, and in what manner the same is to be performed, to be particularly described and ascertained in and by the following statement:

This invention relates to a fastening for rubber heels which, as opposed to those in use hitherto, possesses the great advantages that not only is the rubber heel easily and rapidly fastened to the boot heel by anyone, and, when worn out, may be easily and simply taken off without injury to the boot heel and replaced by a new one, or may be easily changed over in the case of one-sided wear from the right to the left heel, and vice versa, but also that close contact between the rubber heel and boot heel is ensured, and the edges of the rubber heel and boot heel are prevented from separating from the boot heel when in use.

The fastening may consist of a sheath formed as a female screw to be fastened into the boot heel, and of a screw pin to which is attached a curved or concave metal plate, the pin being screwed into the said sheath for fixing the rubber heel.

The female screw sheath is preferably also furnished with an external thread so that the sheath itself may be fastened into the boot heel by being screwed in.

In the case of round rubber heels which are merely fastened with a central screw, the pin for fixing the rubber heel is preferably fastened in the rubber heel in such a way that it is turned together with the latter.

In the drawing Figure 1 shews an example of construction of the subject of the invention in vertical section on the line A—B of Figure 2; Figure 2 a horizontal section on the line C—D of Figure 1; and Figure 3 a vertical sectional view of a detached heel.

[fol 426] b is the sheath to be fastened into the boot heel a, which sheath is furnished with an internal screw-thread and serves for the reception of the screw pin c.

The sheath b is preferably also furnished with an external thread so that the sheath can be simply screwed into the heel a.

The sheath must be completely sunk in the heel a so that it does not project at the bottom. The sheath is furnished with a recess d for the screw-driver.

In the case of round rubber heels—as illustrated in Figures 1 and 2 for example—the pin c is fastened in the rubber heel in such a way that it can be turned together with the latter. A form of construction of this fastening is shewn in Figures 1 and 2, in which the pin c is riveted or otherwise fastened to a plate e in such a way that it can not be turned in the said plate. The plate e is embedded in the rubber heel and also secured against rotation by holes g which are filled by the rubber in the process of moulding.

The fastening of the rubber heel is effected by simply screwing the pin c into the female screw sheath fastened in the boot heel a, by turning the rubber heel.

In order to prevent the loosening of the sheath b screwed into the heel a when unscrewing the pin c, it is preferable for the external thread of the sheath b to have a direction opposite to that of the pin c.

Before being screwed on to the boot heel the plate e is of a curved or concave shape as shewn in Fig. 3, and the rubber heel also has the same form. This shape has the advantage that on screwing the rubber heel tight it remains in contact with the boot heel over the whole surface, and the edges of the rubber heel are not separated from the boot heel.

I am aware that the means hereinbefore described for attaching the rubber heel to the boot heel are not in themselves novel, and I make no general claim to such devices.

Having now particularly described and ascertained the nature of my said invention, and in what manner the same is to be performed, I declare that what I claim is:

[fol. 426A] First. A rubber heel for foot wear so formed and shaped that before it is attached to the boot heel it is of a curved or concave shape, substantially as described.

Second. A rubber heel of the kind forming the subject of the first claiming clause hereof having a curved or concave metal plate embedded therein, and provided with means of attachment to the boot heel, substantially as described.

Third. A rubber heel attachment for footwear comprising a screw-threaded sheath fixed into the boot heel, a screw pin which can be screwed into this sheath, and a rubber heel of curved or concave shape, substantially as described.

A.D. 1913 April 7. N° 8189.
STERN'S Complete Specification. (1 SHEET)

[This Drawing is a full-size reproduction of the Original.]

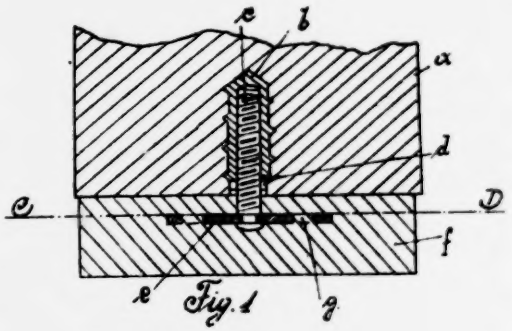


Fig. 1

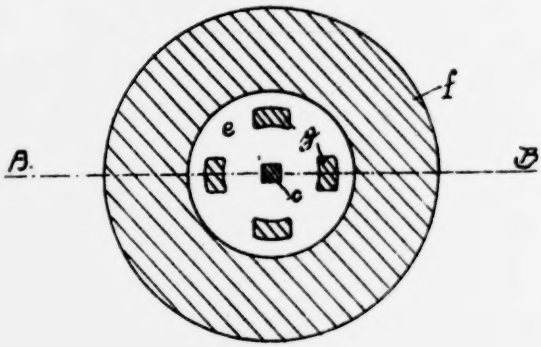


Fig. 2.

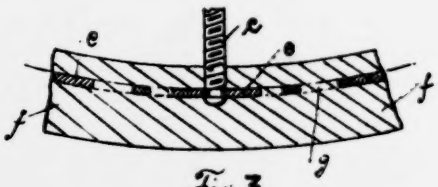


Fig. 3.

Hollyer & Sons, Photo-Litho

Dated this 5th day of April. 1913.
P. Stern, Per W. H. Beck & Co., 115 Cannon Street, London, E. C., Chartered Patent Agents.

Reference has been directed in pursuance of Section 7, Sub-section 4, of Patents and Designs Act, 1907, to Specifications No. 24,194 of 1899, and No. 22,855 of 1902.

(Here follows diagram marked side folio page 427)

[fols. 428 & 429] No. 8205. A. D. 1906

Date of Application: 5th Apr., 1906; Complete Specification Left 10th Sept., 1906; Accepted 22nd Nov., 1906

Provisional Specification

Improvements in or Relating to Heels for Boots and Shoes

I, John Cairns of 36 Cathles Road, Balham Hill, London, S. W., Mechanic, do hereby declare the nature of this invention to be as follows:

This invention is principally made up of five parts which for the purposes of this description are hereinafter distinguished by the letters A, B, C, D, E.

A, is a suitable inner flanged shell, suitably made, out of metal or any suitable material to prevent the rubber pad from expanding outward, when in position,

B, is a suitable rubber pad, or equivalent made with a suitable inner cell, with a raised top leaving a flat edge to fit inside of shell and is put in under compression to prevent the pad from coming out,

C, is a suitable air chamber, which is formed when the rubber pad is in position, and when under compression the air is compressed when pressure is off the compressed air it forces the rubber back to its natural position.

D, is a suitable attachment. In the heel would be a screw put down through the centre of shell to form an axle for the heel to move round on when required, and when the pad is in its position the head of the screw is invisible, and has no connection with the pad,

E, is a suitable washer, which is placed between head of screw and shell to form an air tight joint,

Dated this 5th day of April 1906.

John Cairns.

[fol. 430] Complete Specification

"Improvements in or Relating to Heels for Boots and Shoes"

I, John Cairns, late of 36, Cathles Road, Belham Hill, London, S. W. but now of 9 Alloa Road, Deptford Park, London, S. E. Mechanic, do hereby declare the nature of this invention and in what manner the same is to be performed to be particularly described and ascertained in and by the following statement:

This invention relates to improvements in pneumatic heel pads for boots and shoes, whereby any vibration or shock to the wearer is absorbed, thereby making walking much easier.

In order that my invention may be properly understood and readily carried into effect, I have hereunto appended one sheet of drawings, of which

Figure 1 is a view of heel of boot showing my heel pad fixed thereto.

Figure 2 is a section of the pad.

Figure 3 is a plan of the same.

In carrying out my invention I provide an air-tight shell A of aluminium or any other suitable metal or material having an inwardly-turned flange B. I also provide a pad C of rubber or other elastic material having a somewhat rounded corrugated top D, a hollow or recess E in the underside thereof, and a flange F which causes it to be held in situ, and when the pad is in position, an air space I is formed, as shown more particularly in Figure 2. The whole thus forms a complete pneumatic pad in itself without coacting with the heel.

The shell is fixed to the heel L of the boot or shoe by a suitable screw G which is passed through a washer H and hole or opening in the shell. By this means the air is prevented from escaping when the pressure is put on the rubber pad, and this is capable of being revolved, so that the whole of the surface of the rubber may be worn away before a new one need be replaced, and this can be done without the necessity of replacing a new shell.

By the use of this combination of metal, rubber and air, I obviate [fol. 430a] the suction of the present heels of boots and shoes, and I also prevent the separation of the heel from the upper.

Having now particularly described and ascertained the nature of my said invention and in what manner the same is to be performed, I declare that what I claim is:

1. In heel pads for boots and shoes, an air-tight shell of aluminium or other suitable material having a turned-in flange combined with a pad of rubber or other elastic material having a hollow or recess in its inner side constituting an air space when in position and a retaining flange substantially as and for the purpose hereinbefore described and illustrated on the accompanying sheet of drawings.

2. In heel pads for boots and shoes the general arrangement and combination of parts substantially as and for the purpose hereinbefore described and illustrated on the accompanying sheet of drawings.

A.D. 1906. April 5. No. 8205.
CAIRNS' Complete Specification

(2nd Edition)

[This Drawing is a reproduction of the Original on a reduced scale.]

Fig 1

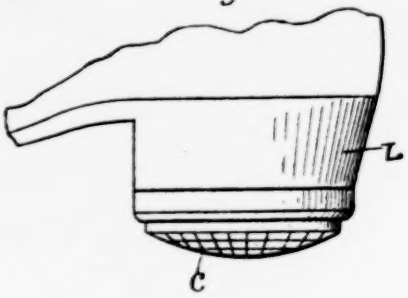
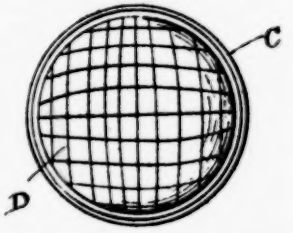


Fig 2

Fig 3.



Dated this 9th day of September, 1906.
Bottomley & Liddie, 154 St. Vincent Street, Glasgow, Chartered Patent Agents.

(Here follows diagram marked side folio page 431)

[fols. 432 & 433] CITATION—In usual form showing service on Frederick L. Emery; omitted in printing

[fol. 434] IN UNITED STATES DISTRICT COURT

CLERK'S CERTIFICATE.

UNITED STATES OF AMERICA,
District of Massachusetts, ss:

I, James S. Allen, Clerk of the District Court of the United States for the District of Massachusetts, certify that the foregoing is the transcript of the record on appeal, including true copies of such proofs, entries and papers on file as has have been designated by the parties in their præcipe, in the cause in equity entitled No. 1008, The I. T. S. Rubber Company, Plaintiff, vs. Essex Rubber Company, Defendant, in said District Court determined, together with the original Citation issued upon the appeal of the plaintiff, with the Acknowledgment of Service thereon.

In testimony whereof, I hereunto set my hand and affix the seal of said District Court, at Boston, in said District, this ninth day of June, A. D. 1923.

James S. Allen, Clerk. (Seal.)

[MEMORANDUM.—Orders of enlargement of time for docketing case to and including June 9, 1923, are here omitted. A. I. Charron, Clerk.]

[fol. 435] IN UNITED STATES DISTRICT COURT

[Title omitted]

DEPOSITION OF EDWARD D. FALES

Elyria, O., November 26, 1920.

EDWARD D. FALES, the next witness called on behalf of plaintiff, being first duly cautioned and sworn, testifies in answer to direct questions by Mr. Richey as follows:

Direct examination by Mr. Richey:

Q. 1. Please state your name, age, residence and present occupation.

A. Edward D. Fales; over twenty-one years of age; Elyria, O.; patent lawyer.

Q. 2. You are a member of the firm of Richey, Slough and Fales, and represented the plaintiff, did you not, in the following cases: The I. T. S. Rubber Company v. H. H. Hackman & Co., the same v. The Thomas Urbansky & Sons Co., in the Northern District of Ohio, [fol. 436] Eastern Division; The I. T. S. Rubber Company v. Walter Wendt and the same v. Jones & Roser, in the Eastern District of Michigan?

A. I did.

Q. 3. Do you know Thomas J. Urbansky?

A. I did.

Q. 4. What, if any, relation did he have to any of the above-named suits?

A. He appeared before the special master in the matter of accounting in The I. T. S. v. Urbansky suit. He also entered into certain stipulations in that suit.

Q. 5. State whether or not you had any conversation with him with regard to who was conducting and contributing to that suit.

A. Yes, I did.

Q. 6. How many?

A. At least two.

Q. 7. When and where did the first one take place?

A. The first conversation took place in Cleveland, O., on June 23, 1920, at the Federal Building.

Q. 8. Who was present at this conversation?

A. Just Mr. Urbansky and myself.

Q. 9. Now what was said by you and what was said by Mr. Urbansky, giving the exact words, if you can, and if not, the substance of the conversation?

A. Mr. Urbansky opened up the conversation by referring to the I. T. S. Rubber Co. and the Essex Rubber Company and the pending suits, and made some indication that he would be glad when things were settled, and then, as a matter of interest in connection with the case, I asked him what the Essex Rubber Co. was doing with regard to the suit, and he told me that he had had some correspondence with them, and that they had agreed to hold his company free from any losses or expenses incidental to the suit; furthermore, that he was conducting the case subject to their directions and suggestions, and that he was doing nothing otherwise.

Q. 10. When and where did the second conversation take place?

A. Shortly after that we met again in Cleveland and talked about the suit in general, talked about Mr. Tufford and about The I. T. S. Rubber Company.

Q. 11. What, if anything, was said by you to anybody connected with The I. T. S. Rubber Company concerning what Mr. Urbansky [fol. 437] had told you about the Essex Rubber Company contributing to and conducting the litigation?

A. Well, I immediately upon arriving in Elyria communicated this information obtained as a result of the first conversation with Mr. Urbansky to F. O. Richey, and the next day I informed, ac-

cording to my present recollection, Mr. Tufford, as well as Messrs. Smith and Ingwer. I am not certain whether this was communicated to Messrs. Tufford, Smith and Ingwer on the same day, or not, but it was shortly after I mentioned it to Mr. Richey. This was before my second conference with Urbansky, which was before June 30, 1920.

Q. 12. Did you have any conversation with anybody connected with the defense in either the Wendt or the Jones & Roser cases regarding who was conducting and contributing to the defense in these cases?

A. Yes.

Q. 13. With whom?

A. I had a talk with Mr. Walter Wendt and Mr. Edward G. Kemp, both of Detroit.

Q. 14. What was Mr. Kemp's occupation in connection with these suits?

A. He appeared in both of these suits in behalf of the defendants.

Q. 15. How many such conversations did you have with Mr. Kemp?

A. I may have had two or more, but the one that distinctly stands out in my mind is the first one, which conversation took place on or about July 21, 1920.

Q. 16. Will you state the exact words of this conversation, if you can, and if not, the substance?

A. Among other things, while talking with Mr. Kemp, he told me that he was representing the Essex Rubber Co. of New Jersey, who had requested his firm to act for them in the Walter Wendt suit [referring to the suit of The I. T. S. Rubber Co. v. Walter Wendt & Company.]

Q. 17. To whom, if anybody, connected with The I. T. S. Rubber Company, did you repeat the substance of what Mr. Kemp had told you with regard to his representing the Essex Rubber Company in the Wendt suit?

A. I told Mr. F. O. Richey as soon as I returned from Detroit, which was the very next day after the conversation, and within the [fol. 438] next week or two the matter was discussed generally in Mr. Richey's office with Mr. Tufford of The I. T. S. Rubber Company and others.

Q. 18. How many conversations did you have with Wendt on this subject?

A. I talked with Mr. Wendt on two occasions about this matter and on this subject.

Q. 19. When and where the first time?

A. The first time was on September 13, 1920, at Mr. Wendt's house in Detroit.

Q. 20. Now, what was said, in words, if you remember, and if not, in substance, by you and Mr. Wendt?

A. He told me that as soon as the suit was started he took the matter up with the Essex Rubber Company of New Jersey, who agreed to hold him harmless and to pay all costs and expenses; that the Essex Rubber Company told him to let the case go by default.

He further said that the Essex people authorized him and Mr. Edward G. Kemp to settle with The I. T. S. Rubber Company for $1,000, in lieu of profits and damages.

Q. 21. When and where did the second conversation take place?

A. The second conversation took place a few days ago, also in Detroit, and at his house.

Q. 22. What was said by Mr. Wendt and by you in this conversation, in words, if you can remember, and if not, in substance?

A. It was pretty much a repetition of what we had discussed before, except that at this time he showed me one of the letters from the Essex Rubber Company, corroborating some of the things he had stated to me on the previous visit.

Q. 23. To whom, if anybody, connected with The I. T. S. Rubber Company did you repeat what Mr. Wendt had said in the first conversation?

A. I repeated this conversation with Mr. Wendt, which took place on September 13th, the day after to Mr. F. O. Richey in Elyria, Ohio. I also told Mr. Arthur G. Smith, of The I. T. S. Rubber Co., within a week or so after that.

Q. 24. Did you have any conversations with anyone in the Hackman firm with regard to who was maintaining the defense of the Hackman suit?

A. Yes, I did.

Q. 25. Who was present?

A. Mr. H. H. Hackman, Mr. Arthur G. Smith and Mr. Baker of the firm of H. H. Hackman & Co.

[fol. 439] Q. 26. When and where did this conversation take place?

A. At the store of H. H. Hackman & Company, about a block from the Hotel Cleveland, before the final decree was entered in that case.

Q. 27. And what was said at this conversation, in words if you can remember, and if not, in substance?

A. I was told that when The I. T. S. Rubber Company brought suit against H. H. Hackman & Company they notified the Essex Rubber Co. and were assured against any losses by the Essex Rubber Company in connection with that suit.

Q. 28. Who said that?

A. Mr. H. H. Hackman.

Q. 29. What, if any, relation does Arthur G. Smith have to The I. T. S. Rubber Company?

A. He is vice-president.

[Adjourned until tomorrow morning at 10 a. m.]

Elyria, O., November 27, 1920.

[Met pursuant to adjournment.
Present: Same as before.]

Q. 30. I call your attention to Plaintiff's Exhibit No. 6, Wendt Heels, and Plaintiff's Exhibit No. 7, Jones & Roser Heels, and ask you to state when you first saw these two exhibits?

A. On or about July 21, 1920.

Q. 31. Where and under what circumstances did you see them at that time?

A. I went to the office of Campbell, Bulkley & Ledyard, in Detroit, Michigan, and asked Mr. Wilson W. Mills for the exhibits in the Walter Wendt and Jones & Roser suits, about which I have previously testified. He handed me all of the exhibits in these two suits, among which were these exhibits which you have handed me.

Q. 32. Where have these exhibits been since?

A. They have been in my possession ever since.

Q. 33. Have you made any use of these exhibits?

A. Yes, I made use of these exhibits in connection with the Walter Wendt and Jones & Roser suits. I took them to court and they were examined by Mr. Edward G. Kemp and by Mr. Walter Wendt. These exhibits were used in those causes as Plaintiff's Exhibits [fol. 440] Defendant's Heels, as indicated by the ink stamp on the back of the tags.

By Mr. Richey: The witness will be produced for further examination, if defendant's counsel desires, on Wednesday, the 1st of December.

Edward D. Fales.

IN UNITED STATES DISTRICT COURT

NOTICE OF TAKING TESTIMONY

Mr. Lucius Varney, c/o Emery, Varney, Blair & Hoguet, 149 Broadway, New York City, N. Y.

DEAR SIR: Will you please take notice that on Monday, November 22, 1920, beginning at 10 a. m., at Detroit, Michigan, we shall proceed to take the testimony of Walter Wendt, of 911 Canton Avenue, Detroit, Michigan; Edward Kemp, of 2104-2112 Dime Bank Building, Detroit, Michigan; W. W. Wicker, of 620 Moffat Building, Detroit, Michigan; Richard S. Jones and Edward J. Roser of 128 Gratiot Avenue, Detroit, Michigan, and perhaps others, whose names and addresses we do not now know, but of which we will advise you as soon as we learn the same, on behalf of the above-named plaintiff, before John Doe, a notary public, or other qualified officer, who is not of counsel nor interested in this cause, at the office of Campbell, Bulkley & Ledyard, Union Trust Building, Detroit, Michigan, and thereafter from day to day, as the taking of the depositions may be adjourned.

Also please take notice that as soon as we are through with the depositions in Detroit, we will adjourn to Cleveland, Ohio, and shall there proceed to take the testimony of Thomas J. Urbansky, of 2364 Ontario Street, Cleveland, Ohio, and H. H. Hackman, Jr., of 1540 West Third Street, Cleveland, Ohio, and perhaps others, whose names and addresses we do not now know, but of which we will advise you as soon as we learn the same, on behalf of the above-named plaintiff, before John Doe, a notary public, or other qualified officer,

who is not of counsel nor interested in the cause, at the office of Joseph L. Wright, 704 Ulmer Building, Cleveland, Ohio, and thereafter from day to day, as the taking of the depositions may be adjourned.

[fol. 441] Also, please take notice that as soon as we are through with the depositions in Cleveland, Ohio, we will adjourn to Elyria, Ohio, and shall proceed there to take the testimony of Carl H. Ingwer and Arthur G. Smith, whose address is care The I. T. S. Rubber Company, Elyria, Ohio, Joseph Tufford of 221 Fifth Street, Elyria, Ohio, and Edward D. Fales, of 1000 Lorain County Bank Building, Elyria, Ohio, and perhaps others whose names and addresses we do not now know, but of which we will advise you as soon as we learn the same, on behalf of the above-named plaintiff, before John Doe, a notary public, or other qualified officer, who is not of counsel nor interested in the cause, at the office of Richey, Slough & Fales, No. 1000 Lorain County Bank Building, Elyria, Ohio, and thereafter from day to day as the taking of the depositions may be adjourned.

The witnesses above named each live at more than 100 miles from the place of trial herein, and more than 100 miles from any place at which a District Court of the United States for the District of Massachusetts is appointed to be held by law, and their testimony is for use at final hearing on behalf of plaintiff in the cause herein, and such testimony will be taken de bene esse under the Acts of Congress, in accordance with the provisions of sections 863, 864 and 865 of the Revised Statutes of the United States and the Rules of Equity.

You are invited to attend and cross-examine.

F. O. Richey, of Counsel for Plaintiff.

Elyria, Ohio, November 16, 1920.

Service of the above notice accepted this — day of November, 1920.

—— ——, Counsel for Defendant.

[fol. 442] IN UNITED STATES DISTRICT COURT

Testimony taken in behalf of the plaintiff, The I. T. S. Rubber Company, de bene esse, under the Acts of Congress and the rules of equity, pursuant to the annexed notice, at the office of Campbell, Bulkley and Ledyard, Union Trust Building, Detroit, Michigan, beginning at 10 a. m., November 22, 1920, before Margaret S. Shields, a notary public in and for Wayne County, Michigan.

Present: Manvel Whittemore, Esq., for the Defendant; E. D. Fales, Esq., for the Plaintiff.

ARGUMENT OF COUNSEL.

By Mr. Whittemore: In view of the plaintiff's notice of taking depositions, defendant now gives notice that at final hearing it will concede that plaintiff has title to the Letters Patent in suit, and that

said Letters Patent are valid. Defendant makes this concession for the purpose of notifying plaintiff that it will be unnecessary to take any proofs directed to these issues.

By Mr. Fales: I wish to take occasion to serve opposing counsel with notice that the plaintiff proposes to produce as witnesses here in Detroit, in addition to the parties whose names and addresses are contained in the notice, the following parties, to wit: C. M. Willits, whose post office address is 600 Union Trust Building, and Wilson W. Mills, of the same address.

By Mr. Whittemore: It is agreed, in view of the short notice, that defendant, if it desires, may recall these two witnesses for cross-examination at some later date, not later than December 1st.

DEPOSITION OF RICHARD S. JONES

The witness, being first duly sworn, testified as follows:

Direct examination by Mr. Fales:

Q. 1. Mr. Jones, will you please give your name, age, residence and occupation?

A. Richard S. Jones; business address, 128 Gratiot Avenue; name of firm, leather findings, Jones and Roser.

Q. 2. Mr. Jones, have you been subpœnaed to testify in this case?

A. Yes, sir.

[fol. 443] Q. 3. I believe that it was necessary to subpœna you because you did not feel inclined to testify otherwise?

A. Yes, sir.

Q. 4. Was your firm, that is, Jones and Roser, defendants in the suit recently settled in this city between the I. T. S. Rubber Company and Jones and Roser?

A. I believe they were.

Q. 5. Before the commencement of the suit last referred to, you were notified by the I. T. S. Rubber Company that you were infringing, were you not?

A. Yes, sir.

Q. 6. Will you please be kind enough to make a statement of every step that you took as the result of the notice and as the result of the investigation of the suit against Jones & Roser above referred to? Give all the details that you can, and if you had any relations with other parties, what these relations were, and all facts within your personal knowledge that will enable the court to understand the conditions?

A. The only—what I had reference to is—I believe I haven't got the letters with me. I believe I did get a letter to the effect—from the I. T. S. to that effect, but I had a little conversation with Mr. Tucker over the 'phone as he was passing through Detroit, saying that he would protect us in the sale of the heel, and after that Mr. Wicker took ahold of it; and that is all I know of it. I could say

this: after Mr. Wicker got in contact with the Essex, Mr. Wicker told us to take the heels off of our shelves. We did so. That is all I have got to say.

Q. 7. Where are the letters to which you refer?

A. I think Mr. Wicker has them.

Q. 8. Would you recognize these letters if you were to see them?

A. I believe I would.

Q. 9. Did you deal directly with the Essex Rubber Company?

A. Yes, and we have also—Mr. Wendt has been their agent here. I did business with Mr. Wendt also.

Q. 10. Did any transactions take place between you and Mr. Wendt when you received notice from the I. T. S. Rubber Company?

A. Did any correspondence pass between you and Mr. Wendt either way?

A. No.

[fol. 444] Q. 11. You are absolutely certain of this?

A. I don't remember. I am not sure.

Q. 12. Who would know the facts as to whether you wrote to Mr. Wendt before you wrote to the Essex Company or not?

A. We got notice of it—we turned it over to Mr. Wicker.

Q. 13. Would it not be possible for you to get in touch with Mr. Wicker over the telephone and have him give you any correspondence that may have taken place between you and Mr. Wendt and you and the Essex Rubber Company? I believe that Mr. Wicker is just across the way and it would not take very long.

A. I would rather have Mr. Wicker take it up himself.

Q. 14. I suppose you understand that there are certain things that Mr. Wicker cannot do for you. Mr. Wicker, of course cannot testify for you, as to facts within your own knowledge. You are required to testify to these.

Mr. Whittemore: This line of examination is objected to. Witness has said first that there was no correspondence, and then that he is not sure whether there was or was not any correspondence; and has, therefore, given a full, truthful answer to the questions asked him.

Q. 15. I don't suppose that you would refuse to produce the correspondence, if there is any?

A. No.

Q. 16. Will you be kind enough to get in touch with Mr. Wicker over the telephone and if he has any correspondence along the line that I have inquired, I will be glad to send a messenger over for you if he will send it to you. It will only take ten or fifteen minutes.

A. Yes.

[Fifteen minutes recess.]

Q. 17. Mr. Jones, have you been able to locate any correspondence?

A. Here is a letter. I don't know whether you have the copy of this letter or not; I am not sure. You might have it. It is a copy of a letter we wrote to Wendt.

Q. 18. Who dictated this letter?

A. W. W. Wicker.

Q. 19. What are the initials "R S J/K" at the bottom of the letter?

A. Wicker dictated the letter and I signed it.

[fol. 445] Q. 20. Did you get a reply to this letter?

A. I got a reply and I guess you have it there.

Q. 21. Is this the letter to which you refer?

A. I believe that is the letter. Yes, sir.

Mr. Fales: The letter produced by the witness to Wendt & Company is handed to the notary, who is requested to mark the same for identification with the title of this cause and "Plaintiff's Exhibit No. 1."

[The letter referred to by the witness as a reply is offered in evidence and the notary is requested to mark the same with the title of this cause and "Plaintiff's Exhibit Jones Letter No. 2."]

Q. 22. You did not state whose initials "R S J" are in Plaintiff's Exhibit No. 1.

A. Why R S J—this was dictated by Mr. Wicker and Mr. Klokow is K. He is the bookkeeper. He wrote this and I signed it R S J—Richard S. Jones, but it was dictated by Mr. Wicker.

Q. 23. You read it before you signed it?

A. Yes, sir.

Q. 24. You intended this to be your own letter?

A. Yes, sir.

Q. 25. Do you know what the date of that letter is?

A. December 29.

Q. 26. What year?

A. 1919.

Q. 27. Referring to the Plaintiff's Exhibit No. 2, I notice that the first paragraph starts out: "Your letter of December 29 has been referred to us." Do you know what letter of December 29 that refers to?

A. That letter there.

Q. 28. Do you mean Plaintiff's Exhibit No. 1?

A. Yes, sir.

Q. 29. You have referred to Mr. Tucker. Who is Mr. Tucker?

A. Gentleman over there.

By Mr. Fales: Mr. Tucker's presense is noted of record.

Q. 30. Do you know what Mr. Tucker's initials are?

A. Couldn't say right now.

Q. 31. Who is Mr. Tucker and with whom is he associated, if you know?

A. The Essex Rubber Company.

Q. 32. In what capacity has he represented himself to you?

A. Why, I believe he is sales manager. I don't know whether I am right. I think Mr. Tucker is.

[fol. 446] Q. 33. Will you please state exactly what the conversation was between Mr. Tucker and yourself here? I refer to the con-

versation over the telephone. I would like you to repeat the conversation word for word if you can, if not, as well as you remember it.

A. Only a few—just a brief conversation. Mr. Tucker was passing through Detroit and he called up on the 'phone in regards to the heel and says to go ahead, he says, and we'll protect you on it. I believe that is about all Mr. Tucker said.

Q. 34. Was any reference made to—made between the I. T. S. Rubber Company and Jones and Roser?

A. I don't just understand you.

Q. 35. How did Mr. Tucker come to call you up, if you know? Why did he call you up?

A. Why, in regards to this suit.

Q. 36. You mean to imply, then, that the Essex Rubber Company had been notified?

A. We were notified by the I. T. S. in regards to selling the Essex heel.

Q. 37. In what way was the Essex Company notified?

A. I don't just remember.

Q. 38 Do you know whether any telegrams or correspondence or telephone messages apprized the Essex Rubber Company of the suit?

A. Why, Mr. Wicker took care of all that.

Q. 39. I hand you certain papers and ask you if you were ever aware of the contents of those papers?

A. I don't remember anything at all. Mr. Wicker took care of everything after I turned them over to him. I had no correspondence myself to my knowledge with the Essex. Mr. Wicker took care of all of that.

Q. 40. Did Mr. Wicker have authority to sign the name of Jones and Roser to communications with the Essex Company?

A. Why, he is administrator of the estate of Mrs. Roser.

Q. 41. But you haven't answered my question just as fully as I would like. Did Mr. Wicker have authority to communicate with the Essex Rubber Company and sign the name of Jones and Roser?

A. I don't know if he has the authority. I presume it was probably signed because he sent the telegram on behalf of Jones and Roser.

Q. 42. You have stated in your testimony thus far, that Mr. [fol. 447] Wicker had charge of certain of these things, or words to that effect. Did he have charge of these things with your approval?

A. Yes, sir.

Q. 43. Did you have any attorney to represent you in the early stages of the Jones & Roser suit?

A. Mr. Wicker has always been our attorney. For 15 years.

Q. 44. Did he or did he not have full powers to act in your behalf?

A. Yes, sir.

Q. 45. Do you know whether or not Mr. Wicker handled the Jones & Roser suit in behalf of the defendant, that is, in behalf of Jones & Roser, from start to finish?

A. Yes, sir.

Q. 46. Did anyone else have anything to do with the case?
A. No, sir.
Q. 47. Why did you let the case go by default?
A. Never knew it went by default.
Q. 48. Don't you know that judgment was rendered against Jones & Roser for $200 in this case?
A. Never knew anything at all about it.
Q. 49. Who is in possession of all the facts?
A. Mr. Wicker.
Q. 50. What did you do with this letter Plaintiff's Exhibit No. 2 when you got it?
A. Took it to Mr. Wicker.
Q. 51. With what instructions?
A. He was handling the case.
Q. 52. Did you intend that he should rely upon this letter?
A. Mr. Wicker?
Q. 53. Yes.
A. For him to look after our interests.
Q. 54. Who is Walter Wendt?
A. He is distributor for the Essex Rubber Company.
Q. 55. You mean in this locality?
A. Yes, sir.
Q. 56. When you had your conversation with Mr. Tucker, did you communicate the matter to Mr. Wicker, or not?
A. I think I did.
Q. 57. Why did you do this?
A. For our own protection.
Q. 58. Did you or did you not rely on what Mr. Tucker said?
A. We did until Mr. Wicker took it up and when Mr. Wicker got in communication with the Essex, Mr. Wicker told us not to sell [fol. 448] any more heels, so we took them off of our shelves and boxed them up and discontinued the sale of them entirely.
Q. 59. Did you ever have any dealings with the firm of Angell and Turner here in Detroit, lawyers?
A. Not to my knowledge no, sir.
Q. 60. Do you know Mr. Kemp who is associated with that firm?
A. No, sir. Introduced to him this morning outside here.
Q. 61. Did you communicate with anyone else from the Essex Rubber Company other than Mr. Tucker?
A. Outside of one letter to Mr. Wendt.
Q. 62. Did you have any personal dealings or conversation with any other members of the Essex Rubber Company besides Mr. Wendt and Mr. Tucker?
A. No, sir.
Q. 63. You are still dealing with the Essex Rubber Company?
A. We have up until recently. That is handling their whole heels.
Q. 64. You say until recently you are still dealing with them?
A. Still selling heels. We have some in stock.
Q. 65. You are still dealing with Mr. Wendt, I suppose?
A. Why, we have been buying from Mr. Wendt.

Q. 66. He is still the representative of the Essex Rubber Company here?
A. Yes, sir.

[Direct examination closed.]

By Mr. Whittemore: The entire deposition of the witness is objected to as immaterial and irrelevant and not relating to any issue pleaded in the above-entitled cause.

[No cross-examination.
Deposition closed.]

Richard S. Jones.

Deposition of Walter Wendt

Walter Wendt, a witness produced in behalf of the plaintiff, after being sworn, testified as follows:

Direct examination by Mr. Fales:

Q. 1. Will you please give your name, age, residence and occupation?
A. Walter Wendt; thirty-two years of age; 911 Canton Avenue; jobber of rubber heels.
[fol. 449] Q. 2. Are you the Walter Wendt, defendant in this district, in the suit entitled I. T. S. Rubber Company against Walter Wendt?
A. Yes.
Q. 3. Before the suit last referred to was instituted, were you notified of the infringement by the I. T. S. Rubber Company?
A. No, sir.
Q. 4. When did you first learn about the contemplated suit or the suit itself?
A. When I was served with a subpœna to appear in the case.
Q. 5. As soon as you were served with a subpœna what step did you take?
A. I notified the Essex Rubber Company of the fact.
Q. 6. How much correspondence, or how many communications took place between you and the Essex Rubber Company with regard to this suit, or to the contemplated suit?
A. Well, that is hard to say, Mr. Fales. I have no way of telling absolutely.
Q. 7. Where do you keep the correspondence—at home?
A. Yes, sir.
Q. 8. It wouldn't be very difficult for you to produce all the correspondence, would it?
A. It wouldn't be difficult, but it would take time to go through the mass of other correspondence and sift it out.
Q. 9. Were all the communications in the form of letters, or in the form of telegrams, or in what form?

A. The suit was referred to in one telegram that I had from Mr. Tucker, in which he said he would see me on a certain day regarding request of guarantee. I do not remember that I had any other telegrams; I think the remainder of the communications were in letter form.

Q. 10. Did you finally communicate with Mr. Tucker?

A. I don't understand. Did I finally communicate with him? Well, I communicated with the Essex Rubber Company; Mr. Tucker, of course, is of that company.

Q. 11. Did you see Mr. Tucker with regard to the guarantee?

A. Yes.

Q. 12. Do you recall the date when you saw him?

A. I do not.

Q. 13. About how long—roughly—after you were served with [fol. 450] the subpœna to which you referred?

A. About how long after that did I see Mr. Tucker?

Q. 14. Yes.

A. It may have been three weeks; I am not certain; two or three weeks.

Q. 15. Will you please state for the benefit of the court what the conversation was between Mr. Tucker and yourself?

A. As I recall it, Mr. Tucker stated that he would guarantee me against any expenses I might be put to through the fact that the I. T. S. Rubber Company instituted suit against me; that was the gist of the conversation.

Q. 16. Who were the first lawyers you got in touch with?

A. I went to see Mr. Fox, of Welsh, Bebout & Kahn.

Q. 17. What was the result of that meeting?

A. Mr. Fox advised me that the papers as served on me contained a prayer for damages, and he advised me to get a guaranty from the Essex Rubber Company to protect me against any costs I might be put to.

Q. 18. Did you retain this firm, or any of its members, during the pendency of the suit against you?

A. The firm of Welsh, Bebout & Kahn you refer to?

Q. 19. Yes.

A. Mr. Fox passed upon the sufficiency of the guaranty which the Essex Rubber Company gave me; that was all the work they did.

Q. 20. Who conducted the correspondence with the Essex Rubber Company people relative to the guaranty, you or Mr. Fox?

A. I did.

Q. 21. How long did it take you to arrive at a satisfactory understanding with the Essex people?

A. Regarding the guarantee?

Q. 22. Regarding the guarantee.

A. Why, it was done probably in a week or ten days after I saw Mr. Fox.

Q. 23. How many letters passed back and forth?

A. I do not know that more than one or two passed referring to that particular phase of it.

Q. 24. Did you have any telegrams?

A. Merely the one referred to previously.

Q. 25. After seeing Mr. Fox did you have any dealings with any other lawyers?

[fol. 451] A. After seeing Mr. Fox I had a telephone call from Angell & Turner's office; I think it was Mr. Angell that called and asked me to come and see them regarding the suit.

Q. 26. Was this before or after you got your guarantee?

A. I can't say that, Mr. Fales.

Q. 27. Did you discuss the question of the guaranty with Mr. Turner or any of the members of that firm?

A. Yes, with Mr. Angell.

Q. 28. What was the nature of the conversation between you and Mr. Angell?

A. Mr. Angell told me that he had a telephone conversation—a telephone call from I think Mr. Varney's office in New York, and that he had been requested to see me and get the different angles of the situation here and see whether I would agree to a continuance of the matter, so that they could determine the type of heels which were in this exhibit in the case. We discussed the different angles of that, and then he tried to learn from me as to how much I might be involved in the matter if the suit went against me, and what the possible amount of damages might be, etc. He impressed me as taking a different sort of interest in the case than Mr. Fox did when I was in his office.

Q. 29. Was the extension taken?

A. Yes. Mr. Angell secured a continuation of the suit.

Q. 30. Who else, if anyone, took a hand in the suit besides Mr. Angell?

A. Mr. Kemp of his office.

Q. 31. Do you know Mr. Kemp's initials?

A. Edward G.

Q. 32. Is he of the firm of Angell & Turner?

A. Yes, sir.

Q. 33. What transpired between you and Mr. Kemp the first time you met him?

A. I can't say exactly about the first time, but I recall that one time, after Judge Angell told me he would turn over the matter, if I decided to leave it with them, into Mr. Kemp's hands, I had quite a lengthy discussion of the case with Mr. Kemp. I tried to enlighten him on the nature, or rather the type of the heel which was described in the papers which were served on me; and I went down to a shoe repair shop on Lafayette Street and purchased some I. T. S. heels and brought them back to his office and showed him the dif-[fol. 452] ference between the I. T. S. heel as described in that paper which was served on me and the type of heel I was selling.

Q. 34. Whom did you understand Angell & Turner, including Mr. Kemp, were representing?

A. Representing me.

Q. 35. And who else?

A. I did not understand they were representing anyone outside of myself.

Q. 36. You have stated that Judge Angell first got in communication with you and asked you to call at his office; in whose behalf was the judge talking or was the judge acting?

A. He told me that he was called by Mr. Varney's office on the telephone and told to get in touch with me regarding the case.

Q. 37. Do you know anything about that letter [handing witness a letter]?

A. Yes.

Q. 38. What do you know about this letter; from whom did it come and to whom was it written?

A. It came from the Essex Rubber Company and was written to Wendt & Co., which is myself.

Q. 39. What is the date of the letter?

A. April 10, 1920.

Q. 40. Who is it signed by?

A. It is signed by the Essex Rubber Company, C. C. Tucker, sales manager, shoe findings department.

Q. 41. Is the Mr. Tucker referred to in that letter the Mr. Tucker whom we have present here?

A. Yes, sir.

Mr. Fales: The letter identified by the witness is offered in evidence; the notary is requested to mark the same with the title of this case and "Plaintiff's Exhibit 3."

Q. 42. Who paid the firm of Angell & Turner?

A. I did.

Q. 43. And finally who?

A. The Essex Rubber Company.

Q. 44. Who paid the judgment in the I. T. S. suit against Walter Wendt?

A. I did.

Q. 45. And finally who?

A. Essex Rubber Company.

Q. 46. I suppose that you are familiar with the suit of I. T. S. Rubber Company against Jones & Roser?

A. Yes, sir.

Q. 47. There was a judgment of $200 in that case. Who paid that?

A. Mr. Kemp called me up and asked me whether, to facilitate [fol. 453] matters, I would pay that, advance the $200 and charge it to the Essex Rubber Company, with whom I have an account. I told him I would do so, and sent him a check for $200.

Q. 48. So that finally who pays the judgment?

A. The Exssex Rubber Company.

Q. 49. Who represented you during the suit, Mr. Angell or Mr. Kemp?

A. Well, it was in Angell & Turner's office, but Mr. Angell had nothing to do with it, as I understand it, after I laid the case fully before Mr. Kemp and explained the different phases to him as I did on the day on which I went out and bought that pair of heels and explained the different angles to him.

Q. 50. Who entered into the stipulation for the extension of time, and who signed the stipulation with regard to profits of $1,000?

A. I do not know.

Q. 51. There was no effort to keep the matter secret that the Essex Rubber Company were being represented by Angell & Turner and by Mr. Kemp, was there?

A. I do not know that they were representing the Essex Rubber Company.

Q. 52. Did or did not Mr. Kemp ever tell you what his relation was to the Essex Rubber Company?

Mr. Whittemore: I object to the question as calling for hearsay evidence; and I understand Mr. Kemp is to be called as a witness.

A. No, he never told me that he was—he never said that he had any relations with the Essex Rubber Company.

Q. 53. Do you mean to have the court understand or believe that Mr. Kemp and Angell & Turner were not acting for the Essex Rubber Company in any way?

A. They were acting for me, which is proven by the fact that the first time I went up to Mr. Angell's office he put it entirely up to me as to whether or not I would accede to the request of Mr. Varney's office that the case be continued; he asked me whether that was agreeable to me and went into the different angles of it, as to why it would be agreeable or would not be agreeable, and the possible amount of the damages, in case the thing went on and no defense was made. The heels that were in the suit were purchased from me, but I did not know what type of heels they were or anything else; [fol. 454] and they requested delay so that they could have an opportunity to examine them, which I believe Mr. Whittemore later did. Also later, I might add, that I went into great detail with Mr. Kemp; after Mr. Angell turned the matter over to Mr. Kemp for his handling, I went into great detail with him about the difference between the different types of heel.

Q. 54. But you have not squarely answered my question. Will the notary please read it again?

Mr. Whittemore: I object to the statement of Mr. Fales. The answer was a full and fair statement of the fact and the situation so far as the witness knows them. What inference may be drawn from the facts the witness is not required to say.

Mr. Fales: The question is withdrawn in its present form.

Q. 55. Do you wish to have the court believe that they were acting for the Essex Rubber Company also?

A. That is a broad question. I can't say whether they had any relations or not—they had not any to my knowledge.

Q. 56. You are still in the shoe findings business in this district, are you not?

A. Please qualify that. I do not sell shoe findings in general,—just rubber heels.

Q. 57. Yes, I will restrict my question to rubber heels?

A. My answer is "yes".

Q. 58. Are you still a district representative for the Essex Rubber Company?

A. I am a jobber of the heels manufactured by them. I am not a district representative in any sense of the word.

Q. 59. Do you recall whether it was before or after that date of Plaintiff's Exhibit No. 3—April 10, 1920—that you received the guaranty in its final form from the Essex Company?

A. I believe it was after that date.

Q. 60. During the pendency of your suit with the I. T. S. Rubber Company, did you have any correspondence with any of the members of the firm of Angell & Turner?

A. I do not think I did. I think all business was transacted either in their office or over the telephone.

Q. 61. How often did you consult with Mr. Kemp?

A. Do you want me to try to enumerate the entire number of times?

[fol. 455] Q. 62. Roughly—on an average during the pendency of your suit?

A. Possibly a dozen or a little more.

Q. 63. Do you recall any of these consultations in particular?

A. None of them were of long duration, except the one in which I explained, as I stated previously, the difference between the different type of heels. After that I think probably the next in length was the one in which I consulted with him about the amount of heels that I had sold which were claimed to infringe and the possible offer that would be made to the I. T. S. Rubber Company in settlement of that claim.

Q. 64. How amny of these intercourses were originated by you, if any?

A. I can't say as to that. I know that the first one in which I explained about the heels, I went in to Mr. Kemp, because Judge Angell told me he would turn the matter over to him, if I decided to leave the matter with them. Mr. Kemp was out of town, and then later, when the question of damages came up, I think I initiated most of the conferences because I was concerned in having the thing settled, and getting it off my mind.

Q. 65. During the course of these conversations was the Essex Rubber Company ever mentioned?

A. Well, that is a broad question. I may have mentioned about the Essex Rubber Company manufacturing different types of heels or some such thing, because I had not only the old type of heel, but the heel which I am selling at the present time, in Mr. Kemp's office and was explaining about the differences; and it is entirely possible that I mentioned the name of the Essex Rubber Company.

Q. 66. Mr. Wendt, will you please look through your correspondence and produce all papers relating to the matter wherein the Essex Rubber Company agreed to assume the responsibility of which you have testified and regarding which you have stated

some correspondence passed which was handled during the time that you were consulting with Mr. Fox and any other correspondence that in any way refers to the suit between the I. T. S. Rubber Company and yourself and the I. T. S. Rubber Company and Jones & Roser?

A. I desire to consult my attorney, Mr. Kemp, regarding this matter.

[fol. 456] [Mr. Wendt excused to consult his attorney.

Recess for luncheon.]

[Deposition of Walter Wendt, continued.]

Q. 67. Mr. Wendt, have you consulted with Mr. Kemp, and what has been the result?

A. I consulted Mr. Kemp and he told me that the best thing to do and the quickest way for me to get out of it, which is what I was most anxious to do, was to go to my files and get the correspondence touching these matters and present them here this afternoon.

Q 68. May I see this correspondence?

A. Yes.

Q. 69. Does this correspondence contain the matter that was conducted with the Essex Company, with the assistance of Mr. Fox?

A. Mr. Fox did nothing, except ask for a formal guaranty.

[Deposition adjourned until November 23, 9 a. m.

Deposition of Walter Wendt continued from November 22, 1920.]

Q. 70. Mr. Wendt, were you subpœnaed to attend as a witness in this case or not?

A. Yes.

Q. 71. How long have you been dealing with the Essex Rubber Company?

A. Approximately six years, I think.

Q. 72. And you have been corresponding with the Essex Rubber Company back and forth during all this time?

A. Yes.

Mr. Fales: The letters produced by the witness are offered in evidence, and the notary is requested to mark the same, with the title of this cause, "Plaintiff's Exhibit No. 8, Correspondence Produced by Walter Wendt." The notary is also requested to number the pages of this lot correspondence numerically from 1 to 32, to facilitate reference to the same.

Mr. Whittemore: The introduction of this exhibit in evidence is objected to as immaterial and irrelevant.

Mr. Fales: Mr. Whittemore, will you stipulate that photo-print copies of this correspondence may be substituted for the originals, with the same force and effect, and subject, of course, to any objections that may have been interposed, or may be interposed, against the originals.

Mr. Whittemore: I see no objection to this course.

[fol. 457] Mr. Fales: There may be some difficulty in taking photo copies of some of the papers that are in blue; in the event that there is any serious difficulty, you would have no objection to having type-written copies substituted for these particular ones?

Mr. Whittemore: That is agreeable.

[No question numbered 73.]

Q. 74. Referring to this correspondence, can you state of your own knowledge whether this correspondence was sent to the parties addressed and by the parties over whose signatures they appear?

A. Yes, to the best of my knowledge.

Q. 75. All of those letters that are signed by Walter Wendt were dictated and signed by you, or not?

A. They were typed by myself.

Q. 76. Are you familiar with the signatures of the various parties appearing on the various letters on the Essex Rubber Company letter-head, or from the Essex Rubber Company?

A. I am fairly familiar with Mr. Tucker's signature.

Q. 77. What do the initials "C. C. T." stand for in this correspondence?

A. C. C. Tucker.

Q. 78. Who is Mr. C. H. Oakley, whose name appears on page 11 of this correspondence?

A. I believe that he is president of the Essex Rubber Company.

Q. 79 On page 30 there is a letter on the letter-head of Emery, Varney, Blair & Hoguet; when did you receive this letter?

A. I can't say definitely, Mr. Fales; if it was mailed on the date which it bears, very likely I received it a few days afterwards.

Q. 80. What is your belief about this, and your recollection?

A. My recollection is that I probably received it a few days after that.

Q. 81. Have you ever received any other correspondence from this firm?

A. No, sir.

Q. 82. All of the letters that were signed by Walter Wendt, or Walter Wendt & Company, and dated in this correspondence, were mailed upon that date?

A. Upon the date of the letters or the following day, unless I wrote some of the letters on a Sunday, when I would date them the day before or the day after, sometimes.

[fol. 458] Q. 83. Did any of these letters that you received which are in this group reach you later than a week after the date they bear?

A. I never paid any particular attention to the date on a letter when I received it, so I could not answer that positively.

Q. 84. What is your best recollection and impression?

A. My impression would be naturally that I got them within a week's time; but I could not make it a positive statement.

Q. 85. If the letter had been delayed any more than that, you would have taken note of it, would you not?

A. If anything was contained in the letter which was likely to attract my attention to that feature of it.

Q. 86. Are all of the facts contained within these letters signed by you true statements of fact, so far as they purport to be within your knowledge?

Mr. Whittemore: I object to the foregoing question, because there are certain to be some statements which do not constitute the best evidence of the facts referred to.

A. Yes, sir.

Q. 87. I believe you have referred to Mr. Whittemore's visit in Detroit in April, 1920; did you see Mr. Whittemore when he came at that time?

A. No.

Q. 88. In your letter of April 21, 1920, No. 14 of this series of papers, you say: "Your special delivery letter dated the 16th inst. was delivered to me at 6.30 p. m. on Monday, the 19th. That is the big reason I did not see Mr. Whittemore of your attorneys, when he was here." Do you recall what that reason was that you refer to as "the big reason"?

A. Does not the letter say it was not delivered until 6 p. m.?

Q. 89. It says that it was delivered to you at 6.30 p. m., Monday.

A. If that was on a Monday, and the special delivery letter having had over Sunday as time for delivery, I probably assumed from that it should have been delivered to me earlier in the day.

Q. 90. On the letter from the Essex Rubber Company, dated May 1st, on page 19 of the series, reference is made to your letter of April 29th, and in the second paragraph it reads "Note Mr. Kemp's latest [fol. 459] advice"; will you point out where in your letter of April 29th any mention is made of Mr. Kemp?

A. I see no mention in that letter.

Q. 91. What does that paragraph in the Essex letter mean?

A. I can't say, Mr. Fales, what that might refer to; it might refer to the matter of postponement. I cannot positively say what it might refer to.

Q. 92. Did you ever know?

A. From the original letter handed to me by Mr. Whittemore, I find a postscript written in long hand, as follows: "Mr. Kemp has reversed himself in this case, which is in line with your advice, I must stop selling on the day of the hearing."

Q. 93. This is a postscript in your own handwriting at the bottom of your letter of April 29th, on page 18 of this series of letters?

A. Yes, sir.

Q. 94. And being in long hand does not appear on the carbon which is in this series?

A. Yes.

Q. 95. In the telegram dated July 7th, on page 22 of the series, you are requested to advise "Judge Angell"; is this Judge Angell of the firm of Angell & Turner?

A. Yes, sir.

Q. 96. In the letter from the Essex Rubber Company of July 16th, on page 23 of the series, in paragraph third, I find the follow-

ing: "I believe that our attorneys have written to their legal representatives in Detroit to offer the I. T. S. Rubber Company a settlement, and I hope same can be adjusted without your having to go to the trouble of making an accounting; this accounting is the accounting that was done between yourself, Mr. Kemp and myself in your suit?

A. Yes, sir.

Q. 97. And did you see the letter which their attorneys had written to their legal representatives here referred to?

A. No.

Q. 98. Were you told about this letter at all?

A. No.

Q. 99. How did they take up this matter with you; that is, after their representatives here received this letter from their attorneys, what was the first step taken here by the reprsentatives as far as you are concerned?

A. Mr. Kemp and I continued our discussions regarding possible profits, on which we had started before I received that letter.

[fol. 460] Q. 100. Yet in your letter of July 26, 1920, I find this paragraph which reads: "I had a talk with Mr. Kemp a week ago following receipt by him of a letter from your attorney; basing our calculation of the amount of old tight-edge heels which I have sold and the cost of them to me, we figured that we would be very fortunate if they would accept the offered suggested." Does this refresh your memory about this?

A. No; I have never seen that letter.

Q. 101. Do you know whether the letter you refer to here is the letter to which the Essex Company refers in their letter of July 16th, third paragraph?

A. No, sir.

Q. 102. Referring to the Essex letter of September 27th, No. 27 of this series, they refer to your letter of the 22d, which does not appear in this series; in that letter you made a deduction evidently of $1,000, and with regard to this you say "See Mr. Tucker." What does this $1,000 refer to?

A. It refers to the damages I paid the I. T. S. Rubber Company in the suit brought against me.

Q. 103. Have you, or can you procure from Mr. Whittemore here present, a copy of this letter of the 22d referred to by the Essex Rubber Company in their letter of September 27th?

A. My recollection is that I made a notation, as you read it, on the back of the check, which bears a remittance statement, at that time. I have asked Mr. Whittemore, and he has not a copy of any letter of that date.

Mr. Fales: Mr. Whittemore, I believe you have your file here containing the original letters sent to the Essex Rubber Company by Mr. Wendt, or by Wendt & Company; may I look at these letters so as to compare them with these carbons?

Mr. Whittemore. I have with me the originals of some of the

letters of which Mr. Wendt has produced copies, and will be glad to have Mr. Fales examine them.

Q. 104. Mr. Wendt, do you think that you have given me copies of all correspondence that mentions the Jones & Roser and Wendt suits asked for in my previous question, as a result of which you produced this series of letters?

A. Yes.

[Direct examination closed.]

[fol. 461] Mr. Whittemore: The entire deposition of the witness is objected to as immaterial and irrelevant and because it does not relate to any issue pleaded herein.

Cross-examination by Mr. Whittemore:

X Q. 105. Does the letter of April 19th, signed by Mr. Oakley, express your entire agreement and understanding with reference to the suit brought against you by the I. T. S. Rubber Company?

A. Yes.

X Q. 106. Will you explain, so far as you know, the reasons why the Essex Company wished to ascertain whether the suit brought against you involved the new type of tight-edge heel?

Mr. Fales: Objected to as incompetent, irrelevant and immaterial, and not proper cross-examination.

A. I have been and am confining myself,—practically the entire conduct of my business, to the sale of Essex tight-edge heels, and was at that time selling heels of different types. The Essex Rubber Company had made and were making improvements in the tight-edge heel, which it was hoped would help the sale of them, and some of both styles were in my stock and purchased for use in the suit. As I understood it, if some of the new style heels had been in that exhibit an injunction would have been issued against me, and I would then have been permanently restrained from continuing the sale of that heel.

X Q. 107. There are, or were, several types of tight-edge heel, were there not?

A. Yes.

X Q. 108. And you are still selling one type of tight-edge heel, without any objection on the part of the I. T. S. Rubber Company, are you not?

A. Yes.

X Q. 109. Is it your understanding that the Essex Rubber Company will defend a suit involving the new type of tight-edge heel?

Mr. Fales: Objected to as irrelevant and immaterial.

A. I think I have been told that they will.

X Q. 110. Is it your understanding that the Essex Rubber Company would not defend or have anything to do with a suit involving merely the old type of tight-edge heel?

[fol. 462] Mr. Fales. The same objection and as calling for testimony in the nature of hearsay.

A. No, I understood that they would not do that.

X Q. 111. Were you reimbursed by the Essex Company for what you paid Mr. Fox?

A. Yes.

X Q. 112. Did you, in company with Mr. Kemp, meet Mr. Fales in or near the master's office, and talk with him in regard to an accounting?

A. Yes.

X Q. 113. Do you recall whether Mr. Fales asked Mr. Kemp if he could speak for Jones & Roser?

A. I won't say that the language was exactly that, but it was, do you represent Jones & Roser, or something to that general effect.

X Q. 114. And do you recall what Mr. Kemp replied?

A. I think Mr. Kemp stated: "Yes, through Mr. Wickert."

X Q. 115. Have you any business agreement with the Essex Rubber Company?

A. No, sir.

X Q. 116. You are an entirely independent jobber, are you not?

A. Yes, sir.

X Q. 117. When you spoke of having been served with a subpœna to testify, you were not unwilling to tell all that you knew in this matter, were you?

A. Do you refer to the present proceedings?

A. No, sir.

X Q. 118. Had you had a previous conference with Mr. Fales before giving your testimony?

A. I met Mr. Fales in this office a week ago yesterday.

X Q. 119. Did Mr. Fales go out to your house at any time?

A. Yes, he came out to my house with me that day.

X Q. 120. Did he suggest serving you with a subpœna, or did you ask him to?

A. That was after I had been already served. I was served with a subpœna on Saturday to appear here on Monday.

X Q. 121. How did the letter Plaintiff's Exhibit No. 3 come into Mr. Fales possession?

A. When I met Mr. Fales in this office he stated that his purpose in subpœnaing me was that he wished to show the responsibility of the Essex Rubber Company in this damage suit; and I told him [fol. 463] that I had a letter in which they guaranteed to reimburse me for damages which might be secured against me, and told him that I would get him the letter if he desired it; and I took him out to the house and found the letter and gave it to him.

[Deposition closed.]

Walter Wendt.

Deposition of Edward G. Kemp.

The next witness produced in behalf of the plaintiff, Edward G Kemp, being duly sworn, testifies as follows:

Direct examination by Mr. Fales:

Q. 1. Will you please give your name, age, residence and occupation?

A. Thirty-three years old; Detroit, Michigan; lawyer.

Q. 2. Mr. Kemp, I believe that you and I have been meeting before the special master, Mr. Sayres, in the cases of I. T. S. Rubber Company against Walter Wendt and against Jones and Roser. Is that not a fact?

A. Yes, that is true.

Q. 3. Do you recall the day when you and I first went to the master's chambers, upon which day we agreed upon the first extension of time before the master?

A. I think I can remember that. I remember we did that anyway.

Q. 4. That was on the first date set for the hearing, as I recall, for the first hearing before the master.

A. I can't swear to that, Mr. Fales. It was either the first hearing or the first adjournment.

Q. 5. I believe that in connection with the proposition of extending the time, you and I had some preliminary discussion in which the position of the Essex Rubber Company came up during the course of the conversation; is that correct?

A. Now, I can't say that it is. I can't say that, Mr. Fales. I know that we had some discussion about the postponement. It seems to me that Mr. Wendt was there and I can't remember what the other discussion was.

Q. 6. Do you recall whether or not the Essex Rubber Company was mentioned?

A. Well, I can't recall that even. I can't recall that.

Q. 7. You don't recall anything—making the statement that the [fol. 464] Essex Rubber Company had put the matter of the Walter Wendt suit in your hands?

A. No. I can't recall that. I feel pretty certain that I didn't make any such statement as that.

Q. 8. Do you recall making a statement to the effect that the Essex Rubber Company had requested you or your firm to represent them in the Walter Wendt case?

A. No. I don't believe I made such a statement.

Q. 9. Do you recall having made the statement that the matter in suit was referred to you by the Essex Rubber Company because they were desirous of protecting their patents?

A. No. I don't recall that. I should say I don't believe I made such a statement as that.

Q. 10. Do you recall having stated that the matter (that is the matter in suit) had been referred to you by the Essex Rubber Company?

A. Well, I hardly know how to answer that question. Could you make it a little more definite, Mr. Fales? What do you mean by the "matter in suit"?

Q. 11. What is your best recollection of the statement that was made?

A. Well, my recollection of statements made in our conversation is very vague. I should like to be asked a more definite question than that.

Q. 12. Did you make the statement that the case had been referred to you to take care of the interests of the Essex Company?

A. Possibly I made such a statement as that with regard to our first introduction to the case. We were asked to investigate facts and look over the bill of complaint in the first instance, to find out what the facts were, and this was before the Essex Rubber Company determined what they wanted to do about it. And if they decided that they had no interest in the case, and didn't want to defend, why that ended our relations with them. We represented them, if you call it that, up to that point.

Q. 13. As a matter of fact, a judgment was entered in the Walter Wendt suit for $1,000, which $1,000 was paid by Walter Wendt in a cheque in behalf of the I. T. S. Rubber Company?

A. Yes. That is right.

Q. 14. This $1,000 was paid when the Essex people authorized [fol. 165] you and Mr. Wendt to settle with the I. T. S. Rubber Company in lieu of profits and damages. Is this not so?

A. Well, in general it was so, because after Mr. Wendt had shown to me that the Essex Rubber Company had undertaken to pay any damages or costs that he might sustain in the dealing in these heels —and of course he couldn't make any settlement that he desired to make—in any amount, and he got the consent to settle the case for $1,000, and did so and paid over that amount.

Q. 15. Your attorneys' fees in the Walter Wendt cases were paid by whom?

A. By Wendt.

Q. 16. And, finally, who was responsible for those fees, if you know?

A. Well, I don't know.

Q. 17. Do you mean that all cheques that your firm had received for services have come through Walter Wendt?

A. Yes. They have come from him. He has paid us and we carried him on our books as our client and have billed him.

Q. 18. In the first instance, who approached you about this case?

A. Well, in the first instance, Judge Angell of our office came to me with the information that he had a telephone call from New York that this case had been started and asking us to get a copy of the bill of complaint, look into the facts and get a postponement of the hearing on the order to show cause; to get in touch also with Wendt, who would want representation—to get in touch with Wendt anyway and investigate the facts from him, and we did so.

Q. 19. Did you get the postponement?

A. Well, the postponement was made. I don't remember whether we got it or whether Mr. Mills requested that it be done. It was agreeable anyhow.

Q. 20. What further communications did you have with the Essex Rubber Company or any of their representatives—that is, your firm?

A. Well, we waited until they should report to us what they wanted to do about this case after they had seen the exhibits which were submitted, and then after an examination of the exhibits we were informed that the Essex Company would not defend the case at all. And thereafter we represented Walter Wendt—the next [fol. 466] thing I heard of it was this order for accounting, and Walter Wendt came in to see us about it.

Q. 21. Who paid for the first services that were performed as a result of the first communication with Judge Angell?

A. Wendt paid everything.

Q. 22. Do you recall making any representations to any of the members of the firm of Campbell, Bulkley and Ledyard with regard to your relations to the Essex people?

A. No. I don't remember any conversation at all except from time to time when conversation arose as to the postponement of hearings and postponement of hearing on the order for an accounting.

Q. 23. Do you know Mr. C. M. Willits of the above firm?

A. Yes.

Q. 24. Do you recall making the statement to him that the matter—meaning the case—was referred to you by the Essex Company?

A. I don't recall that, but I may have made such a statement, because the fact was that it came to us as I described to you in the first place before we knew Mr. Wendt.

Q. 25. Can you give a short statement of the position of your firm with regard to the Jones and Roser case, from the Essex Company standpoint?

A. Well, that is not very easy to do satisfactorily because, of course, Mr. Wicker, as I understand it, was the attorney for Jones and Roser and so far as we *were* went into that case we were somewhat in the position of volunteers and intruders, but my recollection is that you and Mr. Wendt and I were together over in the Federal building, and the proposition came up of adjusting both cases at once and I was familiar with the fact, as disclosed to me by Mr. Wendt, that the Essex Rubber Company had undertaken to pay costs and damages that the dealers and jobbers should suffer, and since we had communication in the first place with the Essex people's representative, when the proposition was made for settling the Wendt case at $1,000 which Mr. Wendt wanted to get consent to, the suggestion was made for settling the Roser case also at $1,000 and so I communicated the fact that both cases could be settled at that figure, and as you know, the Wendt case was settled at $1,000. You desired to get the figures on Jones and Roser which I asked Mr. [fol. 467] Wicker to get and submit and he did, and afterwards when you said that it was agreeable to settle that at $200, I communicated that fact to Mr. Wendt and to the Essex representatives

and then they arranged with Mr. Wendt, as he probably has told you, to settle that case too. I say they consented to it, on the idea that if you got a judgment against Jones and Roser, they had agreed to pay any judgment.

Q. 26. When you communicated the agreement to settle for $1,000 and the agreement to settle for $200 to the Essex people, did you send that communication to New York or to New Jersey?

A. I sent that communication to Mr. Whittemore—to New York.

Q. 27. And as a result of their approval, the stipulations were entered into that both you and I executed?

A. Yes. They wrote to us to communicate with Mr. Wendt and Mr. Wendt reported that he would take care of both cases and so I proceeded, of course, without being attorneys for Jones and Roser, to sign a stipulation with you.

Q. 28. I believe you told me that you were authorized to act in the Jones and Roser case—that anything you did was all right; that your firm, of course, was well known and it was after raising this point that I was satisfied?

A. I can't remember all that, Mr. Fales, but I simply know that in view of the consent that Wendt had to adjust that case I went ahead and acted in that behalf.

Q. 29. Have you the correspondence in which Walter Wendt was authorized to act in the Jones and Roser case?

A. That—no; Wendt would have that.

Q. 30. Will you be kind enough to produce any and all correspondence that has taken place between you and the Essex Rubber Company from the time that Judge Angell was first requested to act until the present time?

A. Yes.

Q. 31. This, of course, to include telegrams also?

A. Yes.

Q. 32. With whom did you correspond besides Mr. Whittemore of the Essex people?

A. Well, I communicated with the firm of Emery, Varney, Blair and Hoguet.

[fol. 468] Q. 33. Did you ever have any communications with Mr. Tucker or Mr. Oakley?

A. No. Never.

Q. 34. Did you meet Mr. Whittemore when he was out examining the exhibits?

A. Yes.

Q. 35. Did you discuss the case?

A. Naturally—yes.

Q. 36. Will you recount what was said between you?

A. Well, in substance, this—that Mr. Whittemore wanted to examine the exhibits which the plaintiff had filed and see whether the Essex Rubber Company would desire to defend the case or take any further interest in it, and so that he made it quite clear to me that if it turned out that the heels involved were old style heels, the Essex Company would not defend the case. Wouldn't take any part in it at all.

Q. 37. At whose suggestion did the cases go by default?

A. Well, at the suggestion of Emery, Varney, Blair and Hoguet. I'll have to say that I can't remember whether that was Mr. Whittemore or who it was that stated that. I'll have to modify that answer to that extent.

Q. 38. Do you know the firm of Welsh, Bebout and Kahn?

A. I know it by reputation.

Q. 39. Did you have any dealings with this firm with regard to either of these cases?

A. No; I think we had no dealings at all with that firm.

Q. 40. Mr. Kemp, will you now kindly make an effort to locate the correspondence between your office and the Essex Rubber Company or any of its agents about which I have already inquired of you and we will continue with your deposition in the morning as soon as it is agreeable to counsel?

A. Yes.

[Witness excused until November 23, to look up correspondence.]

[Deposition of EDWARD G. KEMP, adjourned to November 23, continued:]

Q. 41. Mr. Kemp, have you been able to locate the correspondence referred to in question 40?

A. I have investigated our files and we have no correspondence with the Essex Rubber Company or its agents.

[fol. 469] Q. 42. Have you had any correspondence with the firm of Emery, Varney, Blair and Hoguet?

A. Yes.

Q. 43. With regard to matters relating to the Essex Rubber Company?

A. Yes.

Q. 44. And relating to the Walter Wendt suit or to the Jones and Roser suit?

A. Yes.

Q. 45. Well, then, I will ask you to produce that correspondence, if you will?

By Mr. Whittemore: I object to this correspondence being produced unless Mr. Fales first shows by proper examination of the witness that there is something contained therein material to the particular matters on which he is examining the witness.

By Mr. Fales: I think that enough basis has already been laid to warrant the witness in producing the correspondence.

Mr. Fales to Witness: Mr. Kemp, in this request I wish to include any correspondence with anyone relating to either of these two suits. And in view of the fact that you are the last witness being examined, we will have to adjourn until you can procure these unless you have them here.

By Mr. Whittemore: This raid on the attorney's correspondence files seems entirely unwarranted unless Mr. Fales can point out

specifically what he is after. Otherwise, he is simply engaged in a "fishing" expedition.

By Mr. Fales: Obviously, we are entitled to this correspondence in view of the fact that any and all matters relating to the Jones and Roser suit are pertinent in this case at present from our viewpoint.

A. I am not bound by the subpœna in this case to produce any correspondence or bring anything but myself here. However, I produce correspondence between our office and the office of Emery, Varney, Blair and Hoguet voluntarily.

By Mr. Fales: The correspondence produced by the witness is offered in evidence and the notary is requested to mark the same, with the title of this cause, "Plaintiff's Exhibit No. 9, Correspondence Produced by Mr. Kemp, and the pages numbered consecutively as follows: 1 through 28, inclusive."

[fol. 470] By Mr. Fales: Mr. Whittemore, may we make this same arrangement about substituting photo-prints for the letters just produced by Mr. Kemp in order that these letters may be returned to his files, subject to whatever objections you may enter to these letters themselves.

By Mr. Whittemore: I offer no objection to that course, but do object to the introduction of these letters and copies of letters in evidence as immaterial and irrelevant and not proven.

Q. 46. Mr. Kemp, where did these letters come from?

A. They came from our office.

Q. 47. You received them and sent them in the regular course of business, or not?

A. Well, yes.

Q. 48. How long has your office been communicating with the office of Emery, Varney, Blair and Hoguet?

A. We commenced—our first com-unication was with that office some time last spring. I don't remember the exact date.

Q. 49. Referring to the letters on the letterhead of the said firm of Emery, Varney, Blair and Hoguet, the longhand signature that appears on these letters is the signature of that firm, or not?

A. I don't know.

Q. 50. Have you taken them as such?

A. Yes.

Q. 51. I notice that in this series of letters there are some letters there purporting to be signed by the Essex Rubber Company. I refer particularly to pages 23 and 17. These are evidently copies and are addressed to Emery, Varney, Blair and Hoguet and Walter Wendt and to various parties. How did these letters get in your files?

A. I think the letters there from the firm of Emery, Varney, Blair and Hoguet indicate that they were enclosures.

Q. 52. All of these letters in this series that are written over the name of the firm of Angell, Turner and Dyer, did these letters originate or not in your office?

A. These are copies of letters that originated in our office.

Q. 53. What does the index in the lower left-hand corner of some of the correspondence, to wit, "EGK/VW," signify?

A. E. G. K. are my initials. The others are the initials of the stenographer who wrote the letters.

[fol. 471] Q. 54. I notice that some of the letters are written over the name of Angell and Turner. Did these letters originate also in your office, or not?

A. These are copies of letters that originated in our office.

Q. 55. Are these all of the letters that have passed between your firm and the firm of Emery, Varney, Blair and Hoguet?

A. Yes.

Q. 56. Have any letters passed between your office and anyone else relating or referring to the Jones and Roser and Walter Wendt suits?

A. Yes. I had correspondence with you.

Q. 57. Anyone else?

A. Campbell, Bulkley and Ledyard, and you are the only two, I think, and I think I had a letter from the master in chancery.

Q. 58. And that is all?

A. Except the letters between myself and Mr. Wendt.

Q. 59. How much of a correspondence did you have with Mr. Wendt?

A. A very limited correspondence with Mr. Wendt, because he usually called and saw me at the office.

Q. 60. At the most, how many letters would you have that passed between you?

A. Not more than two or three, or three or four, I should say.

Q. 61. I wonder if you would be kind enough to call up your office and ascertain definitely the number.

A. The exact number is two.

Q. 62. Mr. Whittemore has just refreshed your memory about that, has he not?

A. Yes.

Q. 63. And it was from Mr. Whittemore's grip that you produced the letters that you have brought here this afternoon; is that not so?

A. Yes. I put them in Mr. Whittemore's grip for convenience in carrying them over. They were produced from his grip.

Q. 64. Mr. Whittemore and yourself have been consulting about this case within the last day or two, since you have been on the stand?

A. Oh, yes.

Q. 65. Have you any objection to producing those letters from [fol. 472] Mr. Wendt?

A. I don't think I ought to be called upon to produce the letters that passed between our office and Mr. Wendt.

Q. 66. Would you mind getting in touch with Mr. Wendt and seeing if he has any objection. I think you can do that over the telephone. I think he is at home. He has had no objection to producing any correspondence that he has had with the Essex Company.

A. I think I shall object to going to the trouble of calling Mr. Wendt to ask him if he has any objection to that. I feel as if I should stand on the question of professional privilege in such a case as that.

Q. 67. So that you are taking this position on your own initiative?
A. Yes.

By Mr. Whittemore: I object to the entire deposition as wholly immaterial and irrelevant and because it does not relate to any issue pleaded.

[Direct examination closed.]

Cross-examination by Mr. Whittemore:

X Q. 68. Have you any first hand knowledge of the exact message that came to your office from Mr. Varney's office some time in April last, with reference to the Wendt and Jones and Roser cases?
A. No.
X Q. 69. Am I correct in saying that you were instructed what to do in this matter by Judge Angell?
A. Yes, that is correct.
X Q. 70. Am I correct in stating that it was your understanding that your firm was requested to obtain Mr. Wendt's permission to secure a postponement of the hearings on the orders to show cause in these cases until the Essex Company's counsel could come to Detroit and look over the exhibits which had been filed?

By Mr. Fales: Objection. Irrelevant and immaterial.

A. Yes. That is substantially correct.
X Q. 71. And did you understand that an investigation of the facts was all that the Essex Company's counsel were interested in at the time?

By Mr. Fales: Same objection.

A. Yes.
[fol. 473] X Q. 72. You were never instructed to appear for the Essex Company in any manner, were you?
A. No. And I never did.
X Q. 73. And you had no authority to act in any way for the Essex Company, had you?
A. No.
X Q. 74. From the time Mr. Whittemore wrote you saying that the Essex Rubber Company would take no part in this litigation and that as far as the Essex Company was concerned, the cases might go by default, did you do anything in connection with these two suits until the accounting proceedings were started?
A. Yes. We notified Mr. Mills, at least we told him on his inquiry, substantially what you had told us and what was in your letter,—that so far as the Essex Company was concerned, the matter might go by default, Mr. Wendt already having instructed us that as far as he was concerned they might go by default and we rendered a bill to Mr. Wendt and closed up the matter in our office. Mr. Wendt, when he was served with the writ of injunction in the case, consulted me as to his obligations and rights and duties under that writ of injunction, and I advised him. Outside of that there was nothing at all until the order for accounting was served.

X Q. 75. You never entered any appearance in this litigation, did you?

A. No.

X Q. 76. In connection with the accounting, I note that there is some correspondence between you and Emery, Varney, Blair and Hoguet. Will you please explain why you took this matter up with that firm?

A. Well, after Mr. Wendt came to me with the order to appear and account, I went into the matter with him somewhat, and came to the conclusion that he was responsible for damages to a certain amount, and it might be considerable. And Mr. Wendt had informed me of the Essex Company's agreement to indemnify him against any damages or costs he might suffer on account of dealing in their heels, and it seemed to me that it was desirable not to go to the trouble and expense and take the chances on a formal accounting, but that it was preferable to settle the matter without that. However, we realized that it was—that we were not able to effect a settlement or an arrangement with the I. T. S. Rubber Company that would [fol. 474] entitle us to indemnity from the Essex Rubber Company without notifying them and securing their consent to any steps that might be taken or any arrangements that might be made. Therefore, in order to hold them to Wendt under their agreement to indemnify, I took up with them the proposition at once, as soon as it was broached, and secured their consent to the settlement at $1,000 which was made in the Wendt case.

X Q. 77. Do you recall how the matter of settling the Jones & Roser case was first brought to your attention?

A. In general, I remember that on the first hearing on the accounting, or on a subsequent one, I believe it was the very first one, I desired to have a continuance of the hearing on the accounting and I called Mr. Wicker and asked him if it were agreeable to him, and he said it was, any arrangement or postponement that I should make was agreeable to him, and I represented them with Mr. Fales, as I recall it, before the master, and then after that was arranged, Mr. Fales and Mr. Wendt and I had some conversation in the outer hall, at which time the question of settling these cases was broached, and Mr. Fales seemed favorable. I remember he used the expression that "Tufford was not out for blood" and he and Mr. Wendt had an extended conversation on the extent of Wendt's dealings and Jones & Roser's dealings, and it was proposed then that Mr. Wendt submit a statement of their dealings in these things, and that I find out what Jones & Roser's dealings were—how extensive they were. That was all.

By Mr. Fales: May I break in here just a moment, in view of counsel's objection at the time that Plaintiff's Exhibit No. 9 was offered in evidence? I wish to again offer this same exhibit in evidence, as Plaintiff's Exhibit No. 9.

By Mr. Whittemore: Same objection.

X Q. 78. And you thereafter communicated with Mr. Wicker, did you not?

A. Yes, and I think I told Mr. Wicker what had been done and asked him for a statement of Jones & Roser's dealings and he said he had no objection to what had been done and sent me the statement.

X Q. 79. Will you please refer to Question 28 of your deposition [fol. 475] and X Qs. 8, 9 and 10 of Mr. Wendt's deposition and state whether this refreshes your recollection, so that you can now give a more definite answer to Q. 28?

A. I can say, if it is necessary to clarify this, that, as I stated before, I telephoned to Mr. Wicker about a postponement of the Jones & Roser case along with the Wendt case, and Mr. Wicker said that he had no objection at all. That it would be all right with him and all right with Jones & Roser, so before the master I stated the substance of that,—that I was authorized to act for Jones & Roser as well as in the Wendt case. I can't remember the exact language which Mr. Wendt attributes to me in his answer to X Q. 10.

X Q. 80. But it was something to that effect, was it not?

A. Yes.

X Q. 81. You definitely communicated to Messrs. Campbell, Bulkley and Ledyard the information that the Essex Company would take no part in this litigation, did you not?

A. Yes.

X Q. 82. When you wrote your letter of April 30 to Mr. Whittemore, you knew, did you not, that Mr. Wendt had decided not to make any defense in the case?

A. Oh, yes. Wendt had told me when I first saw him about there being decrees in other districts and that he had no desire to fight the case.

Edward G. Kemp.

[Deposition closed.]

Deposition by W. W. Wicker

The next witness called in behalf of the plaintiff, Mr. W. W. Wicker, being duly sworn, deposes and testifies as follows:

Direct examination by Mr. Fales:

Q. 1. Mr. Wicker, will you please give your name, age, residence and occupation?

A. Name, William W. Wicker; age, fifty-nine years; residence, Highland Park, Michigan; occupation, attorney-at-law.

Q. 2. You have been representing Jones & Roser in the case of I. T. S. Rubber Company against Jones & Roser in this district, I believe?

A. I have been looking after their interests.

Q. 3. Were you acting as attorney for Jones & Roser, or what was your relation?

[fol. 476] A. My relation since the 10th of April, 1918, with Jones & Roser, or rather a short time subsequent to the 10th of April, 1919, has been a dual position. Mr. Edward J. Roser, who

was one of the firm of Jones & Roser, departed this life on that day, and in due course I was appointed administrator of his estate. By consent of the heirs, the business was continued instead of the estate taking over its interest by the sale or other adjustment, and I have been, since that time, looking after the financial affairs of the business. I have also represented them and acted for them in what few matters of a legal nature have arisen.

Q. 4. You were appointed by Jones & Roser to act for them in connection with the suit referred to, I believe?

A. Mr. Richard S. Jones, as survivor of himself and Edward J. Roser, continued to conduct the business of Jones & Roser, and he personally, or through the bookkeeper, caused to be delivered to me the summons, bill of complaint, affidavits, and order to show cause in the case of I. T. S. Rubber Company v. Jones & Roser, which had been instituted in the District Court of the United States for the Eastern District of Michigan, Southern Division.

Q. 5. Did you communicate in any way with any outside parties when the suit was on between I. T. S. Rubber Company——

A. You mean, during all the time that it was pending?

Q. 6. To be more specific, was any communication had with the Essex Rubber Company?

A. Upon receipt of these papers, I immediately caused a telegram to be sent in the name of Jones & Roser, which I prepared myself, to the Essex Rubber Company.

Q. 7. Did you get a reply to this telegram?

A. I did not.

Q. 8. What further did you do?

A. I subsequently sent another telegram to the Essex Rubber Company.

Q. 9. Here are some papers. Do you know what these are?

A. I do.

Q. 10. Please state.

A. The first, marked "Exhibit 4", is the copy of the telegram that I had sent to the Essex Rubber Company on April 11, 1920, and the one marked "Exhibit 5", which is in pen and ink, is in my [fol. 477] handwriting, is a copy of a telegram that I sent to the Essex Rubber Company on April 16, 1920.

Mr. Fales. The telegrams identified by the witness are offered in evidence, and the notary is requested to mark the same, the one dated April 12, 1920, "Plaintiff's Exhibit No. 4", and the one dated the 10th, "Plaintiff's Exhibit No. 5", and with the title of this cause.

Q. 11. I believe that some other lawyer came into the case of I. T. S. against Jones & Roser. Who was this party, if you know?

A. I entered no formal appearance for Jones & Roser in that case and I never have examined the records in the clerk's office of the District Court here to ascertain whether anyone else did enter appearance.

Q. 12. Did anyone tell you that they were taking any steps in connection with the case, or did you consult with anyone who was taking steps in the case?

A. Upon the return day of the order to show cause, I went over to the District Court room for the purpose of seeing what was done in the matter and was informed that the hearing upon the order to show cause had been adjourned. I was also informed at that time that there was another case of the I. T. S. Rubber Company against somebody else, involving substantially the same matters, that is, substantially like matters.

Q. 13. Who was it that informed you as to these two matters that you have just mentioned?

A. Someone from the office of Campbell, Bulkley and Ledyard I am not clear who it was.

Q. 14. Was there any correspondence between Jones & Roser and the Essex Rubber Company?

A. There was.

Q. 15. I hand you Plaintiff's Exhibit No. 1, and ask you if you recognize that?

A. I do.

Q. 16. Is that what you had in mind in your preceding answers?

A. That is part of it.

Q. 17. I hand you Plaintiff's Exhibit No. 4, and ask you if you recognize that?

A. I do.

Q. 18. In whose custody have these letters been until recently?

A. Exhibit 1 has been in the custody of Jones & Roser at their [fol. 478] store until within the last week or such matter. The Plaintiff's Exhibit 2 has been in my custody since or about the seventh day of January, 1920, until some time this week when I gave my deposition—until the seventeenth day of November, instant, at which time I delivered it to the notary as an exhibit in connection with my deposition on that day taken. The Plaintiff's Exhibit No. 1 was in the possession of Jones & Roser at their store until the eighteenth day of November, instant, when it was brought to my office by the bookkeeper, and I this morning delivered it to Mr. Richard S. Jones.

Q. 19. Referring to the Essex letter of January 5, Plaintiff's Exhibit No. 2, do you know if the Essex Rubber Company ever did anything in compliance with the guarantee in this letter?

A. Personally, no.

Q. 20. Have you communicated with Mr. Kemp from time to time with regard to the Jones & Roser suit?

A. There may have been one or two telephone communications and one personal conversation.

Q. 21. There were certain extensions in the Jones & Roser case from time to time. By whose authority were these extensions granted?

A. You mean, extensions of the order to show cause or extensions of what nature?

Q. 22. Extensions before the special master?

A. Of the hearing to assess damages?

Q. 23. Yes.

A. I understood that those proceedings were adjourned and was so informed by Mr. Kemp.

Q. 24. Has Mr. Kemp ever said anything to you with regard to his relation to the Essex Rubber Company and what his capacity was?

A. I can't say that he has.

Q. 25. Do you know whether Mr. Kemp has performed any services for the Essex Rubber Company.

A. I do not.

Q. 26. Do you know whether Mr. Kemp has performed any services for the Essex Company in any way, shape or form?

A. I do not.

Q. 27. Have you never been informed by anyone of any relations between Mr. Kemp and the Essex Rubber Company?

[fol. 479] A. That is a rather difficult question to answer, for this reason, Mr. Fales, that the rubber heels involved in that litigation were, as I understand it, manufactured by the Essex Rubber Company and a Mr. Wendt who I understood was a jobber here in Detroit, and the dealings of Jones & Rosser were all with Mr. Wendt and not with the Essex Rubber Company. I understand, too, that the other litigation instituted at approximately or at the same time as the Jones & Roser, was of the I. T. S. Rubber Company against Wendt, and in the conversations I had over the telephone or personally with Mr. Kemp, I don't think that the Essex Rubber Company's name was mentioned, except as referring to the Essex heels. I may have jumped at some conclusions, but it would be clearly a jump if I did arrive at any conclusion as to who he represented aside from Mr. Wendt.

Q. 28. Why did you let the case go by default?

A. Because we stood squarely upon the guaranty of the Essex Rubber Company and after having notified them and after having been informed by Mr. Jones subsequent to the sending of the telegrams which have been introduced in evidence,—Mr. Jones informed me that someone connected with the Essex Rubber Company had told him that their attorneys would look after the matter.

Mr. Whittemore: I object to the latter part of the answer as hearsay.

Q. 29. What was Mr. Jones' purpose in informing you?

A. I can't tell. You will have to ask that question of Mr. Jones. He is better qualified to answer that.

Q. 30. Do you know Mr. Tucker of the Essex Rubber Company?

A. I do not.

Q. 31. By standing on the guaranty, the you put it up to the Essex Company to do whatever they chose or not?

A. I let the matter go by default. Paid no further attention to the court proceedings.

Q. 32. Did Jones & Roser pay any costs or profits or damages in the suit?

A. They did not.

[Direct examination closed.]

[fol. 480] Cross-examination.

By Mr. Whittemore: I object to the entire deposition as immaterial and irrelevant and not relating with any issue pleaded herein.

X Q. 33. The letter which you have before you, Plaintiff's Exhibit 2, embodies the entire agreement and understanding between your client, Jones & Roser, and the Essex Rubber Company, does it not?

A. That, in connection with the Plaintiff's Exhibit No. 1, comprises the entire of the guaranty.

X. Q. 34. Have you ever received any communications from the Essex Rubber Company other than this letter?

A. You mean in regard to the matters involved with the alleged infringement? Not to my knowledge.

X Q. 35. Either before or after the suit was started?

A. Neither before nor after.

X Q. 36. Is it not true that Jones & Roser acted in this litigation entirely upon your advice?

A. That is my understanding.

X Q. 37. Do you suppose that your client would have taken any action in the litigation without consulting you?

A. I think not, and I can give you the reason for it if you desire.

[That is all.
Deposition closed.]

William W. Wicker.

[Met pursuant to adjournment.]

DEPOSITION OF RICHARD S. JONES (RECALLED)

By Mr. Fales: Mr. Whittemore, I notice that you have with you evidently the originals and copies of various papers to which we have referred, and I will ask if you have with you the original letter of Plaintiff's Exhibit No. 1, and if so, if you will kindly produce it in order that the witness, Mr. Jones, may be able to identify the same.

By Mr. Whittemore. I hand you a letter which is apparently an original, of which Plaintiff's Exhibit No. 1 is a copy.

[fol. 481] Direct examination by Mr. Fales:

Q. Mr. Jones, I hand you the letter that Mr. Whittemore has produced and will ask you if you recognize this letter and what relation does it bear to Plaintiff's Exhibit No. 1, if any?

A. I recognize the letter.

Q. 68. Is this the original of which Plaintiff's Exhibit No. 1 is a carbon, or not?

A. That is the original.

Q. 69. Whose signature appears at the bottom?

A. My signature. Dictated by W. W. Wicker.

By Mr. Fales: Mr. Whittemore, will you be willing to stipulate the carbon that has been marked for identification in place of the original that you have handed the witness, to serve in place thereof, with the same force and effect as the original. This will enable you to keep the original copy in your files.

By Mr. Whittemore: I offer no objection to your use of the carbon copy, Plaintiff's Exhibit No. 1, and its introduction in evidence, subject, however, to the objection noted at the end of the previous deposition of Mr. Jones.

By Mr. Fales: The Plaintiff's Exhibit No. 1 is offered in evidence.

By Mr. Whittemore: The objection heretofore noted as to the materiality of the deposition of Mr. Jones is repeated as to this addenda thereto.

[Direct examination closed.
No cross-examination.
Deposition closed.]

Richard S. Jones.

DEPOSITION OF WILSON W. MILLS

The next witness produced in behalf of the plaintiff, WILSON W. MILLS, being duly sworn, testified as follows:

Direct examination by Mr. Fales:

Q. 1. Please give your name, age, residence and occupation?

A. Wilson W. Mills; Detroit, Michigan; attorney at law.

Q. 2. Are you familiar with the cases filed in the District Court [fol. 482] in this district under the name of the I. T. S. Rubber Company against Walter Wendt and I. T. S. Rubber Company against Jones & Roser?

A. I am.

Q. 3. Did you have anything to do with the case at the beginning?

A. I did.

Q. 4. Please state what your activities were—particularly state any facts that you may know with regard to the exhibits in the cases.

A. Well, the early part of 1920 I received a letter from the firm of Richey, Slough and Fales, bills of complaints against the various defendants you have mentioned, with request to file the same in the District Court of the United States for the Eastern District of Michigan and to obtain an order to show cause, and at the same time I received a number of rubber heel exhibits. After preparing the necessary papers to secure the issuance of summonses and petition for an order to show cause, I went to the clerk's office of the District Court and filed the various papers. I asked the clerk in charge as to whether it was customary in patent cases to file the exhibits. He stated that I could do what I wanted about that, but that it was

not usual to file them. I then wrote to Richey, Slough and Fales and told them what I had done and they replied for me to follow the local practice about filing the exhibits. So, in view of my conversation with the clerk, I didn't file them, although I had them here in my office until some time in the month of August, 1920, I think, when I returned them to Richey, Slough and Fales. I am referring to the file as I testify for the purpose of fixing the dates. The rest of the matters I remember quite well.

Q. 5. Have you the plaintiff's exhibits in both of these cases, entitled "Defendant's Heels?" If so, will you please produce them?

A. These heels fastened by the tag reading "United States District Court, Eastern District of Michigan, The I. T. S. Rubber Company v. Jones and Roser, in Equity, No. —, Plaintiff's Exhibits Defendant's Heels, Tite-Edge" are the same heels that I brought over to the District Court in the Jones & Roser case. And likewise the heels fastened to the tag, reading: "United States District Court, Eastern District of Michigan, The I. T. S. Rubber Company v. Walter [fol. 483] Wendt, in Equity No. —, Defendant's Heels, Plaintiff's Exhibit Tite-Edge" are the exhibits which I brought over in the Wendt case. I wish to qualify that answer, though, in this respect: Originally I didn't have Exhibit Heel 5-O in the Wendt case, although I later secured it and had it here, and it was returned to Richey, Slough and Fales with the other heels.

By Mr. Whittemore: I object to the foregoing as incompetent to identify the exhibits in these cases.

Q. 6. Were these exhibits ever examined by opposing counsel in the Wendt and Roser cases?

A. On either the 18th or the 19th of April, 1920, Judge Angell of the firm of Angell and Turner, of Detroit, as I recall it, brought Mr. Manvel Whittemore to this office and introduced him to me. I am certain that I talked to Judge Angell, but whether Judge Angell or Mr. Kemp actually introduced me to Mr. Whittemore, I don't recall. Mr. Whittemore stated, as I recall, that he represented the manufacturer who sold various heels to Jones & Roser and Wendt and Mr. Whittemore examined in my office all these heels except Exhibit 5-O in the Wendt case, which, as I stated, I didn't have. Mr. Whittemore asked me if I would secure that exhibit for him. I wrote to Richey, Slough and Fales for the missing exhibit. They sent it to me and on April 24, 1920, I wrote Mr. Whittemore addressing the letter to 129 Broadway, New York, as follows:

"I am enclosing herewith, Exhibit 5-O, which you requested last Monday. My correspondents state they intend to rely upon this exhibit. After you have examined it, will you please return it to me as soon as possible in accordance with our verbal arrangement, and at the same time, inform me, if you can, as to whether or not the manufacturer intends to contest the suits. The return day of the order to show cause will be adjourned from April 26, to May 10.

Yours very truly," —— ——.

and on the 28th of April, 1920, I received a letter from Mr. Whittemore, reading as follows:

[fol. 484] "Messrs. Campbell, Bulkley and Ledyard, Union Trust Building, Detroit, Michigan.

GENTLEMEN: I have examined and return herewith, the heel which you sent me in your letter of April 24. I note that this heel is marked '5-OW' but understand it to be the heel referred to as 'Numbered 5-O' in the affidavit of Mr. Slough. The manufacturer of these heels will not appear in this litigation. Whether or not the defendants will contest these suits you will have to ascertain from their respective attorneys.

Very truly yours, Manvel Whittemore."

Q. 7. The Mr. Whittemore to whom you refer is the Mr. Whittemore present at this hearing, is he not?

A. He is, to the best of my belief.

Q. 8. Have you any doubt about it?

A. No. He is the same person.

Mr. Fales: The exhibits in the Wendt & Jones and Roser cases referred to by the witness are offered in evidence and the notary is requested to mark the same with the title of this cause and Plaintiff's Exhibits 6 and 7, applying the number 6 to the Wendt exhibit and the number 7 to the Roser exhibit.

By Mr. Whittemore: I object to the offering of these heel exhibits in evidence as insufficiently and improperly proven.

[Direct examination closed.]

By Mr. Whittemore: I object to the entire deposition of the witness, as immaterial and irrelevant, because it does not relate to any issue pleaded in this cause.

Cross-examination by Mr. Whittemore:

X Q. 9. Mr. Mills, how are you able to identify these heels which you say have been out of your possession for some time as the heels that were in your office several months ago?

A. By the way they are fastened up. Not only with each other, but with tags.

X Q. 10. That is all, is it?

A. And then they look like the other heels.

[fol. 485] X Q. 11. Did you ever make any minute examination of the heels that you had last spring?

A. Not very minute; no.

X Q. 12. When did you receive these heels back—when did the heels which are before you last come into your possession?

A. Oh, just a few days ago; I can't place the exact date. A few days ago.

X Q. 13. And by whom were they handed to you?

A. Mr. Fales.

X Q. 14. Did he make any statements when he handed you these heels?

A. Yes, he did.

X Q. 15. Did he say that these were the heels forming the exhibits in the Wendt and Jones & Roser cases?

A. Mr. Fales stated that they were the same heels I returned to him.

X Q. 16. Then you are relying upon his statement, are you not, in identifying these heels?

A. Partially.

X Q. 17. When Mr. Whittemore was here at your office last spring, did he not make it clear to you that he was merely investigating the facts in these two suits on behalf of his client, the Essex Rubber Company?

A. I have testified what you said to me. The conclusion which I drew at the time from it is probably best evidenced by what I wrote to Mr. Fales at the time that you were here and might contest the suits Except as expressed in that letter to Mr. Fales which formed, at the time, my understanding of what you were here for, I have no very great present recollection.

X Q. 18. That is the letter you read into the record, is it not?

A. I don't believe I read that letter.

X Q. 19. Will you please do so?

A. [Reading:]

"April 19, 1920.

Messrs. Richey, Slough and Fales, Elyria, Ohio.

DEAR SIRS: Mr. Manvel Whittemore, of Messrs. Emery, Varney, Blair and Hoguet, Counsellors at Law, 149 Broadway, New York, called on us today with reference to the local rubber heel cases. He represents the manufacturer who sold to the local defendants. He examined the affidavits and stated that Exhibit 5-O mentioned [fol. 486] in the affidavit in the Wendt case, is not among them. He desires to know whether you meant to rely on Exhibit 5-O or not. If not, he naturally does not care to see the same. If you do, however, he desires the same to be sent him immediately, either by yourself or us, for examination, after which he will return it to us.

Yours very truly," —— ——.

I wish to add, Mr. Whittemore, that probably my recollection, of which I spoke, was based upon my letter to you asking you whether the manufacturer intended to contest the suits, from which it would seem that I gathered from your conversation with me that there was a good chance that the manufacturer might do so. I have no independent recollection of it except from those letters.

X Q. 20. Mr. Mills, have you any objection to my looking through the correspondence file which you have been refering to throughout your deposition?

A. None, up to the time of the entry of the decrees in both cases.

X Q. 21. I note in a letter to you from Mr. Richey, dated April 11, 1920, he says, in substance, that he does not want the rubber

heel cases to go by default and that he wants a contested case. Do you know why he wanted a contested case?

A. I am not certain.

X Q. 22. What is your best recollection?

Mr. Fales: The witness is incompetent to testify along this line.

A. Only what the letter from Mr. Richey states. It is the only thing I have to form any recollection on.

X Q. 23. I notice several letters which would seem to indicate that extensions of the hearing on the orders to show cause were obtained at Mr. Richey's request. Is that the fact?

A. Yes. Also at the request of either yourself or Judge Angell.

X Q. 24. I note in a letter of April 22, apparently written from you to Mr. Richey, you state that "if the manufacturer does not contest, the jobbers will not." Do you recall upon what information this statement was based?

[fol. 487] Mr. Fales: Mr. Whittemore, I think I have been quite liberal with you in this connection and I believe that you are going considerably beyond the scope of the direct examination. I will, therefore, ask you to restrict your examination accordingly.

Mr. Whittemore: The witness has testified generally about his conduct in this litigation and has referred to his correspondence file in so doing, and I consider, therefore, that all of the questions I have asked are within the scope of the direct examination.

Mr. Fales: Will you be kind enough to point out what question in the direct examination opens up the subject-matter of this last cross-question?

Mr. Whittemore: Certainly. The question is directed to my visit to this office last spring. I cannot point them out by number because the testimony has not been written up.

A. It must have been because I was so informed by either Messrs. Angell and Turner or Mr. Whittemore himself, or both, because they were the only people from whom I could possibly derive any such information, because I had, up to that time, never talked to any of the defendants themselves.

X Q. 25. I call your attention to a letter from you to Mr. Richey, dated April 9, in which you say "the attorney for Mr. Wendt has just been in touch with us and stated that they would allow the case to go by default if we would agree not to include in the decree anything besides the injunction—in other words, waive an accounting." Does this refresh your recollection at all?

A. I recall somebody calling me on the telephone, I think, stating that if we would waive an accounting they would let the case go by default. Just who it was, I can't remember.

X Q. 26. This was before you heard anything from Angell and Turner in regard to this case, or before I visited your office, was it not?

A. I am not certain. I can only tell by refreshing my recollection from dates on the correspondence. Evidently Mr. Whittemore was here on April 19 and evidently on April 10 I wrote that letter which

you referred to the effect that the attorneys for Wendt had been in [fol. 488] touch with us about letting the case go by default, if we would not have an accounting, which, on instructions from Mr. Richey's office, we refused to do. That is, we refused to waive the accounting.

X Q. 27. And as far as you recall, this was before you heard anything from Angell and Turner about this matter?

A. As far as I recall the matter, unless it was Angell and Turner—it might have been Angell and Turner themselves who called me. I don't remember who it was.

X Q. 28. You advised Mr. Richey of the receipt of my letter of April 26, did you not?

A. On April 28, I wrote Mr. Richey's firm that I had received a letter from you, Mr. Whittemore, to the effect—stating that "the manufacturer of the heels in question would not appear in this litigation."

X Q. 29. You stated that neither of the local defendants had appeared on the record, did you not, in that same letter?

A. I did.

X Q. 30. Who did you refer to as the local counsel for the local defendants?

A. Angell and Turner, and I am not certain who the other one was. If it was Mr. Wicker, I never had the pleasure of meeting him until ten days ago. I do recall someone calling me on the phone one day stating that he represented Wendt or Jones & Roser, but I didn't catch his name, but his office was in the same building in which I understand Mr. Wicker's office is in, so it may have been Mr. Wicker, although I don't remember.

X Q. 31. According to your best recollection, it was Mr. Wicker, wasn't it?

A. I have no recollection, as I told you.

X Q. 32. I note in a letter dated May 3, that you advised Mr. Richey that the orders to take the bills pro confesso were entered on that day.

A. I did.

X Q. 33. That is a fact, is it not?

By Mr. Fales: The record is the best evidence.

A. That is a fact, unless possibly the letter was dictated late in the evening and was not written until the following day, in which case there would be a day's difference between the letter and the date of the order.

X Q. 34. What is your objection, Mr. Mills, to my examining [fol. 489] the remainder of your correspondence file, after the entry of the decrees?

A. Why, the remainder of the file goes to matters of the accounting and the settlement which was reached upon the accounting.

X Q. 35. All having to do with your conduct of this case, nevertheless?

A. Having only to do with my adjourning of the various hearings on the accounting. That was all I did after this point.

X Q. 36. But still you don't want me to see those?

A. Why, I don't see how it could possibly be material to the matters, as I understand, that are included in the issues in your Massachusetts suit. In other words, the rest of the correspondence relates merely to the negotiations upon the settlement in lieu of accounting.

X Q. 37. But you are not willing to show these letters so that the court may judge of the materiality thereof?

A. Yes, the court may see it all, in view of the fact that Mr. Fales has no objection.

X Q. 38. Will you please read into the record your letter of October 9, to Richey, Slough and Fales?

Mr. Fales: Objected to as not calling for the best evidence.

A.—

"Referring to your talk the other day, one of the members of this office yesterday discussed the two local I. T. S. Rubber suits with Mr. Kemp of the office of Angell and Turner. Mr. Kemp stated that the Essex Rubber Company was the concern who, in the first instance, referred the matter to his firm, asking the latter to defend Wendt, Roser and Jones; upon the direct question, 'This matter was referred to you by the Essex Rubber Company asking you to protect Roser and Jones;' his reply was, 'Yes.' We could ascertain nothing else. Will you please advise me what you wish done about adjourning the case from the 14th, where it now stands for hearing?"

X Q. 39. You personally dictated and signed the letter of which this is a copy?

A. I dictated the letter. I don't know whether I sign- it — not. [fol. 490] X Q. 40. The letter just quoted is apparently based upon a memorandum in the file dated October 8, 1920. Please read that memorandum into the record.

Mr. Fales: Objected to as not calling for the best evidence.

A. This memorandum was dictated by Mr. Willits of this office, who gave it to me, and reads as follows:

"October 8, 1920.

Re I. T. S. Rubber Company

I visited Mr. Kemp this forenoon and during the conversation asked him what connection the Essex Rubber Company had with this matter or what interest they had in it. He said they were only desirous of protecting the patents and at present had no real interest. That they were the persons who in the first instance referred the matter to us and asked us to defend Wendt, Roser and Jones. I again asked him, 'This matter was referred to you by the Essex Rubber Company who asked you to protect Roser and Jones' and his answer was 'Yes.' He said that really they had no present interest other than asking us to protect the above named parties."

X Q. 41. In the last sentence by "they" the Essex Rubber Company is meant, is it not?

Mr. Fales: Objected to as incompetent.

A. I don't know. I didn't prepare the memorandum.

X Q. 42. As far as you know, Mr. Mills, there was no defense made in either of these cases, was there?

A. No appearance made on the record to the best of my knowledge. I think a defense was interposed to the amount of the accounting in one suit, although as to that it is purely hearsay. I didn't attend any of the accountings. I went over with Mr. Fales and introduced him to the master in chancery and left. That was all I had to do with the accounting.

X Q. 43. Before the decree ordering the accounting was entered, there was no appearance and no defense?

A. There were pro confesso decrees and, I believe, they were regular.

[fol. 491] Mr. Fales: This line of examination is objected to as the record is the best evidence.

That is all.

[Cross-examination closed.
Deposition closed.]

Wilson W. Mills.

It is hereby stipulated by and between the parties that the exhibits introduced in evidence in the course of the depositions may be retained by the respective parties until final hearing, subject to examination by the opposing party at all reasonable times.

[Recess for luncheon.]

Deposition of Wilson W. Mills (Recalled)

Wilson W. Mills recalled in behalf of the plaintiff.

Direct examination by Mr. Fales:

Q. 44. Mr. Mills, have you ever handled any other rubber heel exhibits other than the rubber heel exhibits in the Jones & Roser and Walter Wendt suits about which you have already testified?

A. No. Those are the only rubber heel exhibits that I ever handled,—those that I testified to this morning.

Q. 45. And the number of those two suits?

A. The I. T. S. Rubber Company v. Walter Wendt was equity 325, and I. T. S. Rubber Company v. Jones & Roser was equity 326.

[That is all.]

By Mr. Whittemore: Same objection as noted at the end of the original deposition.

[Deposition closed.]

Wilson W. Mills.

Depositions adjourned until November 24, at 704 Ulmer Building, Cleveland, Ohio, in the office of Joseph L. Wright, pursuant to notice.

[fol. 492] Testimony taken in behalf of the plaintiff, The I. T. S. Rubber Company, at the office of Joseph L. Wright, room 704 Ulmer Building, Cleveland, Ohio, at 11 a. m. November 24, 1920, before Henry L. Gabriel, notary public in and for Cuyahoga County, Ohio.

Met pursuant to adjournment from Detroit yesterday, November 23, 1920.

Present: Manvel Whittemore, Esq., for the Defendant; E. D. Fales, Esq., and C. C. Tucker, Esq., for the Plaintiff.

DEPOSITION OF THOMAS J. URBANSKY

The next witness produced in behalf of the plaintiff, THOMAS J. URBANSKY, being duly sworn, testifies as follows:

Direct examination by Mr. Fales:

Q. 1. Will you please give your name, age, residence and occupation?

A. Thomas J. Urbansky; thirty-two years of age; 2364 Ontario Street, Cleveland, Ohio; secretary of the Thomas Urbansky & Sons Company, jobber of leather and findings, same address.

Q. 2. Were you the defendant in a suit in this district in the Federal Court between the I. T. S. Rubber Company and Thomas Urbansky & Sons Company?

A. Yes, I was the defendant.

Q. 3. Do you mean yourself personally or the company?

A. I was the defendant for the company.

Q. 4. Who are the members of the company?

A. You mean the directors?

Q. 5. Yes.

A. Thomas Urbansky, Thomas J. Urbansky, Bertha Urbansky, P. A. White, Abbie E. Kannengieser.

Q. 6. And the Thomas Urbansky above mentioned is yourself?

A. No; the Thomas J. Urbansky.

Q. 7. Who, connected with your firm, knows about the proceedings in the above suit referred to by you?

A. Myself.

Q. 8. What is your capacity in the firm organization?

A. Vice-president and secretary.

[fol. 493] Q. 9. Will you please tell us what did you do when you were notified that the papers in the suit had been filed, that is, when the suit was commenced?

A. Immediately communicated with the Essex Rubber Company.

Q. 10. You mean the Essex Rubber Company of New Jersey?

A. Yes.

Q. 11. Did you communicate with them by correspondence or directly by personal conference?

A. By correspondence.

Q. 12. Did you have any personal relation with anyone representing the Essex Rubber Company during the pendency of the suit relative to the suit?

A. I would say "No, sir" as to that question.

Q. 13. I notice that you seem to hesitate somewhat in giving this answer; was there any particular reason for your hesitating; that is, did you have any trouble in arriving at a conclusion? Was there any question in your mind as to it?

A. No, none other than that I met one or two of the Essex Rubber Company during the convention, and do not recall whether any reference was made to the suit.

Q. 14. What was the correspondence about to which you refer?

A. Well, we advised the Essex Rubber Company that we were defendants in a suit.

Q. 15. And what was their reply?

A. To let the suit go by default.

Q. 16. Did you act accordingly?

A. Yes, sir.

Q. 17. Were any profits or damages paid to The I. T. S. Rubber Company in that suit?

A. Yes, sir.

Q. 18. Did you have any instructions from the Essex Rubber Company as to how to proceed about the matter?

Mr. Whittemore: Objected to as leading.

A. Yes.

Q. 19. And what did they instruct you to do?

A. To let the suit go by default and that we would be reimbursed for the expense that we were put to.

Q. 20. Did anyone here in Cleveland give you any suggestions or instructions with regard to the suit?

A. No.

[fol. 494] Q. 21. Do you recall how many letters passed back and forth between you and the Essex Company? If you do not recall exactly, you may give the approximate number.

A. I presume you have reference to communications in connection with the suit?

Q. 22. Yes.

A. Possibly two or three.

Q. 23. Were there any telegrams?

A. No.

Q. 24. Any telephone messages?

A. No.

Q. 25. Can you produce the correspondence referred to in your answer to question 22?

A. I presume so, if necessary.

Q. 26. Yes, it is quite necessary, and if you can produce the letters, I will appreciate it.

A. It will take some little time to have them here.

Mr. Fales: Mr. Urbansky is excused, for the purpose of procuring the correspondence in question, until this afternoon.

[Recess.]

Q. 27. Mr. Urbansky, have you been able to find the correspondence in question?

A. Yes, sir.

Q. 28. Is this it here?

A. Yes, sir.

Q. 29. Does this correspondence refresh your memory in any way as to whether you had any personal communication with any of the representatives of the Essex Rubber Company?

A. Yes.

Q. 30. Will you please state what the nature of the communication was and with whom?

A. Just about the time we received the bill of complaint against us, Mr. Warman of the Essex Rubber Company happened to drop in and the copy of the bill of complaint was given to him, and he in turn mailed it in to the house.

Q. 31. What did Mr. Warman have to say, if anything?

A. I doubt if he knew anything of the matter at the time, as near as I could recollect, but the matter was to be taken up direct.

Q. 32. How long have you been dealing with the Essex Rubber Company?

A. For a good many years.

Q. 33. Do you know Mr. C. C. Tucker?

A. Yes, sir.

Q. 34. Are you familiar with his signature?

A. Yes, sir.

Q. 35. Whose signature is that which appears at the bottom of these letters that you have handed me on the letterhead of the Essex [fol. 495] Rubber Company?

A. Mr. C. C. Tucker's signature is affixed to all of them.

Q. 36. The other letters that are over the name of The Thomas Urbanskp & Sons Company, that is, the carbon copies in this series that you have handed me, who dictated these letters?

A. I did.

Q. 37. Where did you find these letters, where did you take them from?

A. In our files.

Q. 38. Were these letters sent and received in the regular course of business or not?

A. Yes.

Q. 39. The originals of these carbons in this series were sent to whom?

A. Essex Rubber Company.

Mr. Fales: Counsel for Essex Rubber Company is requested to produce the original letters referred to by the witness.

Mr. Whittemore: They are not in the case yet.

Mr. Fales: The letters produced by the witness are offered in evidence, and the notary requested to mark the same "Plaintiff's Exhibit 10", and with the title of this cause. He is also requested to number the pages of this series of letters "1" to "12" inclusive.

Mr. Whittemore: I object to the introduction of the letters as exhibits in the cause because they are incompetent, immaterial and irrelevant.

Mr. Fales: Counsel for the Essex Rubber Company is again requested to produce the original letters, copies of which are in Exhibit No. 10, and to which the witness has referred.

Mr. Whittemore: If Mr. Fales will explain the reason for this request, I will consider it.

Mr. Fales: The witness has stated that certain letters were written, copies of which he has produced; I would like to see the originals, and I would either like to put them in evidence myself or have the opposing counsel do this.

Mr. Whittemore: I will produce such of the letters as I may have with me for Mr. Fales examination, but I have made no objection to the use of copies in place of originals, and therefore will not produce these letters to be introduced in evidence.

[fol. 196] Mr. Fales: I have examined the letters which you have handed me, but since they are not being produced to be introduced I have no particular interest in them.

[Direct examination closed.]

Cross-examination by Mr. Whittemore:

X Q. 40. In your direct examination, in response to a question by Mr. Fales, in which he asked you if you had any instructions from the Essex Rubber Company as to how you were to proceed about this matter, you replied "Yes". Would it not be more correct to state that you received a request from the Essex Company?

A. Yes; we were not instructed, we were requested.

X Q. 41. If this request had been contrary to your own interests would you necessarily have followed it?

A. No.

X Q. 42. Did the Essex Company or any of their representatives take any part whatsoever in the conduct of this litigation between your company and the I. T. S. Company?

A. No.

X Q. 43. All they did, then, was to reimburse you for what you paid out; is that correct?

A. Yes.

X Q. 44. You personally appeared with Mr. Fales before Mr. Miller, the special master, did you not, and arranged settlement in this case?

A. Yes.

X Q. 45. And you personally signed some paper at the request of Mr. Fales, closing up the case, did you not?

A. I did.

X Q. 46. When you appeared before Mr. Miller, were any heels other than tite-edge heels mentioned?

A. Yes.

X Q. 47. Can you describe them by name and state the occasion of their being mentioned?

A. As near as I can recall there were several other heels exhibited before me, namely, Cats Paw, Beaded Tip, Usco, Hill, and possibly others.

X Q. 48. And why were these heels brought to your attention at that time?

A. Mr. Fales asked me if we had sold or stocked any of the above heels, in addition to tite-edge.

X Q. 49. Do you know his purpose in making this inquiry or did he state why he was making this inquiry?

A. I presume they were infringing heels.

[fol. 497] X Q. 50. Did he ask you to account for your profits on these heels as well as on tite-edge heels, by "account" I mean state to him the profits you had made on the other heels?

A. Yes; we were asked to make an accounting on Usco and Beaded Tip heels, in addition to tite-edge.

Mr. Fales: The question and answer are objected to, as the record is the best evidence.

Mr. Whittemore: I object to the entire deposition of the witness as immaterial and irrelevant and having nothing to do with any issue pleaded in the cause.

[Cross examination closed.]

Redirect examination by Mr. Fales:

Q. 51. Did you rely or not upon the promises of the Essex Company to reimburse you and hold you without loss in the I. T. S. against Urbansky suit?

A. Not necessarily.

Q. 52. I don't quite understand your answer and for the benefit of the court I will ask you to read my question as to whether or not you did rely upon their promise. Did they or did they not reimburse you according to their promise; as contained in the letters that you have produced?

A. They did reimburse us, but if they had not it would have been immaterial, as the expense incurred was small.

Q. 53. Had the expenses been large, then what?

Mr. Whittemore: Objected to as irrelevant and immaterial.

A. It would have been the same anyway, because they did not protect us against any losses when goods were purchased.

Q. 54. I refer you to the Essex Rubber Company's letter of December 18th, and particularly to the first paragraph. What have you to say about this paragraph?

Mr. Whittemore: The letter speaks for itself.

A. I confirm Mr. Whittemore's statement that the letter referred to is self-evident.

Q. 55. But I would like to have your own statement of the facts, regardless of what Mr. Whittemore said. I refer to the language which reads as follows: "We advise you that we shall stand behind [fol. 498] our jobbers and pay any judgments which may be obtained against them by reason of any infringement caused by the handling or sale of our goods."

Mr. Whittemore: Same objection.

[Question continued.] Do you attach any value to those words?

A. Yes.

Q. 56. What do you attach to them?

A. That they would protect us against damages.

Q. 57. Did you take that promise in good faith or not?

A. Yes.

Q. 58. Did this have any influence on your conduct of the case, for example, would you have communicated back and forth with the Essex Company as you did otherwise during the conduct of the case?

[Question withdrawn.]

Q. 58. Why did you communicate back and forth with the Essex Company, keeping them posted as to the various steps, as this correspondence shows?

A. By request of the Essex Rubber Company after they received a copy of the bill of complaint filed against us.

Q. 59. Did you follow their suggestions during the conduct of the case or not?

A. Yes.

Q. 60. Would you have done this had the Essex Company not made the promise to hold you against loss in the event of judgment?

A. No; we would have procured our own counsel.

Q. 61. Were you or not finally reimbursed for all your losses and expenditures by the Essex Company, as far as costs and profits were concerned?

A. We were reimbursed.

Q. 62. Mr. Urbansky, were you subpœnæd to attend as a witness in this case?

A. Yes.

Q. 63. Are you still handling any of the Essex Rubber Company's goods?

A. Yes.

[Redirect examination closed.]

[fol. 499] Recross-examination by Mr. Whittemore:

X Q. 64. Can you state approximately the amount of your monthly business with the Essex Rubber Company at the present time?

A. No; I cannot without looking up the books.

X Q. 65. You handle no tite-edge heels at the present time, do you?

A. We do not.

X Q. 66. Do you handle the I. T. S. heel?

A. Yes.

X Q. 67. Do you recall whether your last purchase of tite-edge heels of the old type was prior to December 18th, 1919?

A. Yes, it was.

X Q. 68. In reading over your deposition you have expressed a desire to correct an answer, will you please state what the answer is and your reply thereto?

A. In answer to Q 53, I wish to make that answer read as follows: "It would have been the same anyway, because they did not guarantee to protect us against any losses when goods were purchased."

X Q. 69. And that is the way you originally answered the question, is it not?

A. Yes, sir.

[Recross examination closed.]

Redirect examination by Mr. Fales:

Q. 70. Referring to Q. 53 and to your correction in X-Q. 68, I would like to clear up this matter a little further. You say that the Essex Company did not guarantee you against any losses when the goods were purchased. But what is the date of the guarantee in this letter that I hand you in Plaintiff's Exhibit 10, Sheet 2, as contained in the first paragraph?

A. December 18, 1919.

Q. 71. Was this guarantee after the goods were purchased?

A. Yes.

Q. 72. I want to draw a distinction between guarantees against losses with regard to the goods nad guarantee against losses due to infringement arising out of the I. T. S.—Urbansky suit in question. Did you incur any losses due to the infringement as a result of the [fol. 500] costs and accounting? You may have already answered that question but I am asking it again.

A. We did but we were reimbursed by the Essex Rubber Company.

Q. 73. And did you expect to be reimbursed as a result of the guarantees by the Essex Rubber Company appearing in this correspondence, Plaintiff's Exhibit No. 10, when you requested the Essex Rubber Company to reimburse you?

A. Yes.

[Re-redirect examination closed.
Deposition closed.]

Mr. Fales: Mr. Whittemore, do you object to having photostatic copies of these letters produced by Mr. Urbansky, Plaintiff's Exhibit No. 10, substituted for the originals with the same force and effect as these originals themselves.

Mr. Whittemore: I offer no objection, this matter to be handled by the notary as we arranged in Detroit.

Deposition of H. H. Hackman, Jr.

The next witness called on behalf of the plaintiff, H. H. Hackman, Jr., being duly sworn, testifies as follows:

Direct examination by Mr. Fales:

Q. 1. Will you please give your name, age, residence and occupation?

A. Name, H. H. Hackman, Jr.; thirty-nine years old; partner, H. H. Hackman Leather Company, wholesale leather and finding business.

Q. 2. Was your partnership the defendant in the suit in the Federal court in this district, I. T. S. Rubber Company against the H. H. Hackman Leather Company?

A. Yes.

Q. 3. When you were notified of this suit did you notify anyone else about the matter, if so, whom?

A. Well, we wired the Essex Rubber Company, we had been sued by the I. T. S. Rubber Company.

Q. 4. What reply did they make?

A. They replied that they would not defend the suit.

Q. 5. Was anything said with reference to yourselves in the [fol. 501] event of judgment?

A. Well, they said we could defend the suit if we wished, as I recall.

Q. 5a. [Question repeated.]

A. Why they said that they would reimburse us for any costs or damage.

Q. 6. Did they do so?

A. When we got the bill from the Federal court we advised the Essex Rubber Company and they told us they would pay it direct to the clerk of court.

Q. 6. Was this done in compliance with their previous promise?

A. I think so.

Q. 8. Did you or did you not rely on that promise?

A. Yes, we did.

Q. 9. And as a result did you take any steps to defend the suit?

Mr. Whittemore: Objected to as leading.

A. No.

Q. 10. Have you any correspondence between yourselves and the Essex Rubber Company that you can produce bearing on this suit in question?

A. Yes, I have got some correspondence here relative to the suit and the payment of the costs.

Q. 11. Where did you take these letters from?

A. Our letter files.

Q. 12. Were these letters sent or received in the regular course of business or not?

A. Yes.

Q. 13. There is a letter dated July 15th, 1920, over the name of H. H. Hackman Leather Company; another one, date October 30, 1919, over the same name. Do you know anything about those letters as to where they came from?

A. Now, one was written by H. H. Hackman, Sr., the letter of July 15th, and the letter of October 30th was dictated by myself; and sent to the Essex Rubber Company.

Q. 14. These letters then are not the originals?

A. Well, these are copies of the originals.

Q. 15. How long have you dealt with the Essex Rubber Company?

A. I would say off and on for perhaps six years.

Q. 16. Do you know Mr. C. C. Tucker?

A. No, I do not.

Q. 17. These other letters in this group, where did they come [fol. 502] from and to whom?

A. From the Essex Rubber Company to the H. H. Hackman Leather Company.

Q. 18. I don't find a copy of the wire which you say you sent to the Essex Rubber Company among these papers, have you a copy of that telegram?

A. I haven't got it with me; no.

Q. 19. Do you know where it is?

A. Why it should be among those papers. It is possible that it is lost or has gone astray.

Q. 20. Have you made an effort to locate it?

A. I had the girl look through the files, but she could not find it.

Mr. Fales: The letters produced by the witness are offered in evidence and the notary is requested to mark the same with the title of this case, "Plaintiff's Exhibit 11, Letters Between Essex Rubber Company and H. H. Hackman Leather Company," numbered 1 to 5, inclusive.

[Opposing counsel is requested to produce the original copies of these letters, which the witness has testified were sent to the Essex Rubber Company.]

Mr. Whittemore: I object to the introduction of these letters as exhibits on the ground that they are incompetent, immaterial and irrelevant. I have made no objection which necessitates the production of the originals, but have with me copies of these letters as heretofore presented to the court in Boston.

Q. 21. Did you have any communications here in Cleveland with any representatives of the Essex Rubber Company during the pendency of the suit?

A. No.

[Direct examination closed.]

Cross-examination by Mr. Whittemore:

X Q. 22. Did the Essex Rubber Company or any of its representatives have anything whatsoever to do with the conduct of the suit brought against you by the I. T. S. Rubber Company?

A. No.

X Q. 23. Are you now selling any heels made by the Essex Rubber Company?

A. I believe our branch store, the Market Leather Store, are handling some Essex heels.

X Q. 24. What type of heels are those?

A. Full heels, I believe.

[fol. 503] X Q. 25. Aside from that you are not handling any other products of that company?

A. We don't at the main store and I don't believe they do at the Market store.

X Q. 26. As a matter of fact, you never handled but a very few pairs of old style tite-edge heels, did you?

A. That's true.

X Q. 27. Merely one order.

A. I cannot state as to that.

X Q. 28. Do you know whether you ever carried them in stock?

A. Yes, we had some in stock.

X Q. 29. Just prior to the commencement of the suit against you by the I. T. S. Rubber Company did you not request the Essex Company to send you two pairs of every style, type, size and color of heel which they manufactured?

A. I don't recall that we did.

X Q. 30. This might have been done without your knowledge, might it not?

A. Yes, sir.

X Q. 31. You ordinarily take care of the orders to manufacturers?

A. No.

X Q. 32. You sell I. T. S. heels?

A. Yes.

X Q. 33. Have you or any member of your firm, to your knowledge, any financial interest in the I. T. S. Rubber Company?

A. Yes.

X Q. 34. How was the settlement arrived at in this suit against you by The I. T. S. Company?

A. I do not know. I did not appear.

X Q. 35. As far as you know it was adjusted amicably, was it not?

Mr. Fales: The record is the best evidence of what occurred in the suit.

A. Well, I had in mind the court costs being the subject now. As far as the suit against us by The I. T. S. Rubber Company, the only thing that I know is that we did not defend this, as I understand judgment was taken against us.

X Q. 36. You have stated that you were advised by the Essex Company that they would not defend the suit. Did you communicate this information to anyone, and if so, to whom?

A. I don't recall. Not that I know of.

[fol. 504] Mr. Whittemore: I object to the entire deposition as immaterial and irrelevant and not relating to any issue pleaded.

[Cross examination closed.
Deposition closed.]

Mr. Fales: Notice is hereby served that an adjournment is taken, pursuant to the notice, to Elyria, Ohio, Friday, 10 a. m., 1000 Bank building, at the offices of Richey, Slough & Fales.

[Notice is also served that plaintiff propose to produce as witness Mr. F. M. Slough.]

Mr. Whittemore: For personal reasons which I have explained to Mr. Fales, I may not be able to be present in Elyria on Friday, and if I am not there I request Mr. Fales to send me that day, if possible, copies of the depositions taken and agree to produce the witnesses for cross-examination on Wednesday next, at Elyria, if I advise him that I desire to cross-examine; and also agree that I may note on the record any objections which I may think proper.

Mr. Fales: It is so agreed, provided plaintiff has the right, if he deems it necessary, after the objections are interposed, to further examine the witness.

Mr. Whittemore: That is satisfactory.

[It is hereby stipulated by and between counsel for the respective parties that the signatures of the witnesses whose depositions have been taken today, namely, the witnesses Thomas J. Urbansky and H. H. Hackman, Jr., are waived.]

Mr. Fales: Mr. Whittemore, do you agree that Plaintiff's Exhibit 11 may be handled the same as Plaintiff's Exhibit 10, with respect to substituting photostatic copies for the originals?

Mr. Whittemore: I make no objection.

[fol. 505] Examination of witnesses de bene esse, beginning on the twenty-eighth day of September, 1922, on behalf of the plaintiff, before me, Clara V. Wharton, a notary public for the State of New Jersey and county of Mercer, at 143 East State street, Trenton, New Jersey, pursuant to a notice given to defendant, a copy of which notice is hereto annexed, in a certain suit now pending and undetermined in the District Court of the United States, as above entitled.

Met pursuant to above notice.

Present: Lucius C. Varney, Esq., and Manvel Whittemore, Esq., for defendant; F. O. Richey, Esq., for plaintiff.

Deposition of C. C. Tucker

C. C. Tucker, a witness produced on behalf of the plaintiff, was duly cautioned and sworn.

Direct examination by Mr. Richey:

Q. 1. Please state your name, age, residence and present occupation?

A. C. C. Tucker; forty-nine; residence, Trenton, New Jersey; employee, Essex Rubber Company.

Q. 2. You are sales manager of the Essex Rubber Company?

A. Of the shoe findings department.

Q. 3. That includes rubber heels?

A. Yes.

Q. 4. How long have you been in charge of sales of rubber heels for the Essex Rubber Company?

A. About eight years.

Q. 5. I show you an advertisement on page 2 of "Shoe Repair Service" for July, 1921; was this advertisement issued by the Essex Rubber Company?

A. Yes, sir.

Q. 6. What was the date of its issue?

A. I take it, in the month of July, 1921.

Q. 7. That is, the date of the issue of the journal?

A. Yes.

[Counsel for complainant offers journal in evidence, which is marked "Plaintiff's Exhibit, Shoe Repair Service, July, 1921." [fol. 506] It is agreed that the exhibits may be kept by the party first producing them, subject to inspection at any time by the opposing party.]

Q. 8. I call your attention to another advertisement by the Essex Rubber Company, on page 2 of "Shoe Repair Service," March, 1922; was that issued by the authority of the Essex Rubber Company, the defendant in this case?

A. Yes.

Q. 9. When was that issued; March, 1922?

A. Yes.

[Counsel offers in evidence journal referred to, which is marked "Plaintiff's Exhibit Shoe Repair Service, March, 1922."]

Q. 10. I call your attention to the advertisement, on page 116, of the journal, marked "S. H. Frank & Company, 1922, and 1923"; was that advertisement issued by and under the authority of the Essex Rubber Company, the defendant in this case?

A. I cannot say who wrote the copy; apparently this is put out by the jobber issuing this catalogue.

Q. 11. What part did your company take in the issue of this advertisement?

A. I don't know; but we didn't pay for it; and I assume that the jobber put it in himself, of his own accord.

Q. 12. Did your company furnish the cuts, and consent to its being published?

A. We no doubt furnished the cuts.

Q. 13. Did you furnish the printed matter, the phraseology of the words regarding the heels?

A. I would have to look that up before answering positively in regard to this copy; they have all the information, and make their own prices; the only thing we could have written for this, would be that line [indicating]; but I would have to look it up, before answering positively.

Q. 14. Will you look it up, and let us know?

A. Yes, sir.

Q. 15. I call your attention to the facsimile of Plaintiff's Exhibit Shoe Findings in this case; there is illustrated at the bottom of this advertisement, a flat heel, is there not?

A. Yes.

Q. 16. Was your company in the business of manufacturing flat heels before they began the manufacture of concave convex heels?

A. Yes.

[fol. 507] Q. 17. What heel is illustrated in the top part of this facsimile?

A. The tite-edge brand.

Q. 18. The same heel as illustrated in the top part of the print on the next page, Plaintiff's Exhibit Shoe Repair, is it not?

A. Yes.

Q. 19. And the same heel as illustrated on page 2 of each of the exhibits Shoe Repair Service, March, 1922, and Shoe Repair Service, July, 1921?

A. Yes.

Q. 20. I call your attention to Plaintiff's Exhibit 3; is that your signature at the end of the letter?

A. Appears to be, yes, sir.

Q. 21. Was the letter written by you?

A. Yes, sir; I wrote this letter.

Q. 22. When?

A. Presumably the date that shows on it.

Q. 23. And mailed it about that time?

A. Yes, sir.

Q. 24. I now call your attention to Plaintiff's Exhibit 2, and to the following letters in Plaintiff's Exhibit 8:

Letter of January 5, 1920.
Letter of April 13, 1920.
Letter of April 14, 1920.
Letter of April 16, 1920.
Letter of April 19, 1920.
Letter of April 20, 1920.
Letter of April 26, 1920.
Letter of May 1, 1920.
Letter of July 16, 1920.
Letter of October 11, 1920.

Is that your signature at the end of each of these letters?

A. The following letters bear my signature:

Letter of January 5, 1920.
Letter of April 13, 1920.
Letter of April 14, 1920.
Letter of April 16, 1920.
Letter of April 19, 1920.
Letter of April 20, 1920.
Letter of April 26, 1920.
[fol. 508] Letter of May 1, 1920.
Letter of July 16, 1920.
Letter of October 11, 1920.

Q. 25. Did you write each of the letters referred to in the next preceding answer, about the time of the dates of the letters, and mail the same about those dates?

A. Presumably, yes, sir.

Q. 26. I will now ask you if you issued and sent the following telegrams, about the time of the dates thereon, each constituting a part of Plaintiff's Exhibit 8:

Telegram of April 7, 1920.
Telegram of April 9, 1920.
Telegram of July 7, 1920.

[Defendant's counsel concedes that the telegrams in question were sent to the persons to whom they were addressed, on or shortly after the dates which they bear.]

Q. 27. I call your attention to a number of copies of letters and telegrams already introduced in evidence, as follows:

Plaintiff's Exhibit 5—Telegram of April 16, 1920, to the Essex Rubber Company, from Jones and Roser.
Plaintiff's Exhibit 4—Telegram of April 12, 1920, to the Essex Rubber Company, from Jones and Roser.

Also the following letters and telegrams constituting part of Plaintiff's Exhibit 8:

Telegram of April 6, 1920, from Wentz to Tucker.
Letter of April 15, 1920, Wentz to Tucker.
Letter of April 21, 1920, to Tucker.
Letter of April 24, 1920, to Tucker.
Letter of April 29, 1920, to Tucker.
Night letter, July 6, 1920, from Wentz to Essex Rubber Company.
Letter of July 26, 1920, to Tucker.
Letter of September 29, 1920, Wentz to Case.
Letter of October 16, 1920, to Tucker.

And the following, of Plaintiff's Exhibit 10:

[fol. 509] Letter to Essex Rubber Company from Urbansky, January 29, 1920.
Letter to Essex Rubber Company from Urbansky, June 15, 1920.
August 3, 1920, from Urbansky to Essex Rubber Company.
August 6, 1920, Urbansky to Essex Rubber Company.

August 16, 1920, Urbansky to Essex Rubber Company.
July 15, 1920, Hackman to Essex Rubber Company.
October 30, 1919, Hackman to Essex Rubber Company.

Will you state whether or not the Essex Rubber Company received copies of the letters and telegrams to which I have referred?

[Defendant's counsel concedes that the telegrams and letters in question were received by the Essex Rubber Company on or shortly after the dates which they bear.]

Q. 28. I call your attention to a letter of July 29, 1920, constituting part of Plaintiff's Exhibit No. 9, from the Essex Rubber Company, the name of C. C. Tucker typewritten thereunder addressed to Emery, Varney, Blair and Hoguet, 149 Broadway, New York City. Did you write a letter, and mail the same on or about that date, in accordance with this copy?

A. I guess I did.

Q. 29. I call your attention to the letters, Plaintiff's Exhibit 10, which bear your signature. Were these letters written and mailed by you to the parties to whom they are addressed, about the time of the dates of the same?

A. Yes, sir.

[It is conceded that the letter of April 19, 1920, addressed to Wentz & Company, and signed by Essex Rubber Company, C. H. Oakley, president, and constituting a part of Plaintiff's Exhibit 8, was written and mailed by Mr. Oakley about April 19, 1920.

Defendant's counsel concedes that the letter of September 27, 1920, from the Essex Rubber Company, L. A. Case, to Wentz & Company, constituting part of Plaintiff's Exhibit 8, was written and mailed by Mr. Case about September 27, 1920.]

Q. 30. Emery, Varney, Blair and Hoguet were the attorneys for [fol. 510] the Essex Rubber Company during 1920, with regards to the suits of The I. T. S. Rubber Company v. H. H. Hackman Leather Company, Thomas Urbansky & Sons Company, Wentz & Company, Jones and Roser and John Piatek & Company; were they not?

A. They are our attorneys on all matters pertaining to patent matters.

Q. 31. And were at that time?

A. Yes.

Q. 32. By "our" you mean the Essex Rubber Company?

A. Yes.

Q. 33. Will you now produce any and all other correspondence, including telegrams, which you or the Essex Rubber Company have, which passed between you and the H. H. Hackman Leather Company, Wentz & Company, Thomas Urbansky & Sons Company, Jones & Roser and John Piatek & Company, between October 20, 1919 and January 1, 1920?

[Defendant's counsel objects to the production of any such correspondence by the witness, which is dated later than the respective

default decrees in each of these cases, on the ground that it is immaterial and irrelevant.]

A. I believe that is all; I have searched the files lately, but I will make another search and see if I can find anything. I believe that the files in those cases were delivered to our attorneys, Emery, Varney, Blair and Hoguet a year or so ago.

[Counsel for plaintiff calls upon counsel for defendant, to produce the correspondence.

Defendant's counsel states that he will procure the files, if any there are, from his office in New York, and deliver the same to the witness, who may then search them and respond to the last question he was asked.]

By Mr. Varney:

Q. 34. May I ask when?

A. I will return any files belonging to the Essex Rubber Company, which I may have, some time within the next week.

Q. 35. Will you produce all of the correspondence that passed between you or the Essex Rubber Company and Emery, Varney, Blair and Hoguet, with regard to the suits of The I. T. S. Rubber Company v. H. H. Hackman Leather Company, Thomas Urbansky & Sons Company, Wentz & Company, Jones & Roser and John [fol. 511] Piatek & Company?

A. I will have to be guided by advice of counsel as to that.

Q. 36. Do you refuse to answer the preceding question?

A. I have answered it. I don't think my answer constitutes a refusal, Mr. Richey.

Q. 37. Do you refuse to produce it?

A. No, sir.

Q. 38. Will you produce it then?

A. I can only repeat that I think that should properly rest in the hands of the attorneys of the Essex Rubber Company.

Q. 39. They are here; will you consult with them, and state whether or not they are willing to have you produce this correspondence?

[Defendant's counsel objects to the question, and states on the record, that until some correspondence has turned up, he declines to pass upon the question either way.]

Q. 40. I notice that some of the advertisements which you have identified, are signed by Essex Rubber Company, and others by Essex Rubber Company, Inc. Are these two the same company?

A. Yes.

Q. 41. Was there a reorganization, or just a change of name?

A. I think that is simply a mistake which occurs here and there. The Essex Rubber Company, Inc., I believe it has been since its inception; since it started business.

Q. 42. There has been no sale of the assets, of one company to the other, or anything of that kind?

A. No, just that sometimes they forgot to put down "Inc.," but it is the only company.

Q. 43. I suppose these various advertisements illustrated the concavo convex rubber heels that were being sold by the Essex Rubber Company, at or about the time the advertisements were issued?

A. I could not say as to that. Some of the cuts or electrotypes might have been issued after we had ceased to manufacture the particular shape.

Q. 44. Well, look at this one on "Shoe Repair Service, July 21," page 2. Can you say whether or not that one illustrates the type of heel being made and sold by the Essex Rubber Company that time, [fol. 512] July, 1921?

A. As far as that illustration would show, yes, to the eye.

Q. 45. And would the same be true of that illustrated in "Shoe Repair Service, March, 1922"?

A. Probably the same cut, but neither show anything except the face side of the heel.

Q. 46. Does the descriptive matter in those two journals, "Shoe Repair Service, March, 1922" and "Shoe Repair Service, July, 1921," describe the concavo convex tite-edge rubber heel made and sold by the Essex Rubber Company, at the dates of the issues of those journals?

A. Yes, I think so.

[Direct examination closed.]

Cross-examination by Mr. Varney:

X Q. 47. Referring to these two advertisements, that dated July, 1921, and that dated March, 1912, will you state whether the heels there advertised and intended to be illustrated, are heels of the same construction as the heels you were intending to advertise and illustrate in your April 1, 1918, advertisements and other advertisements appearing about that time?

A. No.

X Q. 48. Do you recall having seen and examined the heels filed as exhibits with the bill of complaint in this suit against Essex Rubber Company?

A. I don't remember.

X Q. 49. You don't remember seeing them?

A. No.

X Q. 50. I call your attention to your letter of January 5, 1920, to Jones & Roser (Plaintiff's Exhibit No. 2), in which you state that "We will, to meet the broad interpretation which the courts have given the I. T. S. patent, go into production on the Improved Tite-Edge Heel, and supply some to our trade as soon as possible, in place of our present Tite-Edge Heel." What heel were you referring to in that statement as "Improved Tite-Edge Heel"?

Mr. Richey: In asking this question, counsel for defendant makes the witness his own. He was not interrogated regarding the conetnts of the letter, during direct examination.

A. I referred to the tite-edge heel that we are now manufactur-[fol. 513] ing, and were preparing at that time, as rapidly as possible to manufacture.

X Q. 51. Can you produce a sample of that heel, and will you do so?

A. I can, and I do. [Witness produces heel.]

[Heel produced by witness, offered in evidence and marked by notary "Defendant's Present Tite-edge Heel."]

X Q. 52. Can you state about when defendant commenced to produce this type of tite-edge heel?

Mr. Richey: I make the same objection as before. In asking this question, counsel for defendant makes the witness his own.

A. I think about a month or two after that letter was written—in shipable quantities.

X Q. 53. I note that the heel is marked with a patent date—January 14, 1919. Do you recall who the patentee of the patent corresponding to that date, is?

Mr. Richey: I make the same objection as before. In asking this question, counsel for defendant makes the witness his own.

A. A man by the name of Troiano.

X Q. 54. Do you recall the circumstances which led up to the putting out of this heel under the Troiano patent?

Mr. Richey: I make the same objection as before.

A. Immediately after the decision by the Circuit Court of Appeals in Cincinnati, in the suit of the I. T. S. Rubber Company against the United States Rubber Company, we consulted about the matter, and, as I remember it, we decided to follow that decision as closely as possible, and were unable to tell whether under that decision the heel we were then making might be within the Tufford patent, and so we decided to change our heel and make one which would follow the lines of that decision.

X Q. 55. And that resulted in the production of your new type of heel?

Mr. Richey: I make the same objection as before; the question also is leading.

A. Yes.

X Q. 56. Did the defendant have any dealings with Troiano?

Mr. Richey: I make the same objection as formerly.

[fol. 514] A. The company arranged with Troiano to acquire the right to manufacture the heels under his patent.

X Q. 57. And how soon did all that follow upon the decision of the Court of Appeals of Cincinnati to which you have just referred?

A. Almost immediately after the knowledge of the decision reached us.

X Q. 58. Did you make new moulds for these new heels?

A. Yes.

X Q. 59. Were your old moulds unusable for that purpose, to any extent?

A. As to that, I would not say positively; there may have been some material which could be salvaged.

X Q. 60. Did you retain any of the moulds that were used to make the old heels after you devised this new design?

A. No; none.

X Q. 61. Were they scrapped?

A. Either scrapped or material partly used perhaps.

X Q. 62. How long did that change take, roughly?

A. I do not remember exactly, but it took quite a few months altogether to get all of the work done.

X Q. 63. Would you say by June 1, 1920, the change was substantially completed?

A. To the best of my recollection, it was probably nearly finished by that date.

X Q. 64. Did you work as fast as you could?

A. Yes, sir.

X Q. 65. Do you recall, roughly, what the expense was of changing and substituting the moulds?

Mr Richey: Objected to as immaterial, and as not germane to the direct examination.

A. The expense was very heavy, because at that time the cost of both material and labor was probably at its highest peak, as I remember it.

X Q. 66. Can you give any estimate at all, in figures?

Mr. Richey: I make the same objection as to the previous question.

A. Probably around $25,000.

X Q. 67. Has the defendant any moulds whatever for moulding [fol. 515] what has been called the concavo convex heel other than the moulds which follow this present design?

A. No, sir.

X Q. 68. Have they ever had, since this change you have just referred to as completed?

A. No, sir.

X Q. 69. Were you present in Detroit at the time testimony was taken in this case, when Wentz and Mr. Kemp gave depositions?

A. I was there, but I do not know that I was there all of the time.

X Q. 70. Did you hear some of that testimony?

A. Yes.

X Q. 71. Do you recall that they referred to Mr. Whittemore's coming to Detroit shortly after Wentz was sued, to discover whether any of the heels complained of in that suit, were of the defendant's new type of heel?

A. Yes.

X Q. 72. What did you understand that new type of heel was, to which Mr. Wentz and Mr. Kemp referred in their depositions?

A. The Troiana heel, the same as we manufacture now, and have since that time.

X Q. 73. That is, like the heel, a sample of which you have produced here today, which has been marked for identification "Defendant's Present Tite edge Heel"?

A. Yes.

X Q. 74. Can you produce a mould, in which the defendant moulds rubber heels such as the sample just referred to by you, and marked for identification "Defendant's Present Tite-edge Heel"?

Mr. Richey: Objected to as immaterial, and on the ground that counsel makes the witness his own.

A. I can and I do.

[Mould produced, which is marked by the notary, for identification "Defendant's Mould.]"

X Q. 75. Referring to the top piece of the mould, upon which appears the parts of the mould which form the upper part of attaching the faces of the heels, will you state, if you know, how this upper part of the mould was produced by the defendant?

A. These rams are placed on a solid of metal plate, which has been planed to uniform thickness, and then the surface of the rams is [fol. 516] planed, so that they are parallel with the base to which they are attached—both upper and under surface.

X Q. 76. Are you able to see the marks of the planing machine on the mould and on the upper faces?

A. They appear to be the planing machine marks that I see.

Redirect examination by Mr. Richey:

Q. 77. You came here in response to a subpœna, did you not?

A. Yes.

Q. 78. Your company makes, and has made, heels like the Troiano heel in various sizes and colors, does it not?

A. Yes.

Q. 79. You were making these heels in the summer of 1921 and in the spring of 1922?

A. Yes.

Q. 80. Is this the only concavo-convex heel you were making at that time?

A. Yes.

Q. 81. That is, I mean heels like this, except in size and color?

A. Yes.

Q. 82. In making heels in the mould which has been produced and marked for identification here as "Defendant's Mould", you put the rubber biscuit on top of the pins, and then put on the top plate?

A. Yes.

Q. 83. And then put it in the mould and vulcanize it?

A. Yes.

Q. 84. Mr. Varney asked you about your statement made in the letter Plaintiff's Exhibit 2, to the effect that the Troiano heel was an improvement over the other heel. In what way was it an improvement?

A. It was an improvement over the heel which was developed at the breast side, because it took away the pressure from that side. I could give you an explanation of the why of that if it would be interesting.

Q. 85. Who was present at the consultation when it was decided to make these heels?

A. I think Mr. Oakley, Mr. Varney and myself.

[Examination closed.]

It is stipulated by and between the parties, that if E. D. Fales were called as a witness for plaintiff, he would testify as follows:

[fol. 517] "I am the E. D. Fales who has testified in this case before. I represented the plaintiff in the case of The I. T. S. Rubber Company v. Thomas Urbansky & Sons Company, in the United States District Court, for the Northern District of Ohio, Eastern Division. I was familiar with the exhibits in that case and I identify the bunch of heels now in evidence in the case at bar, as 'Plaintiff's Exhibit Urbansky Heels', as the identical heels which were charged to infringe, in the said Urbansky case. These heels were withdrawn by me from the clerk's office in Cleveland, and were in my possession until offered in evidence in the case at bar."

The parties hereby waive the signature of the witness, and the certificate.

In United States District Court

Motion to Amend Bill of Complaint and Amendment Thereto —Filed August 17, 1922; Allowed September 7, 1923, as of October 25, 1922

Now comes the plaintiff and moves to amend its bill of complaint as follows:

Cancel the paragraph 6 of the bill of complaint, including the amendements thereto, and substitute:

(6) And plaintiff further shows that the plaintiff recovered a decree on said Letters Patent in suit in the District Court of the United States for the Northern District of Ohio, Eastern Division, against Fetzer & Spies Leather Company, which decree was sustained by the United States Circuit Court of Appeals for the Sixth Circuit (260 Fed. 939); and the plaintiff did recover a decree upon said Letters Patent here in suit in the District Court of the United States for the Northern District of Ohio, Eastern Divsion, against United States Rubber Company, which was sustained by the United

States Circuit Court of Appeals for the Sixth Circuit (260 F. R. 947); and thereafter the plaintiff did recover a decree upon said Letters Patent in suit in the District Court of the United States for the Northern District of Ohio, Eastern Division, against the Hill Rubber Heel Company, which decree was sustained by the United States Circuit Court of Appeals for the Sixth Circuit (269 [fol. 518] F. R. 270); and thereafter the plaintiff did recover a decree upon said Letters Patent in suit in the District Court of the United States for the Northern District of Ohio, Eastern Division, against the Tee Pee Rubber Company, Inc., which decree was reversed by the United States Circuit Court of Appeals for the Sixth Circuit, which court found said patent uninfringed (268 F. R. 250); and still another decree upon said Letters Patent in suit in the District Court of the United States for the District of Rhode Island against United Lace & Braid Manufacturing Company (266 F. R. 375); and the plaintiff did recover a decree upon said Letters Patent in suit in the District Court of the United States for the Northern District of Ohio, Eastern Division, against the Elyria National Rubber Heel Company, which was reversed by the Circuit Court of Appeals for the Sixth Circuit, which coudt found said patent uninfringed (263 F. R. 979), and the plaintiff did thereafter recover a decree upon said Letters Patent in suit in the District Court of the United States for the Northern District of Illinois, Eastern Division, against United States Rubber Company (278 F. R. 975).

The plaintiff herein did, about February 25, 1920, file its bill of complaint in the United States District Court for the Eastern District of Michigan, Southern Division, against Walter Wendt, doing business as Walter Wendt & Company, alleging infringement of claims five (5) to nine (9), inclusive, of the Tufford reissue patent No. 14,049 here in suit, by said Wendt, by the sale of Essex Tite-Edge heels exactly like (except perhaps as to size and color) Plaintiff's Exhibit No. 1, Defendant's Heels, and asking for the relief usually asked for in patent cases. Essex Tite-Edge heels exactly like those constituting Plaintiff's Exhibit No. 1, Defendant's Heels, here (except perhaps in size and color) were exhibits in the Wendt case.

Plaintiff avers that the Essex Rubber Company assumed the entire charge of such suit, controlled and maintained such suit until entry of final decree, about November 1, 1920. Plaintiff avers that the Essex Rubber Company participated in such suit and did agree with said Wendt to, and did, pay all the expenses [fol. 519] thereof, including defendant counsel's expenses and fees, costs and judgment.

After the time when plaintiff was informed and believed the Essex Rubber Company assumed entire control of this suit, an interlocutory pro confesso decree was entered, adjudging the patent valid and infringed, and thereafter the matter was referred to a master for an accounting. Proceedings were had in connection with the accounting and before the master, at which counsel, who, plaintiff avers, was attorney for and in the employ of the Essex Rubber Company, appeared and represented the Essex Rub-

ber Company's interests. Thereafter plaintiff's claim for damages and profits having been adjusted between plaintiff and counsel, who plaintiff was informed and believed, and avers, was attorney for the Essex Rubber Company, final decree was entered about November 1, 1920, adjudging the patent valid and infringed by the sale of such Essex Tite-Edge heels, title in the plaintiff, and ordering the issue of a permanent injunction, and that plaintiff recover in lieu of profits from the sale of Essex Tite-Edge heels the amount agreed upon. And it was agreed, prior to entry of final decree, by counsel for defendant, who plaintiff is and was then informed and believes, and avers, was in the employ of and acting for the Essex Rubber Company, that there would be no appeal from such final decree, and such agreement was executed and filed in court.

Plaintiff was informed of and believed in the exclusive control of the suit by the Essex Rubber Company, its participation in such suit, its contribution thereto and its conduct and maintenance thereof from time to time during the prosecution of the suit and all before the entry of final decree therein, as such actions were done openly by the Essex Rubber Company. Wherefore, in view of the above facts, the Essex Rubber Company, defendant in the case at bar, is concluded and estopped by the judgment in the said Wendt case from contesting each and every issue in the case at bar, and each and every such issue is res adjudicata so far as the defendant here is concerned.

The plaintiff herein did, about February 25, 1920, file its bill of [fol. 520] complaint in the United States District Court for the Eastern District of Michigan, Southern Division, against Jones & Roser, a co-partnership, alleging infringement of claims five (5) to nine (9), inclusive, of the Tufford reissue patent No. 14,049, here in suit, by said Jones & Roser, by the sale of Essex Tite-Edge heels, exactly like (except perhaps as to size and color) Plaintiff's Exhibit No. 1, Defendant's Heels, in the case at bar, and asking for the relief usually asked for in patent cases. Essex Tite-Edge heels exactly like those constituting Plaintiff's Exhibit No. 1, Defendant's Heels, here (except perhaps in size and color) were exhibits in the Jones & Roser case.

Plaintiff avers that the Essex Rubber Company assumed the entire charge of said suit, controlled and maintained such suit until entry of final decree about November 1, 1920. Plaintiff avers that the Essex Rubber Company participated in such suit and did agree with such Jones & Roser to and did pay all expenses thereof, including defendant counsel's expenses and fees, cost and judgment.

After the time when plaintiff was informed and believed the Essex Rubber Company assumed entire control of this suit an interlocutory pro confesso decree was entered, adjudging the patent valid and infringed, and thereafter the matter was referred to a master for an accounting. Proceedings were had in connection with the accounting and before the master, at which counsel, who plaintiff avers was in the employ of the Essex Rubber Company, appeared and represented the defendant. Thereafter plaintiff's

claim for damages and profits having been adjusted between plaintiff and counsel, who, plaintiff was informed and believes, and avers, was employed by the Essex Rubber Company, final decree was entered about November 1, 1920, adjudging the patent valid and infringed by the sale of such Essex Tite-Edge heels, title in the plaintiff, and ordering the issue of a permanent injunction, and that plaintiff recover in lieu of profits from the sale by the defendant, Jones & Roser, of Essex Tite-Edge heels, the amount agreed upon, and it was agreed, prior to the entry of final decree, by counsel for defendant, who, plaintiff is and was then informed and believed, and avers, was in the employ of and acting for the Essex [fol. 521] Rubber Company, that there would be no appeal from such final decree, and such was executed by counsel for plaintiff and by counsel for defendant filed in court.

Plaintiff was informed of and believed in the exclusive control of the suit by the Essex Rubber Company, its participation in such suit, its contribution thereto, and its conduct and maintenance thereof from time to time during the prosecution of the suit and before the entry of final decree therein, as such actions were done openly by the Essex Rubber Company. Wherefore, in view of the above facts, the Essex Rubber Company, defendant in the case at bar, is concluded and estopped by the judgment in the said Jones & Roser case from contesting each and every issue in the case at bar, and each and every issue is res adjudicata so far as the defendant here is concerned.

The plaintiff herein did, about the seventeenth day of October, 1919, file its bill of complaint in the United States District Court of the Northern District of Ohio, Eastern Division, against H. H. Hackman & Company, a partnership, alleging infringement of claims five (5) to nine (9), inclusive, of the Tufford reissue patent No. 14,049, here in suit, by said H. H. Hackman & Company, by the sale of Essex Tite-Edge heels, exactly like (except perhaps as to size and color) Plaintiff's Exhibit No. 1, Defendant's Heels, in the case at bar, and asking for the relief usually asked for in patent cases. Essex Tite-Edge heels exactly like (except perhaps as to size and color) those constituting Plaintiff's Exhibit No. 1, Defendant's Heels, here were filed in the court there.

Thereafter, during the month of October, 1919, the plaintiff moved for a preliminary injunction in the said Hackman case, which was heard about November 8, 1919, by his Honor Judge Westenhaver, to whom were submitted in connection with the motion heels exactly like (except perhaps in size and color) the heel lifts constituting Plaintiff's Exhibit No. 1, Defendant's Heels, in the instant case, which were inspected by his Honor Judge Westenhaver, and a preliminary injunction was granted.

Thereafter, about December 23, 1919, an interlocutory pro con- [fol. 522] fesso decree was entered, and thereafter, about August 7, 1920, a final decree was entered.

Plaintiff avers, that defendant here, the Essex Rubber Company, contributed to the expenses of such suit, paying all such expenses

thereof, and agreeing in advance with H. H. Hackman & Company to pay all of the expenses of said suit. Plaintiff avers that all court costs were paid directly by the defendant in the instant case. All of these acts were done to the knowledge of plaintiff, which was acquired before the entry of final decree.

Wherefore, in view of the above facts, the Essex Rubber Company, defendant in the case at bar, is concluded and estopped by the judgment in the said Hackman case from contesting each and every issue in the case at bar, and each and every such issue is res adjudicata so far as the defendant here is concerned.

Plaintiff here did, about December 7, 1919, file its bill of complaint in the United States District Court for the Northern District of Ohio, Eastern Division, against Thomas Urbansky & Sons Co., of Cleveland, Ohio, alleging infringement of claims five (5) to nine (9), inclusive, of the Tufford reissue patent No. 14,049, here in suit, by said Thomas Urbansky & Sons Co., by the sale of Essex Tite-Edge heels, exactly like (except perhaps as to size and color) Plaintiff's Exhibits Nos. 1 and 2, Defendant's Heels, in the case at bar, and asking for the relief usually asked for in patent cases. Essex Tite-Edge heels exactly like those constituting Plaintiff's Exhibits Nos. 1 and 2, Defendant's Heels, here (except perhaps as to size and color) were filed in the court there.

Plaintiff avers, that the Essex Rubber Company, the defendant here, paid all of the expenses of the said Urbansky suit, and that Urbansky took no steps therein without consulting the Essex Rubber Company and obtaining their direction with regard to said suit, and further that the Essex Rubber Company agreed with Urbansky to pay all of the expenses of such suit directly after the suit was instituted.

About January 28, 1920, an interlocutory pro confesso decree was entered in the said Urbansky suit, adjudging the patent valid and infringed, and thereafter the matter was referred to a master [fol. 523] for an accounting. Proceedings were had in connection with the accounting and before the master, and plaintiff's claim for damage and profits having been adjusted, final decree was entered about August 7, 1920.

Plaintiff was informed of the control of the suit by the Essex Rubber Company and its contribution thereto prior to the entry of final decree therein, as such actions were done openly by the Essex Rubber Company.

Wherefore, in view of the above facts, the Essex Rubber Company, defendant in the case at bar, is concluded and estopped by the judgment in the said Urbansky case from contesting each and every issue in the case at bar, and each and every issue is res adjudicata so far as the defendant here is concerned.

Frederick A. Tennant, Solicitor for Plaintiff. F. O. Richey, Counsel for Plaintiff.

Sworn to by John G. Tufford. Jurat omitted in printing.

In United States District Court

Stipulation re Motion to Amend Complaint—Filed September 4, 1923

It is stipulated by and between counsel for the respective parties that the motion to amend the bill of complaint, which includes the amendment thereto, filed on August 17, 1922, and the stipulated [fol. 524] order of October 25, 1922, annexed hereto, allowing such motion to amend the bill of complaint, be entered nunc pro tunc, and that said motion and order may be certified to the Circuit Court of Appeals of the First Circuit as a part of the transcript of record on appeal, and that such other orders may be entered as will make the aforesaid motion to amend and order allowing the amendment a part of the transcript of record on appeal.

Frederick A. Tennant, Counsel for Plaintiff. Frederick L. Emery, Counsel for Defendant.

In United States District Court

Order to Amend Bill of Complaint—September 7, 1923, as of October 25, 1922

It is hereby ordered that the plaintiff be permitted to amend its bill of complaint in accordance with plaintiff's motion to amend the bill of complaint now pending and undetermined in this court.

George H. Bingham, United States Circuit Judge.

We assent to the entry of the above order.

Frederick A. Tennant, Counsel for Plaintiff. Frederick L. Emery, Counsel for Defendant.

In United States District Court

Clerk's Certificate

United States of America,
District of Massachusetts, ss:

I, James S. Allen, Clerk of the District Court of the United States for the District of Massachusetts, certify that the foregoing are true copies of the deposition of Edward D. Fales, filed November 29, 1920; depositions of Richard S. Jones, Walter Wendt, Edward G. Kemp, W. W. Wicker, Wilson W. Mills, Thomas J. Urbansky and H. H. Hackman, Jr., filed December 1, 1920, and deposition of C. C. Tucker [fols. 525 & 526] and stipulated testimony of E. D. Fales, filed October 7, 1922; and of the motion to amend bill of complaint and

amendment to bill, filed August 17, 1922, and allowed September 7, 1923, as of October 25, 1922; and of the stipulation and order permitting amendment to the bill of complaint, entered September 7, 1923, as of October 25, 1922; in the cause in equity entitled, No. 1008, The I. T. S. Rubber Company, Plaintiff, v. Essex Rubber Company, Defendant, in said District Court determined.

Said depositions, motion to amend bill of complaint and amendment to bill, and stipulation and order are certified for the purpose of being made part of the transcript of record in the above-entitled case, already filed in the United States Circuit Court of Appeals for the First Circuit on the ninth day of June, A. D. 1923.

In testimony whereof, I hereunto set my hand and affix the seal of said District Court at Boston, in said District, this twelfth day of September, A. D. 1923.

James S. Allen, Clerk. (Seal.)

[fol. 527] In United States Circuit Court of Appeals for the First Circuit, October Term, 1924

No. 1642

The I. T. S. Rubber Company, Plaintiff, Appellant,

v.

Essex Rubber Company, Defendant, Appellee

Appeal from the District Court of the United States for the District of Massachusetts

Before Johnson, Morris and Lowell, JJ.

Opinion—October 23, 1924

Johnson, J.:

This is a patent infringement suit which has been before this court once before on a motion to dismiss which had been granted by the District Court for Massachusetts. Upon the record then before us we reversed the decree of the District Court and the case has since been heard upon its merits. The District Court has decided that, upon its merits, the bill of the plaintiff should be dismissed and from that decree an appeal has been taken.

The bill charges infringement of reissue letters patent No. 14,049, applied for June 22, 1915, and issued January 11, 1916, to the plaintiff as assignee from John G. Tufford, to whom the original patent No. 1,110,730 was issued September 15, 1914, on an application filed July 21, 1912.

[fol. 528] The patent covers a cushion lift for a shoe heel. The original patent contained four claims, all of which appear in the reissue patent with six additional claims. Infringement is charged of five of these additional claims, which are as follows:

"5. A heel lift of substantially non-mentallic resilient material having its body portion of concavo-convex form on every line of cross section, the concave upper face lying entirely below a plane passing through the rear upper edge and the breast corners of the lift.

"6. A heel lift of substantially resilient material having its body portion of concavo-convex form on every line of cross section, the concave upper face lying entirely below a plane passing through the rear upper edge and the breast corners of the lift, said lift being provided with nail receiving openings located near the center thereof.

"7. A heel lift of substantially resilient material comprising a body portion, the attaching face of which is concave and the tread face of which is convex on every line of cross section and normally held in such form by its own inherent resiliency, the concave attaching face lying entirely below a plane passing through the rear upper edge and the breast corners of the lift, whereby to cause the entire margin of said lift to exert a uniform pressure on the heel of a shoe when said lift is positioned on the heel and the convex tread face thereof depressed to flatten said lift.

"8. A heel lift of resilient material comprising a body portion of uniform thickness throughout its entire area and of concavo-convex form on every line of cross section, the concave upper face of the lift lying entirely below a plane passing through the upper edge and the breast corners of said lift.

"9. A heel lift of resilient material comprising a body portion, the attaching face of which is concave and the tread face of which is convex, the concave face of the lift being unbroken and lying entirely below a plane passing through the rear upper edge and the breast corners of the lift, whereby when the convex tread face is depressed to flatten said lift a suction will be created between the lift and the heel to hold the attaching face of the lift throughout its entire extent in contact with the exposed face of the heel."

Defendant in its answer admits that the reissue letters patent [fol. 529] are valid, but denies infringement, averring that by reason of the rejection of claims in the application for the original patent, and for the reissue patent, upon reference to certain prior patents and the acquiescence of the applicant in said rejections, the plaintiff admitted that the reissue patent "did not cover or include every form of resilient heel lift which was 'concavo-convex on every line of cross section'" and that, in addition to the plaintiff's heel being concavo-convex on every line of cross section, the reissue patent contains the further limitation without which the Patent Office refused to allow the claims in issue, viz., that the concave upper face lies "entirely below a plane passing through the rear upper edge and the breast corners of the lift."

The alleged infringing heels of the defendant are shown by two exhibits marked "Plaintiff's Exhibits 1" and "2". In those marked "Plaintiff's Exhibit 1" the attaching surface is made up of a flat,

oval surface from which a bevel portion rises to the side and rear edges and nearly to the breast edge; so that its rear edge and side edges lie within the same plane, making what has been called a "saucer shaped heel."

Exhibit No. 2 is of the same general form except that the center of its breast edge is lower than in Exhibit No. 1 and rises but little above the surface of the central oval plane, making what has been characterized as a "scoop shaped heel."

In substance defendant's contention is that the letters of the reissue patent cover only a heel concavo-convex upon every line of cross section and which, in addition, has its entire concave surface below a plane passing through its breast corners and rear upper edge; that the sides of the defendant's heels are straight and lie in the same plane as the rear upper edge and breast corners and that this distinguishes them from the heel of the plaintiff.

When the case was heard before we said in our opinion, 281 Fed. 5, 9:

"If it should appear that the raised side edges in the defendant's heel do not cause it to function in a different way from the plaintiff's, but simply cause its rear edge and breast corners to function [fol. 530] less perfectly (a matter of degree), we think it should be held to infringe.

"As the defendant's heel may or may not infringe the claims in issue, depending upon whether or not it functions in the way or manner heels constructed in accordance with the requirements of the claims in issue functions, and as this question cannot reasonably be determined on a mere inspection of the heels thus constructed, we think the case should be remanded for trial, unless the defendant is estopped to deny the question of infringement, due to the pro confesso decrees obtained against the dealers in the Sixth Circuit."

We did not then have the record of the proceedings in the Patent Office before us; but at the hearing upon the merits in the District Court the file-wrapper was introduced in evidence. From that it clearly appears that upon the application for the original patent the applicant was denied claims which cover a heel having its upper side edges, breast corners and rear edge in the same plane and that he acquiesced in the rejection of such claims.

The applicant also sought to obtain the allowance of claims covering a heel having a concave attaching face and a convex tread face, and these were denied and their denial acquiesced in by the applicant.

The four claims which were finally allowed upon the original application related to the means of attaching the lift to the heel, the form and position of the washers which were imbedded within it to secure the attaching nails and the suction area of the heel, which was alleged to be increased by slight grooves upon its concave surface, so that, when the lift was applied to the heel of the shoe and its convex side depressed to cause its concave attaching face to be applied to a heel, the atmospheric pressure would tend to prevent the lift from resuming its normal form.

In his application for a reissue patent the applicant states that his original specification was defective and insufficient, that it failed to claim adequately what he had really invented and disclosed, that such error arose from failure of his attorneys to clearly apprehend and point out the true invention made by him; and that, consequently, the claims were restricted to a heel lift in which [fol. 531] washers of a particular form were embedded and to a heel lift in which inter-communicating channels are formed in the attaching face, whereas he did not in fact consider his invention so limited; and that he did not understand and appreciate the scope of the claims of his patent when the same was granted.

The proceedings in the Patent Office clearly disclose that the claims in the original application covering a heel having a concave attaching face and its upper side edges, breast corners and its rear upper edge lying in the same plane were disallowed upon references to prior patents; that he acquiesced in such rejection; and that such acquiescence was not occasioned by inadvertence or mistake. The patent proceedings upon the reissue patent show that applicant again attempted to obtain the allowance of claims for a concavo-convex heel; but these claims were denied upon references to prior patents and he acquiesced in their rejection. The patent which came nearest to that of the applicant was that issued November 6, 1900, to Nerger, and in an attempt to distinguish from this patent the applicant amended his claims so as to call for a heel lift of resilient material—

"comprising a body portion of concavo-convex form on every line of cross section and normally held in such form by its own inherent resiliency."

These amended claims were rejected upon Nerger. The applicant then called attention to the fact that the Nerger lift was not concavo-convex on every line of cross section, as its upper longitudinal edge was represented by a straight line and that the deepest portion of the concavity of its upper surface terminated at the breast of the heel so as to leave an opening there which would prevent the lift from being held on the heel by suction; and that, by reference to the longitudinal sectional view of applicant Nerger's drawing, it would be seen that a true depression or concavity was formed in the attaching face of the lift which extended from the forward edge of the breast of the heel to the rear portion thereof.

The Examiner insisted upon his previous rejection and said:

[fol. 532] "The rubber heel lift of Nerger has an upper surface concave on any line of cross section and a tread surface concentric thereto. His object is to make the edges of the lift closely hug the margin of the heel proper by flattening the spherical arch at the center of the lift and securing such center to the heel by nails."

Applicant then further amended by cancelling claims 5 to 8 inclusive, and substituted therefor present claims 5 to 9 inclusive, calling attention to his drawings, which he claimed showed—

"that the upper concave attaching face of the lift lies entirely below a plane tangent to the rear upper edge and the breast corners of the lift";

He also claimed that the heel lift shown in Nerger had the deepest portion of its concavity in its upper surface at the breast of the heel.

Attention was called to the fact that this was conclusively demonstrated during a recent oral interview with the principal examiner, at which time sample lifts, constructed according to the Nerger patent, and also a set of molds used in making the Nerger lift and specimen lifts of the applicant, were presented to the examiner for his examination. These claims were rejected and attention was called by the examiner to the fact that figure 2 of the applicant's drawing showed that a point midway between the breast corners of the lift was in contact with the heel to which it was applied and that, according to this figure—

"a plane tangent to the rear edge and the breast corners would also pass through the entire front edge of the lift";

He also stated that the sample lift shown to him at the interview did not correspond to the drawing, since—

"all the points of its breast except the two corner points lie below a straight line passing through these points."

"In each of the claims 5, 6, 7, 8 and 9 applicant specifies 'that the concave upper face lies entirely below a plane tangent to the rear upper edge and the breast corners of the lift.'"

These claims were rejected because they did not read on the drawings. The applicant then called attention to figures 2 and 4 [fol. 533] of his drawings, claiming that they demonstrated that the concave upper face of the lift lies entirely below a plane passing through the rear upper edge and breast corners of the lift, and stated:

"Owing to the curvature of the concave attaching face of the lift the rear upper edge and breast corners of said concave attaching face are disposed in a plane above the upper side edges and the breast edges of the lift; that the specification of the original application clearly sets forth that applicant's lift is of concavo-convex form on every line of cross section and that its marginal surface is at all points radial to the center of curvature of its concave side. This statement in the original application shows that the concave attaching face of the applicant's lift is in the form of a true curve."

Permission was asked to change figure 2 of the drawings, which "did not clearly illustrate applicant's invention." This was granted and figure 2 as changed then showed the breast of the lift to be slightly curved. A new claim 10 was then added, showing that the rear upper edge and breast corners of the attaching face of the lift are disposed in a plane above the upper side edges of said attaching face. The claims were then allowed.

The District Court has found that it clearly appears that a mistake was made both by the examiner and the applicant in the omission of the word "rear" before the words "upper edge" in claim 8 of the reissue patent, and it has been strenuously argued before us that this was error as the court is without power to revise the plain, unambiguous language of the claim. That the claim must be read in the light of the specifications and drawings is too well established to need the citation of any authorities.

Under R. S. sec. 4916 a reissue patent can only be granted for the same invention for which the original patent was granted. Mahn v. Harwood, 112 U. S. 354; Parker & Whipple v. Yale Clock Co., 123 U. S. 87. In the latter case the court said at page 98:

"Corrections may be made in the description, specification or claim where the patentee has claimed as new more than he had a right to claim, or where the description, specification or claim is defective or insufficient; but he cannot under such an application [fol. 534] make material additions to the invention which were not described, suggested, nor substantially indicated in the original specifications, drawings, or patent office model."

According to the original specification and drawings of the applicant the upper side edges of the entire concave surface of the Tufford lift do not lie in a plane passing through the breast corners and all the upper edges of the lift; and this was expressly disclaimed by the applicant's attorney. Claim 8 of the reissue patent without the word "rear" before the words "upper edge" is invalid because not for the same invention as described in the original specification and drawings and would have been so found by the Examiner had he not believed, as it clearly appears from the file wrapper he did, that the word "rear" appeared in the claim before the words "upper edge."

While the defendant has admitted the validity of the patent it has in its answer alleged that the scope of the patent is limited by the proceedings in the Patent Office as shown by the file wrapper.

Construing the claim in the light of the specification and drawings, as well as of the proceedings in the Patent Office, we have no doubt that the words "upper edge," used in this claim, refer to the rear upper edge; for, if this were not so, the claim would be invalid. The plaintiff's invention, therefore, is limited to a heel lift concavo-convex on every line of cross section, whose concave face lies entirely below a plane passing through its two breast corners and rear upper edge and is not infringed by the defendant's heels.

The plaintiff also contends that the defendant assumed the control and bore the expense of suits for infringement brought by the plaintiff in the sixth and seventh circuits against jobbers who handled its heels and that the defendant is estopped to contest infringement in this case. The records in those cases and the correspondence between the parties show clearly that the defendant refused to become a party to these suits or in any way to assume control of them, but only agreed that it would hold the parties sued harmless

and would pay whatever damages were assessed against them; and [fol. 535] that it took no part in the conduct or control of the suits, but only in the adjustment of the damages after pro confesso decrees had been entered.

In its opinion the District Court has dealt at great length with the connection of the defendant with all these suits and we approve its findings and its ruling that the defendant is not estopped from contesting the question of infringement in this suit.

The decree of the District Court is affirmed with costs to the appellee.

[fol. 536] On October 5, 1923, this cause came on to be heard, and was fully heard by the court, Honorable Charles F. Johnson, Circuit Judge, and Honorable George F. Morris and Honorable James A. Lowell, District Judges, sitting.

Thereafter, to wit, on the twenty-third day of October, A. D. 1924, the opinion of the court (page 527) was announced and the following Final Decree was entered:

IN UNITED STATES CIRCUIT COURT OF APPEALS

FINAL DECREE—October 23, 1924

This case came on to be heard October 5, 1923, upon the transcript of record of the District Court of the United States for the District of Massachusetts, and was argued by counsel.

Upon consideration whereof, It is now, to wit, October 23, 1924, here ordered, adjudged and decreed as follows: The decree of the District Court is affirmed, with costs to the appellee.

By the Court,

Arthur I. Charron, Clerk.

IN UNITED STATES CIRCUIT COURT OF APPEALS

CLERK'S CERTIFICATE

I, Arthur I. Charron, Clerk of the United States Circuit Court of Appeals for the First Circuit, certify that the printed pages numbered 1 to 536, inclusive, hereto prefixed, contain and are a true copy of the record and all the proceedings to and including December 12, 1924, in the cause in said court numbered and entitled, No. 1642, The I. T. S. Rubber Company, Plaintiff, Appellant, v. Essex Rubber Company, Defendant, Appellee.

In testimony whereof, I hereunto set my hand and affix the seal of said United States Circuit Court of Appeals for the First Circuit, at Boston, in said First Circuit, this twelfth day of December, A. D. 1924.

Arthur I. Charron, Clerk. (Seal of the United States Circuit Court of Appeals, First Circuit.)

[fol. 537] SUPREME COURT OF THE UNITED STATES

On Petition for Writ of Certiorari to the United States Circuit Court of Appeals for the First Circuit

ORDER GRANTING PETITION FOR CERTIORARI—Filed Jan. 12, 1925

On consideration of the petition for a writ of certiorari herein to the United States Circuit Court of Appeals for the First Circuit, and of the argument of counsel thereupon had,

It is now here ordered by this Court that the said petition be, and the same is hereby, granted, the record already on file as an exhibit to the petition to stand as a return to the writ.

No. [redacted] 229

FILED
DEC 29 1924
WM. R. STANSBURY
CLERK

In the Supreme Court of the United States

October Term, [redacted] 1925

272
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The I. T. S. Rubber Company,
Petitioner,

v.

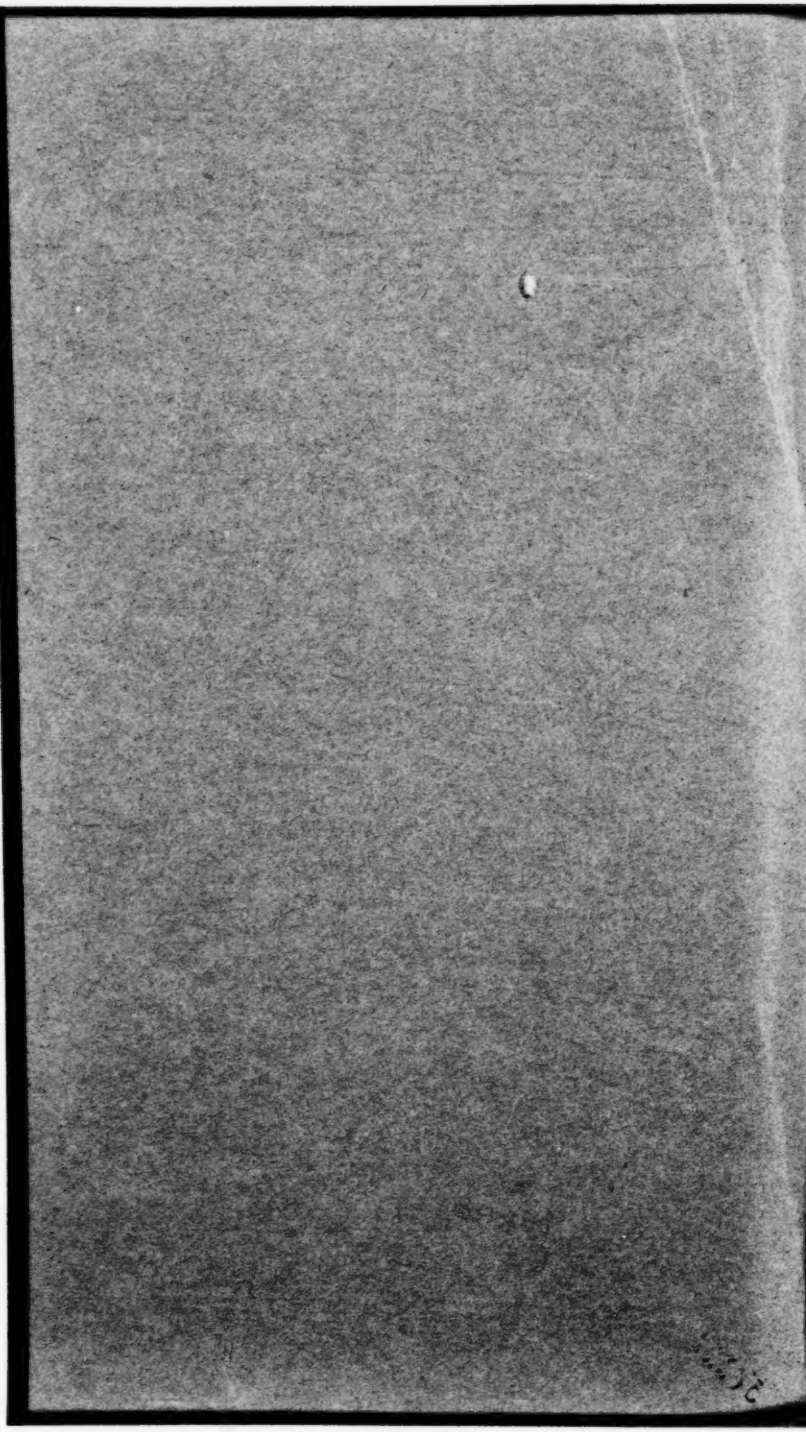
Essex Rubber Company,
Respondent.

On Petition for Writ of Certiorari Directed to the United States Circuit Court of Appeals for the Fifth Circuit.

[redacted]

[redacted]

[redacted]



In the Supreme Court of the United States

OCTOBER TERM, 1924.

THE I. T. S. RUBBER COMPANY,
Petitioner,

vs.

ESSEX RUBBER COMPANY,
Respondent.

ON PETITION FOR WRIT OF CERTIORARI DIRECTED TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE FIRST CIRCUIT.

PETITION FOR WRIT OF CERTIORARI
and
BRIEF IN SUPPORT THEREOF.

MELVILLE CHURCH,
CHARLES A. BROWN,
For Petitioner.

J50226

In the Supreme Court of the United States

OCTOBER TERM, 1924.

THE I. T. S. RUBBER COMPANY,
Petitioner,

vs.

ESSEX RUBBER COMPANY,
Respondent.

NOTICE.

To Essex Rubber Company or Its Solicitors:

Please take notice that upon a certified copy of the transcript of record herein, we shall present the petition for writ of certiorari and the brief in support thereof, hereunto annexed, to the Supreme Court of the United States at the Capitol, in the City of Washington, District of Columbia, on January 5th, A. D. 1925, at the opening of the court on that day, or as soon thereafter as counsel can be heard.

We shall request the Clerk of the Supreme Court to make such presentation and submission for us.

MELVILLE CHURCH,
CHARLES A. BROWN,
Solicitors for Petitioner.

December 17, 1924.

To Frederick L. Emery,
Lucius E. Varney.
Counsel for Respondent.

Service accepted Dec. 17, 1924
Frederick L. Emery

Service of the foregoing Petition and Brief in the above entitled cause is admitted on this 17 day of November, 1924.

Frederick F. Emery

.....

In the Supreme Court of the United States

OCTOBER TERM, 1924.

THE I. T. S. RUBBER COMPANY,

Petitioner,

vs.

ESSEX RUBBER COMPANY,

Respondent.

PETITION FOR WRIT OF CERTIORARI.

To the Honorable, the Chief Justice of the United States and the Associate Justices of the Supreme Court of the United States:

Your petitioner, The I. T. S. Rubber Company, an Ohio corporation, of Elyria, Ohio, owner of the Tufford Reissue Patent No. 14,049, respectfully represents:

FIRST: The ground upon which this petition is based is a direct conflict between final decrees of Courts of Appeals for the First and Sixth Circuits with respect to the Tufford Reissue Patent No. 14, 049.

SECOND: The respondent, Essex Rubber Company, is a New Jersey corporation, and had, when the Bill was filed, a regular and established place of business in Boston, Massachusetts, where it committed the alleged infringing acts.

THIRD: The Sixth Circuit Court of Appeals held a device to infringe claims 5 to 9, inclusive, of the Tufford Reissue Patent No. 14,049. The First Circuit Court of Appeals held, what was admittedly, the same device not to infringe the same claims of the same patent. The record was substantially the same in each case.

FOURTH: Your petitioner has been aggrieved and believes a miscarriage of justice has been caused in this case, because the decisions of the Courts of Appeals in the First and Sixth Circuits are in conflict.

Your petitioner represents that in compliance with the rule of this Court, it has furnished and filed as an exhibit to this petition a certified copy of the record submitted to the Circuit Court of Appeals for the First Circuit and of the proceedings in said court.

Wherefore, your petitioner respectfully prays (1) that a writ of certiorari may be issued out of and under the seal of this Court, directed to the United States Circuit Court of Appeals for the First Circuit, commanding the said Court to certify and send to this Court on a day therein designated, a full and complete transcript of the record and all proceedings in the said Circuit Court of Appeals in the said case entitled *The I. T. S. Rubber Company vs. Essex Rubber Company No. 1642,* to the end that the said case may be reviewed and determined by this Court pursuant to the provisions of the statutes in such cases made and provided; (2) that this Court will stay the action of the Circuit Court of Appeals in the First Circuit until this proceeding is disposed of; (3) that your petitioners may have such other and further relief in the premises as the nature and circumstances of the case may require; (4) and that said judgment of the said Circuit Court of Appeals of

the First Circuit may be reversed by this Honorable Court.

And your petitioners will ever pray, etc.

THE I. T. S. RUBBER COMPANY,
MELVILLE CHURCH,
CHARLES A. BROWN,
Its Solicitors.

STATE OF ILLINOIS,
COUNTY OF COOK, ss:

CHARLES A. BROWN, being duly sworn, says that he is the solicitor and of counsel for The I. T. S. Rubber Company, the petitioner above named, and as such had personal charge for said petitioner of the case in the foregoing petition mentioned in the District Court of the United States for the District of Massachusetts, and in the United States Circuit Court of Appeals for the First Circuit; that he has read the foregoing petition by him subscribed; and that the facts therein stated are true to the best of his knowledge and belief.

CHARLES A. BROWN.

Subscribed and sworn to before me this 4th day of December, 1924.

CLAUDE A. NELSON,

(Notarial Seal) *Notary Public.*

I hereby certify that the above petition is believed by me to be well grounded in point of law and that it is not interposed for purposes of delay.

MELVILLE CHURCH.

In the Supreme Court of the United States

OCTOBER TERM, 1924.

THE I. T. S. RUBBER COMPANY,
Petitioner,

vs.

ESSEX RUBBER COMPANY,
Respondent.

PETITIONER'S BRIEF ON PETITION FOR WRIT OF CERTIORARI.

FACTS: During the seven years in which this patent has been in litigation, there have been twenty decisions on the same in the four circuits in which it has been litigated. As the patent now stands adjudicated, a device twice held by the Circuit Court of Appeals in the Sixth Circuit to infringe has been held by the Circuit Court of Appeals in the First Circuit not to infringe.*

*So identically alike in function, mode of operation and material structural features were the devices adjudged by these two Courts of Appeals that counsel for defendant in the First Circuit case stated in the beginning of that case:

"We do not deny infringement by these exhibits if this Court follows the decision in the Sixth Circuit and Judge Brown's decision in Providence. We agree that the heels vary (here) as Exhibits 1 and 2 are infringements under this decision (R. p. 48)."

and

"If not, why then the Court, if it follows the decision in the Sixth Circuit, and Judge Brown, will hold these heels infringements (R. p. 48)."

and

"We admit that it (defendant's device in the First Circuit case) functions as the Court of Appeals in the Sixth Circuit and Judge Brown, of Providence, found the heels to function (R. p. 49)."

As the litigation now stands, devices which infringe in the Sixth Circuit do not infringe in the First Circuit.

The patent covers an improvement in rubber heels which revolutionized the rubber heel industry. In the words of Judge Westenhaver, the invention is one of a high rank and entitled to a broad range of equivalents. Though the patent covers a commonplace device, about half a billion heels covered by the patent have been made and sold under it in seven years. Since the patent has been held valid, an understanding of the invention and its place in the art is not necessary to decide this petition.**

The particular embodiment of the device illustrated in the patent in suit had a curved upper side edge as illustrated at A in Figure 1 hereof.

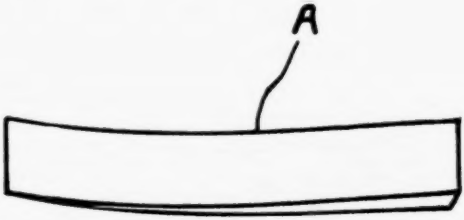


Fig. 1

The infringers sought to avoid the patent by making this edge straight, as shown at B in Figure 2 hereof.

**The invention and its importance are explained in the opinion of the Court of Appeals for the Sixth Circuit and in the opinion of Judge Westenhaver, quoted with approval by that Court, 260 Fed. 939, and in the opinion of Judge Brown, 266 Fed. 375.

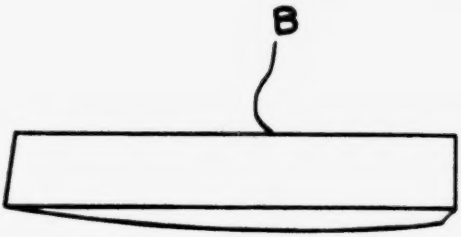


Fig. 2

The Sixth Circuit Court of Appeals held (260 Fed. 947 and 269 Fed. 270) the device of Figure 2 to infringe. The First Circuit Court of Appeals held that such a device did not infringe.

The Sixth Circuit Court of Appeals held infringement notwithstanding the straight side edge B of the heel of Figure 2; the First Circuit Court of Appeals held non-infringement solely because of the straight side edge B of the heel of Fig. 2.

This point of difference is also illustrated by counsel for The Essex Rubber Company in the following cuts taken from their brief in the Court below in the instant case:

PATENTED HEEL

Fig. 3

DEFENDANT'S HEEL

Fig. 4

The First Circuit Court of Appeals has held the patent limited to the device in the upper figure (3) and that claims 5 to 9, inclusive, of the patent were not infringed by the device of figure 4. The Sixth Circuit Court of Appeals has held the same claims of the same patent infringed by the device of figure 4.

The explanation of this simple fact is a little involved in the opinions, because at times this straight or horizontal characteristic of the upper side edge has been defined by the position of the upper surface of the heel to a plane surface and the relation of the side edges to the center of the rear edge and the two breast corners of the heel.

The Sixth Circuit Court of Appeals in defining the device which that Court twice (and Judge Westenhaver as well) held to infringe, said (260 Fed. 947 and 948):

> "In the form made by the defendant * * * the upper edge of the sides and rear is all in the same horizontal plane as these three points. (The center of the rear edge and the breast corners.) Hence it is said that the defendant does not infringe."

The First Circuit Court of Appeals said of the device held not to infringe by it:

> "In substance, defendant's contention is * * * that the sides of the defendant's heels are straight and lie in the same plane as the rear upper edge and breast corners."

The record relating to infringement was the same before each of these two Courts of Appeals. In each case it consisted of the patent in suit, the file wrapper of the original and reissue patents and evidence of identity of mode of operation and function. The claims of the patent involved were the same.

LAW: Following a long established practice, supported by a uniform current of authorities of this Court, certiorari has been granted, where there has been diversity of decrees on the scope of a patent between different Circuit Courts of Appeals. Two recent cases are in point:

The case of *Hildreth vs. Mastoras* (257 U. S. 27) was brought to this Court by certiorari where the Courts of Appeals in the Fourth and Ninth Circuits construed Claim 1 of the Dickinson patent differently.

The case of *Weber Electric Company vs. Freeman Electric Company* (256 U. S. 668) was brought to this

Court on certiorari where the Second and Third Circuit Courts of Appeals construed Claim 1 of the Weber patent differently.

The instant case is on all fours with each of these cases. A careful review of the reports discovers no reported cases where the facts are as, or even substantially as, the facts in this case where certiorari has been denied.

ARGUMENT.

I.

In view of the clear application of these cited cases to the instant case, it seems superfluous to refer to other cases where this patent has been adjudicated or other reasons for the grant of the certiorari here applied for, yet, if there is any doubt in the court's mind as to the wisdom of granting the writ, there are both other cases and other reasons which should be considered.

While the decision of the First Circuit Court of Appeals is in affirmance of the District of Massachusetts, it is in effect a reversal of Judge Brown in the District of Rhode Island (266 Fed. 375) who held to infringe claims 5 to 9, inclusive, of the patent, a device admittedly the same as the device held not to infringe the same claims by Judge Bingham in the District of Massachusetts and the First Circuit Court of Appeals.

In addition to differing from the Sixth Circuit Court of Appeals, the First Circuit Court of Appeals differs from the Seventh Circuit Court of Appeals, who, in the case of *United States Rubber Co. vs. I. T. S. Rubber Co.*, 288 Fed. 786, said that it lined itself with the Sixth Circuit Court of Appeals. After quoting the Sixth Circuit Court (page 790), the Seventh Circuit Court said:

"We agree with this statement, and believe it wholly applicable to the appellant's lift now under consideration."

At the top of page 791, the Court of Appeals for the Seventh Circuit said:

"We agree fully with the holding of the Circuit Court of Appeals for the Sixth Circuit, when it says:" (Follows quotations from the Sixth Circuit opinions.)

Further, at page 793:

"We agree with other courts in that respect. (Citation from the Sixth Circuit.) Our conclusion brings us in line with the holdings of other courts upon this patent and to the belief that the court below was led into a fallacious line of reasoning by applying an erroneous test."

In this decision, the Seventh Circuit Court of Appeals reversed Judge Luse, who had tried upon the merits a case under the Tufford patent. If, therefore, it be contended that some of the Sixth Circuit cases were decided on preliminary injunction proceedings, there is here a Seventh Circuit case tried upon the merits where the Court of Appeals in the Seventh Circuit gives the patent a different construction from the construction given in the First Circuit.

The Court of Appeals in the Seventh Circuit reversed Judge Luse (278 Fed. 975) and the Court of Appeals in the Sixth Circuit reversed Judge Westenhaver in cases later than those cited *supra* to bring such Courts of Appeals to the position which differs from the position of the Court of Appeals in the First Circuit but *not* because Judges Westenhaver and Luse agreed with the Courts in Massachusetts or with the Court of Appeals in the First Circuit, but because each Judge

Westenhaver and Judge Luse had given to the claims in question a broader and different interpretation from any of the other courts.

It results that three interpretations have been given the same claims of the Tufford patent and that the courts stand substantially as follows:

(1) The narrowest interpretation, First Circuit Court of Appeals and District Court of Massachusetts.

(2) The intermediate interpretation, the Sixth and Seventh Circuit Courts of Appeals and the District Court of Rhode Island as far as Judge Brown went.*

(3) The broad interpretation, Judge Westenhaver and Judge Luse.

There is now pending in the Third Circuit a case on the same claims of the same patent and in which the lower court has adopted, as far as can be judged, the intermediate position. This case is now on appeal and being held up awaiting the decision of this Court on this petition and will proceed in case this petition is denied.

The reported decisions on these claims are to be found at 260 Fed. 939; 260 Fed. 947; 263 Fed. 979; 266 Fed. 375; 269 Fed. 270; 270 Fed. 593; 268 Fed. 250; 278 Fed. 975; 276 Fed. 478; 281 Fed. 5; 288 Fed. 794; 288 Fed. 786. In addition there are seven unpublished opinions and a half a dozen or more cases settled or taken by default. In fact, we find in the reports no patent which has been so much litigated or one over which there has been such diversity of view among the courts adjudicating it.

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*The device before Judge Brown did not involve the point upon which the Sixth Circuit Court of Appeals disagreed with Judge Westenhaver and the Seventh Circuit Court of Appeals disagreed with Judge Luse.

II.

Several questions of public interest are involved.

The First Circuit Court of Appeals read into one of the claims a word and with it a limitation, though the same word and the same limitation appeared in other claims in suit, whereas other courts have refused thus to reconstruct a claim. We recognize the rule that claims may be construed but we find no other case in which a word has been read into a claim to make out a case of non-infringement. It seems to us that it is a matter of public interest—and great public importance as well—to decide once and for all whether a patent, unlike all other forms of contract, may be revised and remade by the court where there is neither fraud nor mutual mistake.

No request that the patent be thus revised nor allegation of fraud or mutual mistake appeared in the pleadings; nor was evidence submitted upon that question by either party except that the file wrapper was submitted by the defendant for an avowedly sole and different purpose (R. p. 100). It seems to us that it is of both great interest and importance to the public to know if patents, unlike all other forms of contracts, may be revised and remade by the court where that issue has been neither raised by the pleadings nor opportunity been presented the patentee to submit evidence on the question.

It has been contended that certain limitations were placed upon the adjudicated claims of the Tufford reissue patent during the prosecution of the same. Some of the courts have so thought—others have not. Thus Judge Bingham said:

> "It is apparent from the matters referred to as having taken place during the course of proceed-

> ings in the Patent Office that the patentee sought broad claims, but was denied them, and acquiesced in the denial."

Judge Westenhaver said (260 Fed. 945):

> "The applicant did not modify or limit his claims as a result of these repeated rejections, and finally the Examiner, upon further consideration, admitted his error and the patent was issued."

The compromise between these contradictory pronouncements lies in the fact that the alleged limitation said to have been placed in the claims during the prosecution in the Patent Office was taken out before the reissue was granted. Such alleged limitation was eliminated after the Examiner "admitted his error" as Judge Westenhaver said. This litigation therefore presents this question which does not seem to have been decided by this Court: Where a limitation written into a claim during the prosecution thereof in the Patent Office is cancelled from the claim before the termination of those proceedings and the patent issues with the claim freed from such limitation, may the limitation be read back into the claim by the court? It seems to us that it is of great importance to the public to have an answer to this question from this Court.

After the decisions of the Sixth Circuit Court of Appeals reported in volume 260 of the Federal Reporter, plaintiff (petitioner here) instituted suits in the Sixth Circuit against certain jobbers who were infringing the patent (according to the Sixth Circuit Court of Appeals) by selling heels of the defendant (respondent here) in that Circuit. Respondent apparently fearing to contest the issue in the Sixth Circuit directed that these jobber suits be so conducted that default interlocutory decrees were entered, holding, *inter alia*, infringement by identi-

cally the same devices as were involved in the First Circuit case and held non-infringing there. In, at least, two of these cases these interlocutory decrees were superseded by final decrees, *based upon stipulations entered into by the duly appointed attorneys of the parties in the First Circuit case duly authorized and paid, to the knowledge at the time of the other party, which final decrees held, inter alia, infringement by devices identical with those held not to infringe in the instant case.* Each of the decrees (R. p. 268 and 249) entered by Judge Tuttle are as stated in the preamble to the decrees based upon "a stipulation by counsel" and the decree at page 249 is signed and approved by counsel. It is not therefore the frequent question of estoppel by a default decree, but the question of whether or not the respondent is estopped by a final consent decree based upon stipulation entered into by respondent and which decree was signed and approved by respondent. A decision by this court upon the effect of such stipulated decrees would be of great public importance. It seems to us that it is of great importance for this Court to decide this question.

The litigation on this patent has continued for seven years and the scope to be given the patent is further from being settled now than when the litigation was started. The patent covers a valuable invention, and the manufacture thereunder has been and is now remunerative, so that the litigation must and will continue until the questions now open are settled. Six District Court trials, all substantially coextensive in the issues involved, have already been held on the patent. Nine times have arguments been had on the patent in the various Courts of Appeals. As we have said, another suit on the patent on its way to the Third Circuit Court of Appeals is now stayed waiting decision on this peti-

tion. It would therefore seem that this Court would be justified in granting this petition, if only to settle and terminate the litigation.

We recognize the heavy burden imposed upon this Court but it would seem that economy of judicial time, as well as the time of the litigants, demands that this litigation and the scope of the patent be settled by a court of supreme authority.

The plaintiff, as well as other manufacturers of rubber heels, should know the scope of the claims of this patent. As the matter now stands, they do not know and a decision by this Court is necessary in order that they may know.

We want to repeat that this petition is based upon contrary decisions on the scope of the patent. The devices involved are structurally and functionally the same. This does not involve a question of devices structurally or functionally different where one might infringe and the other might not infringe.

Here, if one device infringes, the other also infringes; if one does not infringe, the other does not. It is purely a question of the scope of the same claims as applied to the same structures and the question is of the same vital importance as the question of validity or non-validity.

MELVILLE CHURCH,
CHARLES A. BROWN,
For Petitioner.

FILED
FEB 23 1926

In the Supreme Court of the United States

OCTOBER TERM 1925.

No. 229.

THE L. T. S. RUBBER COMPANY,
Petitioner,

vs.

EMPIRE RUBBER COMPANY,

BRIEF FOR THE L. T. S. RUBBER COMPANY.

[redacted]
P. O. Address:
For Petitioner.

[redacted]
Of Counsel.

In the Supreme Court of the United States

OCTOBER TERM 1925.

No. 229.

THE I. T. S. RUBBER COMPANY,
Petitioner,

vs.

ESSEX RUBBER COMPANY,

BRIEF FOR THE I. T. S. RUBBER COMPANY.

MELVILLE CHURCH,
F. O. RICHEY,
For Petitioner.

RICHEY & WATTS,
Of Counsel.

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In the Supreme Court of the United States

OCTOBER TERM 1925.

No. 229.

THE I. T. S. RUBBER COMPANY,
Petitioner,

vs.

ESSEX RUBBER COMPANY,

BRIEF FOR THE I. T. S. RUBBER COMPANY.

I.

STATEMENT OF THE CASE.

Status: This is a patent infringement suit brought to this Court by writ of certiorari directed to the First Circuit Court of Appeals who construed the patent in suit more narrowly than, and held non-infringing a device held to infringe by, the Sixth Circuit Court of Appeals.

The patent in suit has been litigated in many courts.[1] There have been many infringers. The litigation was started nine years ago and some is still pending.

Though Mr. Tufford, the inventor, did not create a new art, he advanced an art substantially.

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[1] 260 Fed. 939 (C. C. A. 6); 260 Fed. 947 (C. C. A. 6); 263 Fed. 979 (C. C. A. 6); 266 Fed. 375 (D. C. D. R. I.); 268 Fed. 250 (C. C. A. 6); 269 Fed. 270 (C. C. A. 6); 270 Fed. 593 (D. C. D. Mass.); 276 Fed. 478 (C. C. A. 1); 278 Fed. 975 (D. C. N. D. Ill.); 281 Fed. 5 (C. C. A. 1); 288 Fed. 786 (C. C. A. 7); 288 Fed. 794 (C. C. A. 6) and 1 Fed. (2nd) 780 (C. C. A. 1). There are in addition a number of unpublished opinions.

The patented device has been made and sold by the millions. It is most useful and its inventor has established an industry about it owned largely by him.

The prior art (Nerger patent) relied upon to limit the patent is practically paper art and concerns an invention which was tried and failed in practice when effort was made to use it. It was neither useful nor advanced the art. It was crude and did not work. It differs substantially structurally from the Tufford device.

Mr. Tufford succeeded where others had failed though many men had tried and many means had been tried to solve the problem.

Defendant's[2] devices operate like and realize the same results as the Plaintiff's devices.

Defendant concedes—

That Plaintiff has title to the patent, (R. pp. 10 and 1);

That the patent in suit is good and valid, (R. p. 10);

That Mr. Tufford was the first, true, original and sole inventor of the device of the patent in suit and that he was entitled to a patent therefor, (R. pp. 10 and 1);

That the reissue application was duly made, that Mr. Tufford complied with the Act of Congress relating to reissues and that the reissue patent in suit was "issued in due form of law," (R. pp. 10 and 2);

That defendant infringes if the Sixth Circuit Court of Appeals and Judge Brown of Providence are correct (R. pp. 33 and 34) (this would also include Judges Westenhaver and Luce); and

That the defendant's devices function as the Sixth Circuit Court of Appeals and Judge Brown found the Plaintiff's devices to function. (R. p. 34.)

---

[2]We designate the parties as they were designated in the trial court.

In fact, everything is admitted except the file wrapper defense. (R. p. 34.)

The questions involved are:

(1) Infringement involving the scope of the patent as effected by the file wrapper.

(2) Estoppel by *res adjudicata.*

THE ISSUE.

On infringement:

The particular embodiment of the device illustrated in the patent in suit had a curved upper side edge as illustrated at A in Figure 1x hereof.

FIG. 1x.

Defendant seeks to avoid the patent by making this edge straight, as shown at B in Figure 2x hereof.

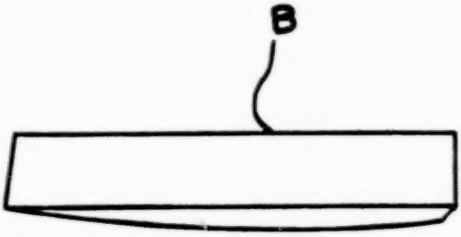

FIG 2x.

The Sixth Circuit Court of Appeals held (260 Fed. 947 and 269 Fed. 270) the device of Figure 2x to infringe. The First Circuit Court of Appeals held that such a device did not infringe.

The devices operate alike and realize the same results. They are in substance the same.

(1) Defendant asks that a limitation be read into claim 8 to make out non-infringement. Defendant from the file wrapper says the Examiner thought the claim contained the limitation. We say the claim cannot be remade by adding an element not now in the claim whether the Examiner thought it was there or not, and that it was omitted purposely;

(2) Defendant asks that the last amendment made to each claim in suit be ignored or that the claims be remade to read an element out of the claims and read back another previously cancelled out. We say that the amendment cannot be ignored and that the claims cannot be remade;

(3) Defendant asks that limitations be read into claims 7 and 9 to make out non-infringement, and we say again the claim cannot be remade; and

(4) This useful invention which advanced its art, is entitled to a liberal construction. Defendant asks for a narrow and constrained construction.

On the estoppel question we contend that the action of this Defendant in suits brought against its jobbers in the Sixth Circuit estop it from denying infringement here.

II.

The First Circuit Court of Appeals erred in holding (1) non-infringement, and (2) in holding no estoppel of Defendant by the decrees in the Sixth Circuit against the vendors of the Defendant's devices.

III.

LAW POINTS.

A.

Where the invention has advanced the art substantially, this Court will construe the patent liberally.

Eibel Process Co. vs. Minnesota & Ontario Paper Co., 261 U. S. 45; 67 L. ed. 523;

Winans vs. Denmead, 15 How. 338, 341, 14 L. ed. 720, 721;

Corning vs. Burden, 15 How. 265, 269, 14 L. ed. 689, 690;

Turrill vs. Michigan S. & N. I. R. Co., 1 Wall. 491, 510, 17 L. ed. 668, 672;

Providence Rubber Co. vs. Goodyear, 9 Wall. 788, 795, 19 L. ed. 566, 568;

McClain vs. Ortmayer, 141 U. S. 419, 425, 35 L. ed. 800, 803, 12 Sup. Ct. Rep. 76.

B.

An element not in a granted claim cannot be read into the claim to make out non-infringement.

McCarty vs. Lehigh, 160 U. S. 110;

Keystone vs. Phoenix, 95 U. S. 274;

Wollensak vs. Sargent, 151 U. S. 221;

Frederick vs. Russell, 85 Fed. 224;

Acme vs. Cary, 96 Fed. 344;

Nisbet vs. Perkins, 269 Fed. 633.

C.

A granted claim cannot be modified merely because the Examiner may have considered or thought it so modified.

Hildreth vs. Mastoras, 257 U. S. 27;
Acme vs. Cary, supra;
Nisbet vs. Perkins, supra.

D.

A patentee is not limited to the specific device illustrated and described in his patent.

United States vs. Societe, 224 U. S. 328;
Hotchkiss vs. Greenwood, 11 Howard 248;
Winans vs. Denmead, 56 U. S. 330; 15 Howard 330.

E.

Change in *form* does not avoid infringement where defendant's device operates and realizes the same results as the patented device.

Winans vs. Denmead, 15 Howard 343;
Paper Bag Machine Case, 97 U. S. 120;
Nathan vs. Howard, 143 Fed. 889 (C. C. A. 6 Lurton, J.).

F.

A claim broadened during the file wrapper proceedings cannot be narrowed by reading out the broadening matter.

Morgan Envelope Case, 152 U. S. 425.

G.

To omit an element and secure an important advantage is high order of invention.

Lawther vs. Hamilton, 124 U. S. 1;
Morey vs. Lockwood, 8 Wallace 230;
Dunn Mfg. vs. Standard, 163 Fed. 521, C. C. A. 6 Judge (later Justice) Lurton.

IV.

FACTS[3] ON UTILITY AND ADVANCE IN THE ART.

Introductory[4]—John George Tufford had been an ordinary shoe cobbler for about thirty-five years when he invented the rubber heel covered by the patent here involved. Being without the means essential to patenting and marketing his device, he sought outside aid and met with refusal and discouragement. Persisting he secured the assistance of two retail shoe clerks in a shoe store in Elyria, Ohio. After the patent was secured, these three men hired a bookkeeper, raised about twenty-three thousand dollars here and there among their friends and embarked in the rubber heel business in competition with Goodyear Tire & Rubber Company, The O'Sullivan Rubber Company, United States Rubber Company and others who had placarded the country with advertisements and who canvassed the country with salesmen. The business thus launched in 1916 has since been conducted by these four men. The patented devices sold rapidly and widely and on their merits for there was little advertising and no canvassing worth mentioning. Judge Westenhaver in the summer of 1918 appraised the situation as follows, (260 Fed. 943):

> "The sales of the Tufford lift in February, 1915, were 6,696 pairs, and for the entire year 748,189 pairs. The sales of the year 1916 were 4,529,518 pairs; for 1917 they were 12,733,567 pairs; and for the first six months of the year 1918, 13,893,245 pairs. For the month of June alone, 1918, the number sold were 2,279,045 pairs. Complainant has put in capital from first to last of less than $30,000. Its undivided profits

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[3]Affirmance of the facts stated in this introduction is found at various places in the record (pp. 35, 169-170, 185) and reiterated in the opinions of the Courts, 260 Fed. 941-946.

[4]Notwithstanding the admission of the validity of the Tufford claims in suit, the facts and discussions of this section are pertinent in view of the recent holding of this court in Eibel vs. Minnesota, 261 U. S. 45.

January 1, 1918, were $800,000. Its net earnings alone for the year 1917 were $482,000. The Miller Rubber Company began with 10 or 15 persons in its press room in February, 1915, making these heel lifts; it now has 160 employes so engaged. Its investment for this purpose totals a half million dollars. It was making at the time of trial 75,000 pairs a day, and trying to reach an output of 120,000 pairs a day. Mr. Griffith says the company has never been able to keep up with the public demand for this heel lift."

These achievements continued, except as affected by infringements, as is indicated in various parts of the record, and during the progress of the litigation as reported in the decisions.

This astonishing commercial success is understandable in view of the precarious condition of the rubber heel business when Mr. Tufford made his invention. Softness to the tread and quietness in walking, the salient advantages of rubber heels, were neutralized by the faults and ills of the rubber heels in use commercially prior to Mr. Tufford's invention. These ills incurred the hostility of the cobbler as well as of the user, and both stood bars to the progress of the rubber heel. Nation-wide advertising and canvassing had failed to convert the cobbler and the user to the rubber heel involving as it did the faults which we will proceed to describe. Literally, every rubber heel was sold at the bayonet point of the advertiser. (R. p. 41, 170, 184, 260 Fed. 941).

We will here digress to explain the terms of the rubber heel. The rubber heel as known in this record, is substituted for certain layers of leather called lifts by the cobbler who looks at the heel from the bottom, and therefore calls the heel pieces "lifts" instead of under pieces. The heels here involved are in reality rubber lifts, but are commonly called rubber heels, and we will therefore call

them "heels." The first rubber heels were made flat just like the leather lifts and were substituted for one or more of the leather lifts. We have illustrated such a flat rubber heel in Fig. 1.

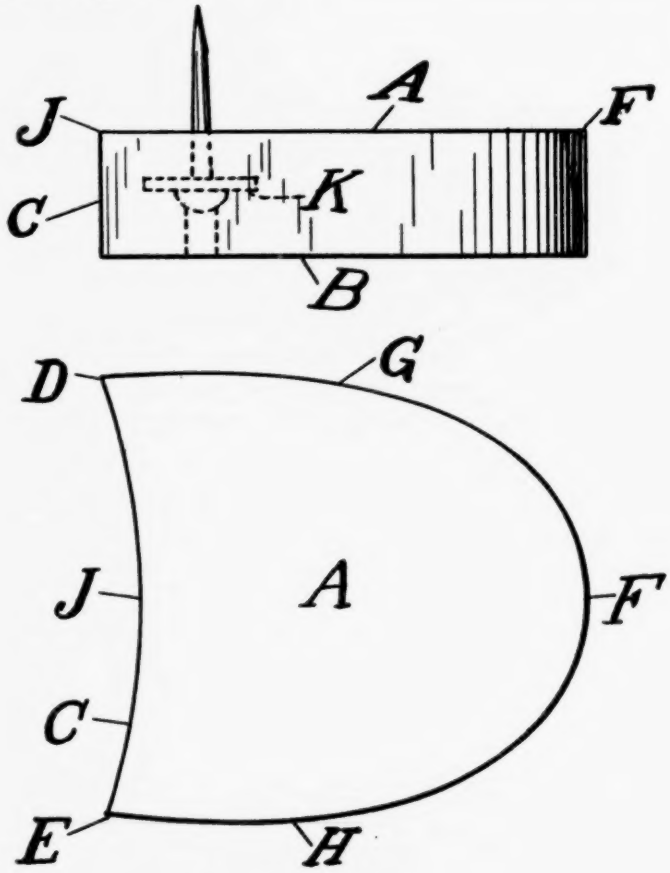

Fig. 1

The attaching face of the heel is shown at "A." This face comes next to the bottom of the leather part of the

heel when the rubber heel is attached. The other face "B" is known as the tread face. The front of the heel "C" is called the breast. The breast is usually curved inwardly as indicated in Fig. 1. The corners "D" and "E" are known as the breast corners. The back part "F" is called the rear edge. The edges "G" and "H" are known as the side edges and the edge "J" is known as the breast edge. The heel is pierced at various places part way through for the passage of the nails or screws by which the rubber heel is attached. Molded in the heel midway between its faces are small metal plates or the like upon which the head of the nail rests when it is fully seated. Most frequently these small plates are circular and, being pierced for the nails, have the shape of a washer and hence are commonly called washers. These plates perform no other function than that of preventing the head of the nail from tearing through the soft rubber.

These prior flat heels realized the rubber heel's salient advantages of softness to the tread and of quietness in walking. When, however, the cobbler drove home the attaching nails or screws, the rubber under the plates would be compressed by the pressure of the attaching means and cause the rubber heel to spring away from the leather about the edges as shown in Figs. 2 and 2A.

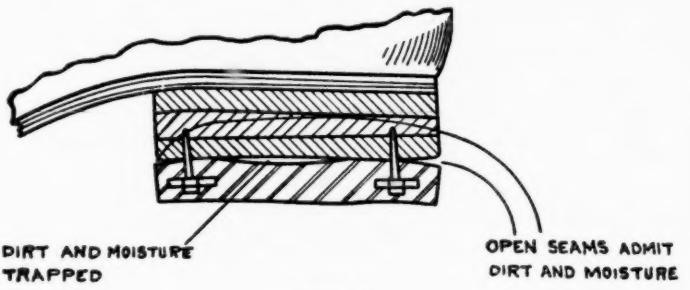

FIG. 2.

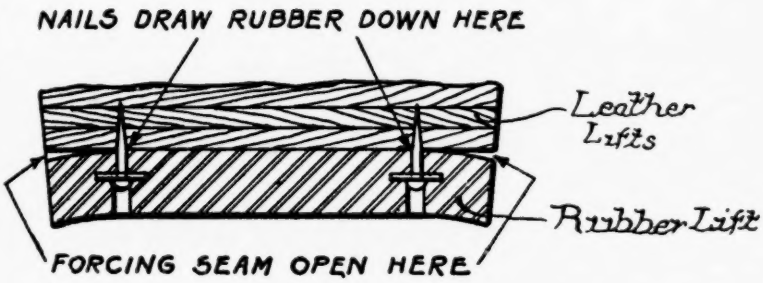

FIG. 2a.

This made the job unsightly and water, filth and the like crept, or was drawn, into the open seam and fouled the heel. This filth was frequently expelled in the house or at other inopportune times.

This fault of the flat rubber heel militated against its success and stood a bar to its general introduction. In an effort to remedy this fault, the cobbler would cement the rubber heel to the leather in addition to nailing it on. Too much time and labor were consumed in the cementing operation. The contiguous surfaces of heel and leather had to be cleaned and smoothed with rasp and sand paper before the cement could be applied. After the cement was applied the shoe and the heel had to be set aside for awhile that the cement might partly dry to the desired consistency or stickiness. While the cement was drying it had to be watched that it did not overdry. When well and completely done the cementing was a mere makeshift for no satisfactory cement for cementing rubber to leather is known. Sooner or later the heel was caught and the cement ripped loose. This was often caused by pulling off rubber shoes, or striking the heel inadvertently against some object such as the edge of a step or in the trimming of the rubber heel after attachment. The manufacturer

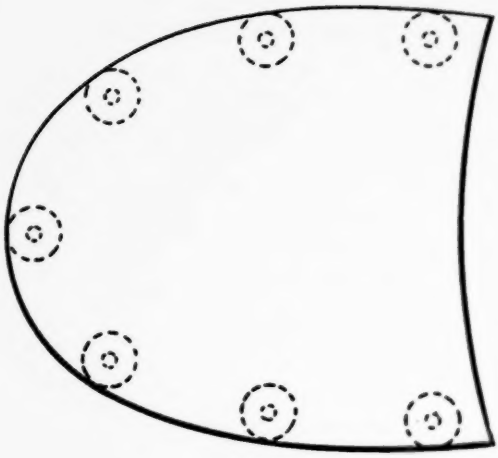

Fig. 3

of the heels sought to remedy this defect by moving the nails and washers closer to the edge of the heel, as shown in Fig. 3. By so doing it was hoped that the edges of the heels could be nailed together and the opening of the seam prevented, but this change introduced other and additional ills. The trimming area of the heel was so limited that the cobbler frequently trimmed with his knife into the washer, injuring his knife and leaving the washer exposed at the outside. The wearing area was also limited and very shortly the washer was exposed, as indicated in Fig. 4, with the result that the washer, and very soon the nails, scraped on the floor and pavement. It also frequently happened that the nail intended to attach a rubber heel would strike a nail in the leather heel and be deflected through the leather and exposed, mutilating the leather heel and, in the case of wooden heels, sometimes chipping off a portion of the heel. This is indicated in Fig. 5.

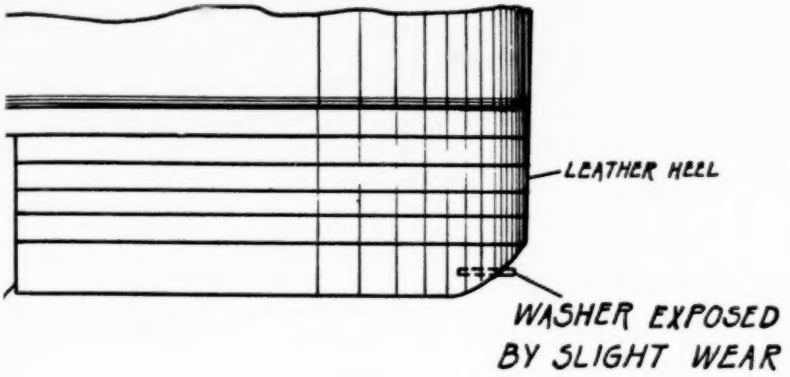

FIG. 4.

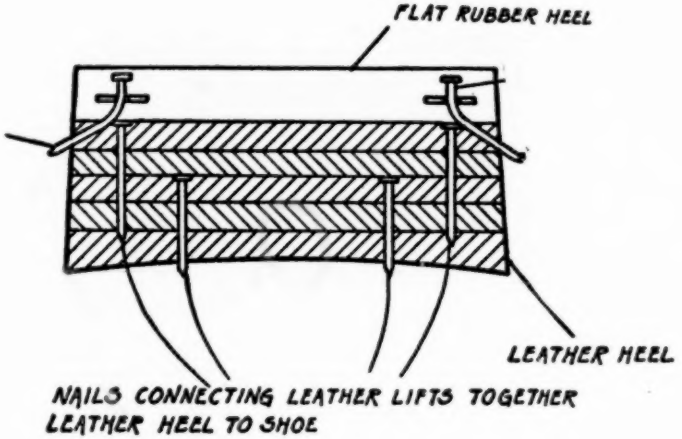

FIG. 5.

Flat rubber heels were utterly impracticable for women's French wooden heels with the well-known flared bottoms. If the nails were near the edges, the wooden heel was chipped and destroyed. If the nails were set in

far enough to avoid this consequence, the seam was wide open.

Many efforts were made prior to Mr. Tufford's to remedy these evils of the rubber heel. We will not undertake to discuss all of these efforts, but will content ourselves with the more important ones.

It was proposed to attach the rubber heel to a leather lift at the factory and nail leather to leather in the cobbler's shop. This only postponed the evil day for a little while. (R. p. 406.)

Heels were made with a raised margin about the edge of the attaching face such as shown at A, in Fig. 6. (R. p.

Fig. 6

422.) It was planned to pinch this margin by the pressure of the nails between the rubber and the leather and thus dam the seam between the rubber and leather surfaces. This plan, however, was open to the objection that the heel could not be trimmed without trimming away the dam more or less and in some places entirely, thus leaving a wider and more objectionable opening. The trimming area which was limited to the width of the margin was too narrow. Some of these heels were equipped with large metal plates in an effort to better pinch the dam between the leather and rubber surfaces. These heels met with some success especially when attached to the shoes by the manufacturer of shoes who, knowing in advance the size

of the shoe heel, could mold the rubber heel to size, but these heels were no more satisfactory to the cobbler than the flat heels.

Large metal plates of various forms and shapes (R. p. 422 and 414) were employed, or their use suggested, in various forms of rubber heels. It was hoped that these plates would prevent the opening of the seam as illustrated in Figs. 2 and 2A hereof. This was promising from a theoretical standpoint and many efforts were made to solve the problem by the use of heels made of rubber and iron or steel plates. A few of these contraptions were manufactured and considerable effort was expended in futile attempts to make them successful commercially. Although the records in the various cases, as well as the opinions of the Courts, are replete with discussions of these heels and the reasons for their failure, we will limit our reference here to only one of these heels and discuss that one briefly.

The Nerger heel has received, in this litigation, a prominence which it did not deserve because on paper it appears to be a solution of the problem and to embody some of the Tufford features. When divorced from the paper showing, and applied in practice, it was a flatter failure than any of the other efforts to solve the problem. Mr. Nerger conducted a number of campaigns very similar to the sampaign that Mr. Tufford conducted in behalf of his heel. Each of Mr. Nerger's attempts were failures. Mr. Tufford's single attempt was successful. (260 Fed. 944.)

The principal trouble with these Nerger heels was that the iron or steel plates destroyed the salient features of the rubber heel. The plates about which the rubber was molded made the device about as hard as a leather heel and stiffer than the leather lifts for which it was substituted. (R. p. 103.) These heels should, and in fact

were, called plate heels. They should not be classified with rubber heels at all. The composite structure was not entitled to be called a rubber heel any more than a suit of armour is entitled to be called a suit of clothes. The hard, stiff, metal plate dominated the soft and resilient rubber so that the characteristics of this composite device was that of the iron or steel rather than that of the rubber. They were more iron than rubber heels. In addition to sacrificing the salient features of the all rubber heel, these plate heels limited the trimming area because the edges of the plate had to be extended to near the margin, if the seam was to be sealed, the same as the nails and small plates had to be, as shown in Fig. 3. The plate bridged the irregularities in the leather, leaving them open. Unless the plate was made of hard steel, the heel was liable to be bent in attaching or in use or caught in some such way as indicated in Fig. 7, and the plate bent back.

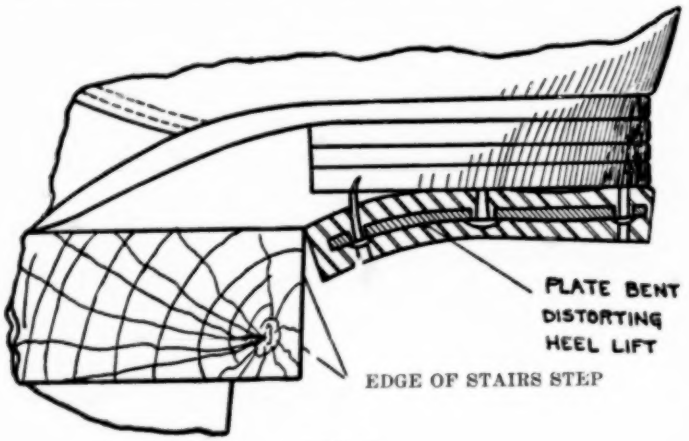

FIG. 7.

The seam thus opened could never be closed again unless the heel was taken off and the kink taken out of

the plate. If the plates were made of hard steel they were liable to be cracked in the manufacture, attaching or use of the heel. These plate heels were very difficult to manufacture as compared with the other heels because the rubber had to be molded on both sides of the plate.

Various forms and shapes were given to these plates. Nerger made his structure scoop-shaped; others made them flat and others employed them with the raised margin (Yahraus 817355). Some employed two or more of these expedients together (*ibid*). The failure of the Nerger heel is typical of the failure of all these plate heels and we will limit our discussion of that matter to a quotation from the opinion of Judge Westenhaver quoted with approval by the Court of Appeals in the Sixth Circuit and which appears in 260 Fed 945:

> "I have examined the testimony in deposition form showing previous sale and use of the Nerger heel. Nerger ordered from Morgan & Wright, rubber manufacturers of Chicago, during the years 1901 and 1902, some 600 pairs of heels. These were peddled by him or one or another of his sons to shoe cobblers in and about Chicago. Nerger, his sons and one or two other witnesses also testify that these heels gave satisfaction, adhered closely at the edges, did not gap away from the leather, and did not spread beyond the leather, and wore well. Giving full weight to these statements, but taking his testimony as a whole, I am convinced that the Nerger heel lift was neither successful nor practicable, that a limited number only were sold, and that, owing to the inherent defects therein, it failed to meet or solve the problem of a desirable heel lift. Nerger brought this heel lift to the attention of different persons in his efforts to enlist their co-operation in making and selling them, but always without success. His invention must be regarded as a practical failure."

(We will say more about the Nerger heel later herein.)

Various modifications of the Nerger and other plate heels, both as illustrated in patents and in heels themselves, were urged upon the various Courts by various Defendants in the litigation over the Tufford patent and resulted in some of the judicial view limiting the Tufford patent. Other Courts refused to accept these heels other than as they were illustrated or described in the patents or found to have been tried in practice.

The outstanding fact in the history of the iron plate heel was that it was thoroughly tried in practice in various forms and by various parties independently of each other and had failed so completely that when Mr. Tufford came into the field, the plate heel was obsoleted and would probably never have been resurrected for any purpose had not this litigation been instituted

We have perhaps devoted too much space to the prior plate heel in view of the formal admission in defendant's answer of the validity of the Tufford patent.

Outstanding also is the fact that when Mr. Tufford made his invention the trade had accepted the flat heel, with all its faults, as the best of these make-shifts. It then seemed that the rubber heel industry must survive or perish with the flat heel.

We have thus briefly reviewed the more important prior art and stated the situation that the Court may comprehend the picture and understand the importance of the invention and the scope to which the Tufford patent is entitled. In an ordinary case such a review might be unimportant or unnecessary since the *validity of the patent is here conceded.*

Mr. Tufford's Invention: The reasons for the failures of prior efforts we have recounted are clear when it is

understood that the problem involved apparently irreconcilable antagonisms.

A tight seal of a seam between the soft rubber heel and the hard leather heel must be made by attaching means applied remote from the seam. A firm connection must be made without stiffening the rubber heel with plates or the like. The connection must hold and the seam remain sealed for the life of the heel. The seam must be tightened and sealed at the edges by attaching means applied well away from and inside the edge.

In his solution, which is patented and here involved, Mr. Tufford employed an all rubber heel, discarded all plates, raised margins and other appendages, moved his attaching means inside further than any had ever done before, and cupped his heel. Then, when the nails were driven in, the heel was flattened and its edges pressed and held tightly against the leather shoe heel edge by the retractive effort of the rubber operating as the heel tried to return to its cupped form. We have illustrated this action in Fig. 8 below, where a Tufford heel is shown in section as it is nailed down. The sealing increases as the heel is depressed and is finally permanently tight when the nails are set. There was no longer need of sand papering and cementing. The old lifts were torn away and the rubber heel nailed right on. What had taken half an hour could be done in a few minutes.

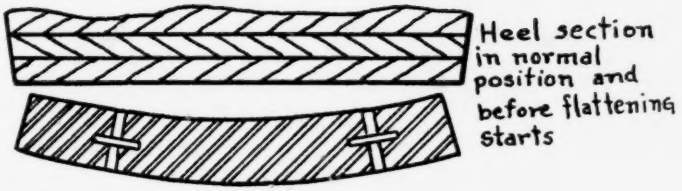

Fig 8 A

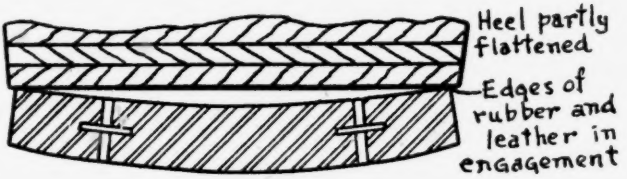

Fig 8 B

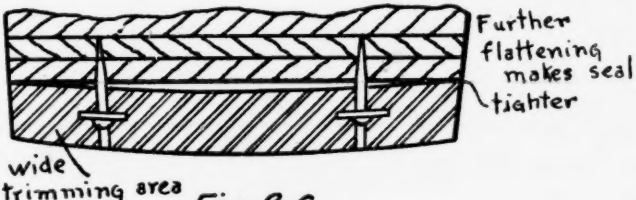

Fig 8 C

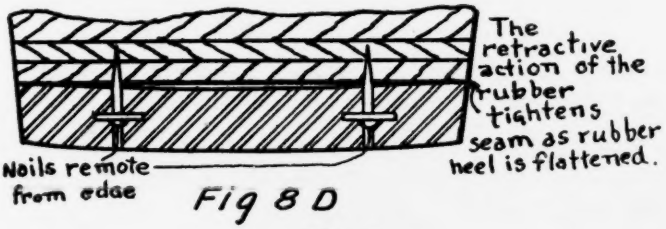

Fig 8 D

FIG. 8.

The trimming and wearing areas were increased. All the faults of the old heels were gone and all their advantages preserved (R. pp. 38, 39).

The cobbler who had been the enemy of the rubber heel was now its friend and ardent promoter. It had been harder for him to attach a rubber heel than a leather heel; now it was easier. Those who liked the softness and quietness of rubber heels, but who would not tolerate the open seam, could now have rubber heels with seams as tight and sightly as the leather heels. Mr. Tufford and his shoe clerks and his bookkeeper became captains of industry over night. From then until now the use of the rubber heel spread until now, as is well known, its use is almost universal. Almost immediately a multitude of infringers sprung up anxious to share with Tufford the fruits of his invention; some of these infringers have been suppressed in the extensive litigation over the Tufford patent, and some of them still practice. In fact about everything happened that usually happens when a revolutionary invention is made in any industry. The humble shoe heel industry does not differ from others in that respect.

Against this record of achievement the defendants oppose a Babel of verbal technicalities. No one now challenges either the importance of Mr. Tufford's invention or its complete remedy of all the maladies of the rubber heel. No one now asserts that his invention is anticipated. No infringer denies that his heels embody the mode of operation and result of the Tufford invention. So thoroughly have all these contentions been established by Mr. Tufford that we find the defendant in the case at bar admitting the validity of the patent, admitting infringement under the decision of the Sixth Circuit, agreeing that there is infringement under the decision of Judge Brown which was based on equivalency and we find defend-

ant here presenting the sole defense of alleged limitations of the patent by the file wrapper.

V.

Infringement:

Defendant's counsel thus stated his position (R. p. 33):

> "The question of infringement directly is not in issue. The answer simply cites the file wrapper as the sole defense which the Defendant puts in. * * * There is no issue as to anything except what is specifically a file wrapper defense."

(R. p. 33):

> "We deny infringement, but we do not deny infringement by those exhibits if the court follows the decision in the Sixth Circuit and Judge Brown's decision in Providence. We agree that the heels vary as Exhibits 1 and 2 are infringements under this decision. We put in the file wrapper to contest the correctness of this decision."

(R. p. 34):

> "If not, why then the Court, if it follows the decision in the Sixth Circuit and Judge Brown, will hold these heels as infringements. * * *
>
> "We admit that it (Defendant's heels here involved) functions as the Court of Appeals in the Sixth Circuit and as Judge Brown in Providence found the heels to function."

The particular embodiment of the Tufford heel illustrated and described in his patent happened to have a curved side edge (R. p. 222) as illustrated below by the reference A, added by us, to Fig. 2 of his patent which is reproduced below and made Fig. 9 of this brief.[5]

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[5] This has also been called the three-point contact heel because since the breast and side edges are curved it would engage at the breast corners and the rear edge when held against the shoe heel as in Fig. 9.

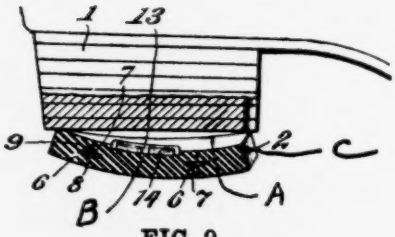

FIG. 9.

Although, whether the side edges are curved or straight has no effect upon the function, mode of operation or results of the heel, (R. p. 43) this minor detail has been the storm center of this litigation. The District Court in Massachusetts and the First Circuit Court of Appeals held non-infringement because Defendant's heels had straight side edges as illustrated in the Sanders patent (R. p. 322) showing one form Defendant's heels. (Exhibit I, series A). Fig. 5 o his patent is reproduced below (as Fig. 10 hereof) with the addition of the reference A to indicate its straight side edge.

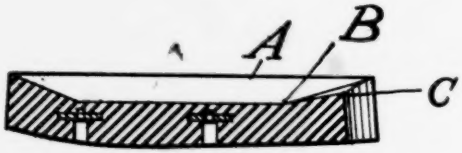

Fig. 10

This question was squarely before the Sixth Circuit Court of Appeals in a number of cases and before Judges Brown and Westenhaver, and all those Courts held infringement regardless of this difference.

The particular embodiment of the Tufford heel illustrated in his patent also had, when the heel was held with

its rear edge and breast corners in a horizontal plane, as is the case in Fig. 2 of his patent (R. p. 222) reproduced in Fig. 9 hereof, a spot such as B to the rear of and lower than the breast C.[6] The presence or absence of this low spot does not affect the function, mode of operation or result—except perhaps in degree—of the heels charged to infringe in this litigation. Whether the defendant's heels had a low spot back of the breast or not has also been one of the points of controversy in this litigation.

Defendant's Exhibit 1, series A heels like those shown in Fig. 5 of the Sanders patent (Fig 10 hereof) undoubtedly have such a low spot at B even more marked than the Tufford heel. One of Defendant's heels, Exhibit 2, Series B, also has the low spot back of the breast though the low spot is only slightly below the breast. These heels clearly infringe under the decisions of the Sixth Circuit Court of Appeals and it is so conceded. Indeed, the decision of that Court in the *Hill* case (269 F. R. 270) specifically held infringement where there was slight difference in elevation between the "low spot" and the breast edge.

There was some controversy and evidence both ways at the trial (R. pp. 49 and 50) concerning the slant of the other heel of Exhibit 2. This question is succinctly stated and illustrated thus:

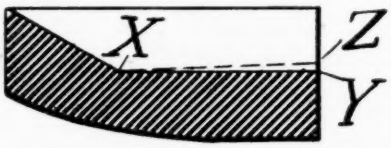

Fig. 11

[6]These heels have also been called "open breasted" heels though that expression is somewhat misleading. It should be considered not literally but with the above definition in mind.

If the center line of the second heel of Exhibit 2 in this case rises from X to Z in Fig. 11 infringement is conceded if the Courts in the Sixth Circuit and Judge Brown were right; if, however, the line runs parallel to the side edge like X Y, it is contended that there would be no infringement even under the decisions of the Sixth Circuit Court of Appeals.

In the Court of Appeals below Defendant's counsel contended that both heels of Exhibit 2 were lower back of the breast (open breasted) and therefore did not infringe under the Sixth Circuit decision though in the trial Court he had admitted the contrary. (R. pp. 33, 34.)

Defendant's counsel produced during the trial a specially prepared heel marked "Defendant's Exhibit F." In this particular heel the parts are so proportioned that the composition of rubber used is not capable of closing the breast which is remote from the curved part. Its infringement is not in issue and we do not, therefore, discuss it in detail here. It was made after this suit was started. It behaved very differently from any other Defendant's heel in this case.

After the offer of this heel, Plaintiff went out in the streets and purchased a plurality of Defendant's heels[7] and proved that they would perform the Tufford functions. (Exhibits 100 to 103, R. pp. 103-106.) Some of these Defendant's heels are "open breasted" heels and present the issue between the Sixth Circuit Court of Appeals and Judges Westenhaver, Brown and Luce.

Succinctly stated, we contend:

(1) That defendant's exhibits 1 and 2 infringe because (a) they adopt the essentials of construction

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[7]These heels bear Defendant's name, address, trade-mark, patent dates and other insignia and were found to otherwise respond to Defendant's advertisements (R. p. 165) and stipulated heels, and are undoubtedly Defendant's heels. They are not otherwise proven as such, but we do not believe Defendant can or will deny that they are Defendant's heels.

and the mode of operation and realize the results of the patented heel and (b) because they fall within the decisions of the Sixth Circuit Court of Appeals and of the three District Judges as is conceded.

(2) That the heel of exhibit 2 which is slightly lowest at the breast infringes for reason (a) and under the decisions of the three District Judges.

VI.

Litigation: We find neither in the annals of this or of any foreign country a patent over which there has been so much litigation as over the patent in suit. It is, therefore, fair to say that it is the most litigated patent of all time. Six times has the patent been tried out in open court. Nine times has it been argued in the Courts of Appeals. Preliminary injunctions and other interlocutory proceedings have been legion. Other litigation involved is now pending in the Third Circuit, awaiting this Court's ruling in this case. It seems to us that this Court, who have the authority, should make an all-comprehensive interpretation of the patent that will settle that sole remaining question forever.

VII.

THE FILE WRAPPER DEFENSE: We speak in all seriousness when we say the defense in this litigation has degenerated to the file wrapper defense, and is a mere babel of technicalities. There has been the greatest disagreement both among counsel for Defendants and the Courts regarding what, if any, estoppel has been created by the Tufford file wrapper. The holdings of the Courts on this question have ranged all the way from no estoppel at all to estoppels which emasculate the patent and deprive it of all value. Where they are not in accord they

are inconsistent, one Court finding a limitation at one point and another court a limitation at another point.

Judge Westenhaver, who tried this case twice on the merits and heard it four times on preliminary injunction proceedings besides, Judge Brown of Providence, who listened to the evidence for nearly a week and Judge Luce in the Eastern District of Illinois, who heard evidence for over a week, all found that the file wrapper placed no estoppel upon the inventor. (8)

At the other end of the range, it was first held, in the District of Massachusetts, that the patent itself limited Mr. Tufford to a heel with curved side edges, a situation we will explain hereinafter and one which if adhered to, renders the patent impotent.

The Court of Appeals for the First Circuit disagreed with such holding (281 Fed. 5).

It was then held in the District of Massachusetts that, though basis for such limitation was not in the patent, it was found in the reissue file wrapper.

The First Circuit Court of Appeals held that basis for this limitation was to be found in the file wrapper of the original patent and limited the patent to the extent of impotency.

The Sixth Circuit Court of Appeals, held that there was basis for such a holding in neither the patent, the re-

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(8) Judge Westenhaver's views are stated at 260 Fed. 945:

"The presumption of patentable invention flowing from the allowance of the application and the granting of a patent by the Patent Office authorities is strengthened to an unusual degree by the actual proceedings in this case. During the pendency of the reissue application Ferguson and Nerger were both cited against it. The examiner repeatedly rejected the application, first because of Ferguson and Nerger patents, and later on Nerger's alone, and it was not until after he had seen, inspected, and demonstrated the Nerger and Tufford heels that he passed the application. *The applicant did not modify or limit his claims as a result of these repeated rejections and finally the examiner, upon further consideration, admitted his error and the patent was issued.* In these circumstances, the granting of the patent carries more than the usual weight."

issue nor the original file wrappers, but that another and different limitation had been accepted and must by estoppel remain in the claims.

The now unsettled file wrapper questions resolve into the single question of claim remaking.

Defendant asks the Court to remake claims in three particulars, as follows:

(1) To read "rear" into claim 8, to add an element not in the claim that non-infringement may be found.

(2) To read "passing through" out of claims 5, 6, 7, 8 and 9 and read "tangent to" into each claim.

(3) To read "on every line of cross section" twice into claim 9 and once into claim 7.

We recognize the rule that the language of a claim can be construed, but that is not the proposition here. The Court is asked to remake the claim in violation of the rule in *McCarty vs. Lehigh,* and other cases cited *supra.*

(1) In each of claims 5 to 7 and 9 inclusive there appears the limitation (R. p 164):

> "the concave (or the upper concave or the concave attaching) face lying entirely below a plane passing through the *rear* upper edge and the breast corners of the lift."

The word "rear" is omitted from this expression in claim 8, which claim reads as follows:

> "8—A heel lift of resilient material comprising a body portion of uniform thickness throughout its entire area and of concavo-convex form on every line of cross section, the concave upper face of the lift lying entirely below a plane passing through *the upper edge* and the breast corners of said lift."

That infringement must be held unless the claim is thus amended or redrawn is manifest, for as claim 8 was

originally presented, allowed and now appears in the patent, it is infringed by a device whose upper edge is in the reference plane whether that upper edge be the part of the edge to the rear alone, as in the Tufford heel, (Fig. 9) or

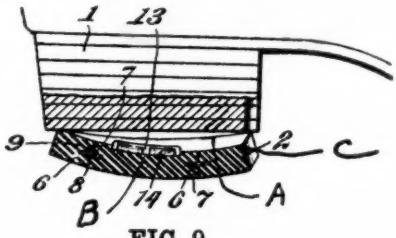

FIG. 9.

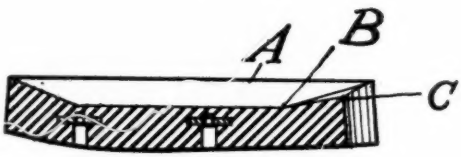

Fig. 10

the entire upper edge, except the breast edge, as in Defendant's heel, (Fig. 10). The first Circuit Court of Appeals proceeded to read this limitation into claim 8 to make it the same as in the other claims saying that the Court thought the Examiner intended that the word should be in the claim, although it wasn't in fact there.

In the recent case of *Hildreth vs. Mastoras,* (257 U. S. 27; 66 L. Ed. 112) this Court settled the law on this question by holding that what a Patent Office Examiner might have considered of the scope of a claim did not deprive this Court of the right to determine the true import of the language used in the granted claim.

In *Nisbet vs. Perkins*, 269 Fed. 633, that very point was before Judge Hand; there the defendant urged the revision of a claim to make out a case of non-infringement, and Judge Hand agreed that the examiner thought the claim contained the limitation though he thought otherwise. The learned Judge said (p. 634):

> "Hence, through his mistake the examiner did not impose a close enough limitation to narrow the patent as he meant to do. However that may be, he did what he did; and there cannot be the slightest question to my mind that, viewed as a grant, it covered all cases in which the shield was narrow. *I cannot make over the patent against the patentee, because of the mistake of the examiner in failing to phrase it properly.* The language is clear. If the defendant objects, let him widen his shield."

In *Acme vs. Cary*, 96 Fed. 344, the same Court said in rejecting the same kind of contention (pp. 345 and 346):

> "A mere remark of the examiner, 'It is not seen that there is any material difference in the claims,' does not estop the patentee from claiming the construction shown by the specification and original claim. It is the construction of the patent as finally issued which is to be considered. *Reece Buttonhole Mach. Co. vs. Globe Buttonhole Mach. Co.*, 10 C. C. A. 194, 61 Fed. 958."

This Court has always held that a claim cannot be altered by the Court either by reading or implying an element into it, and the reading of the curved side edge or three point contact limitation into claim 8 of the Tufford patent would be contrary to a long line of authority in this Court.

In *McCarty vs. Lehigh Valley*, 160 U. S. 110, this Court held, to quote the syllabus (40 L. Ed. 358)—

> "An element not mentioned in a claim for a patent cannot be read into the claim for the purpose of making out a case of novelty or infringement."

In *Keystone Bridge vs. Phoenix*, 95 U. S. 274, it was held, to quote the syllabus—

> "When a claim is so explicit, the Courts cannot alter or enlarge it";

In *Frederick vs. Russell*, 85 Fed. 224, Chief Justice (then Judge) Taft, speaking for the Court of Appeals in the Sixth Circuit said—

> "To imply as elements of a claim parts not named therein for the purpose of limiting its scope, so that it may be accorded novelty is contrary to a well settled rule of patent law."

All of this authority is consonant with the rule that contracts cannot be revised except in clear cases of fraud or mutual mistake and consistent with the well known nose of wax rule laid down by this Court in *White vs. Dunbar* (*) (119 U. S. 47).

The Court (C. C. A. 1st) undertakes to justify this action on the grounds that in that court's opinion the claim must be so revised to save it. Our answer is two-fold,—

First, the claim cannot be revised and a limitation inserted to save it any more than to make out non-infringe-

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(*) As a matter of fact, the word "rear" was omitted from claim 8 intentionally and at the direction of Mr. Tufford, but we had no opportunity to so prove because no such issue was raised either by the pleadings or the evidence, and when urged at the final hearing for the first time, surprised us completely. Since a patent is a contract, we doubt if this Court would sanction its revision without due pleadings and evidence. The file wrapper presents no evidence on the question. The adding of claim 8 without the word "rear" to the other claims in suit which contained the word "rear" proves the intention to omit the word which, as we say, is the fact. The contention that the Examiner thought the claim was so limited is based entirely upon the statement by the Examiner that claims 5, 6, 7, 8 and 9 specified language (R. p. 257) which was afterwards changed and which now appears in none of the claims. Indeed, the precise language quoted by the Examiner did not at that time appear in any of the claims. It would be just as reasonable to assume that the Examiner inadvertently included claim 8 in this group as it would be to assume that the Examiner thought the word "rear" was in the then claim 8. Indeed, if there was any error, that was the error. The whole proposition is based on speculation and surmise. The absence of the word "rear" in claim 8 could not have escaped the careful scrutiny always given claims before the patent is finally issued.

(Continued on next page)

ment, (*McCarty vs. Lehigh, supra*) and that if it is invalid without the curved side edge limitation it is invalid, but that is a question with which neither this Court is, nor that Court was, concerned because Defendant has admitted the validity of the claim and that admission applies as the claim is and not after attempted remaking. No such condition was tied to defendant's admission and plaintiff made out its case accordingly.

Second, the fate from which the Court (C. C. A. 1) fancied that the reading of the curved side edge into the claim would rescue it, is found in the Court's statement that without such a limitation the claim would be invalid "because not for the same invention as described in the original specification and drawings."

The Court then cited *Parker vs. Yale Clock Co.*, 123 U. S. 87 and quoted therefrom this Court's statement regarding the well-known rule that a patentee cannot make material additions to his re-issue patent. The facts in the *Parker* case and this Court's reasons for deciding adversely to the re-issue there are found in the following further statements by the Court—

In the court below, defendant contended that if the omission of the word "rear" had been intentional, the words "breast corners" would also have been omitted because "breast corners" are part of the edge. This resolves itself into a super-technical argument as to whether or not a corner is part of an edge. The answer to this general proposition is immaterial in view of the fact that the patentee has elsewhere defined the corner as not a part of the edge. In claim 10 and elsewhere in the specification, where the patentee's spherical embodiment is specifically described, occurs the expression "the rear upper edge and breast corners of the concave attaching face of the lift being disposed in a plane above the upper side and breast edges." Here the breast corners are said to be above the side edges and breast edges. The corners could not be above the edges, if the corners were considered a part of the edges. To hold the corners a part of the edges, we must accept the anomalous conclusion that the corners are in the edges and above them at the same time, a clear contradiction of the language used and a physical impossibility. If it is true, as the learned judge sitting in the District Court thought, that there would have been no need of reciting the "corners" in the claim, the necessity for thus reciting the corners becomes apparent when we learn that the writer of the claims considered and defined the corners separately from the edges.

"If by 'new matter' in Sec. 4916 of the Revised Statutes, *is meant such new substantive matter as might be the subject of another application for a patent,* there was new substantive matter introduced into the specification of the re-issue in the present case; for the description set forth in that specification as the foundation for the first eight claims in it, and *those eight claims themselves, might have been the subject of another application for a patent* at the time the original patent was applied for and taken out, leaving that patent valid and operative in respect to the claims it covered." (31 L. Ed. 106).

This was further explained by this Court in the following language quoted from *Coon vs. Wilson* in the *Parker* decision—

"The description had to be changed in the re-issue to warrant the new claims in the re-issue. The description in the re-issue is not a more clear and satisfactory statement of what is described in the original patent, but *it is a description of a different thing* so ingeniously worded as to cover collars with continuous long bands, and which have no short or sectional bands."

There was a gross case of intervening rights in the *Parker* case and none in the case at bar. Mr. Tufford was prompt to apply for his reissue. In the *Parker* case the Court said—

"In the present case, the infringing clock was made by the Defendant Lane more than six months before the re-issue in suit was applied for."

The law applicable to re-issues was stated by Mr. Justice Bradley in *Miller vs. Brass,* 104 U. S. 350; 26 L. Ed. 783 as follows:—

"If a patentee who has no corrections to suggest in his specification except to make his claim broader and more comprehensive, uses due diligence in return-

ing to the Patent Office, and says, 'I omitted this,' or 'my solicitor did not understand that,' his application may be entertained, and, on a proper showing correction may be made."

The whole re-issue question was squarely before the Sixth Circuit Court of Appeals who held in quoting Judge Westenhaver with approval—(260 Fed. 946)—

> "Defendant's contention that the reissue patent is for a new invention, not embodied in the original patent, is not sound.
>
> * * * * *
>
> The changes made in Figure 2 of the drawings of the reissue patent are slight and immaterial, and scarcely perceptible to the untrained eye. The additions made to the specifications are from lines 83 to 105, inclusive, on the second page. An examination of these added lines and a comparison thereof with the original does not show the introduction of any new idea not disclosed in substance in the original. These lines were added only to bring the same out with greater clearness."

The same conclusion must follow from the first decision of the First Circuit Court of Appeals. That Court said (281 Fed. 9)—

> "The specification also discloses a preferred form of heel, concavo-convex on every line of cross-section and possessing a like function or retroactive force. The specification says: 'It is preferable that the lift be of the same thickness throughout and that its marginal surface be at all points radial to the center of curvature of its concave side 3 so that, when the lift is applied to the shoe heel and subjected to pressure, its said marginal surface will be coincident with the side of the shoe heel.'
>
> "It is conceded by the plaintiff that the preferred form of lift called for by the language—'that its marginal surface be at all points radial to the center of

curvature of its concave side 3'—is spherical. The drawings of the specifications show a concavo-convex lift of spherical form, having a body of uniform thickness and its side and breast edges below a plane passing through its rear upper edge and breast corners."

This matter considered by the First Circuit Court of Appeals as sufficient to describe the preferred form of the invention appears word for word in both the reissue and the original patent. There can be, therefore, no question that the disclosures are the same. The uniform current of authority in this litigation including the opinions of all the Courts was to the effect that the Tufford reissue is a valid reissue until this last decision of the Court of Appeals of the First Circuit which was, as we said, based in fact upon the proposition that a patentee cannot in his reissue patent make a claim broader than the specific embodiment of the invention or preferred form of device disclosed therein.

If that were the law, there would be no such thing as a broadening reissue because no claim in the original patent could be narrower than the specific disclosure and any broader claim in the reissue must, therefore, necessarily be broader than the disclosure. And this Court, with others following, has time and again held that re-issue claims if made within a reasonable time may be broader than the disclosure in the original, else there could be no such thing as a broadening re-issue, which all know are legion with many such sustained by this Court. (*Topliff vs. Topliff*, 145 U. S. 156 and running both ways as far back as *Morey vs. Lockwood*, 8 Wallace, and down to the present time.) It follows that unless claim 8 is thus remade or rewritten, it is infringed. Even the First Circuit Court of Appeals so held in its first decision.

If the word "rear" were read into the last limitation of claim 8 to make the words thereof correspond to the words in the limitation respecting the edge in all the claims

in suit, claim 8 would still be infringed and still be broad enough to include a heel having straight side edges and still come within Defendant's concession of infringement under the decisions of the Sixth Circuit Courts and Judge Brown, for this concession was made of and these Courts held infringement of claims 5, 6, 7 and 9 which do contain the word "rear."

(2) Defendant asks that all the claims in suit be remade against the patentee by reading a limitation out of the claim and substituting therefor a limitation once in the claim but cancelled and superseded by the present different limitation before the patent issued.

Claims 5 and 6 as presented with the amendment of October 27, 1915 (R. p. 254) contained the expression—

> (e) "the concave upper face lying entirely below a plane *tangent to* the rear upper edge and breast corners of the lift." ([10])

Defendant contends that this limitation recites the curved side edge or three-point contact heel. Defendant says that the quoted language described the particular embodiment of the Tufford heel illustrated and described in the patent and having the curved side edge and that the claims in suit containing this expression are so limited. Defendant says that the solicitor said, page 255 of the record, that this language was not descriptive of a straight edge heel. Assuming that this is so, and that if the claims (except claim 8) had issued with the quoted limitation (e) in them, we would be limited to the curved side edge heel. That does not end the matter, however because the claims were thereafter amended again, eliminating this

([10]) Claims 7, 8 and 9 contain the expression with the following variations. The word "rear" was omitted from claim 8 as we have said; also "said" was substituted for "the" before lift and "of the lift" was added after "face." Claim 7 substituted "attaching" for "concave" and claim 9 omitted "upper" before "face."

very "curved edge" limitation from each of them and broadening them to include a straight edged heel. On page 258 of the record *"tangent to"* was cancelled and *"passing through"* was substituted therefor in each of the claims in suit, making the limitation of claims 5 and 6 read as follows:

> (d) "the concave upper face lying entirely below a plane *passing through* the rear upper edge and breast corners of the lift."

According to Defendant's contention, the claim was at its narrowest when it contained the "tangent to" expression (e), for Defendant says that the claims then read specifically to the embodiment of the Tufford invention illustrated and described in the patent in suit. Since the claims were then at the bottom of the wheel, any amendment to this phrase was necessarily broadening. A more narrowing limitation would have made the claim misdescriptive.

In the *Morgan Envelope Case,* 152 U. S. 425, this Court held that a limitation cancelled from a claim could not be read back into the claim after it went to patent, any more than a limitation placed in a claim could be read out after the claim went to patent. Defendant here asks for a violation of both of these rules. In the *Envelope* case, this Court after re-announcing and citing authorities on the second rule said, (page 429),

> "It is true that these were cases where the original claim was broader than the one allowed, *but the principle is the same if the rejected claim be narrower.* Why the claim of the present patent was allowed after the rejection of the narrower claim, does not appear."

Although it clearly appears in the case at bar why the broader claims were allowed after the rejection of the narrower claims, we might well stand upon the proposition

that the broader expression "passing through" cannot be read out of the patented claim and be within the *Envelope* case. The reason why the broader claim was allowed after the rejection of the narrower claim in the instant case appears from the following:

The Examiner defined the term "passing through" as follows. The original reissue application drawing contained a figure like Fig. 12 below, which was Fig. 2 of that

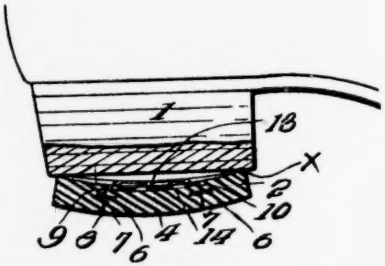

FIG. 12.

drawing. It appeared that there was a line contact between the rubber lift and the heel along the breast line as shown at "X." The Examiner said, in the office action of November 16, 1925 (R. p. 256), that Fig. 2 did not show a structure defined by the limitation (e) then in the claims which contained the expression "*tangent to*" and which we have quoted at the head of this discussion, because, said the Examiner, the reference plane of the claim would then *pass through* the entire front edge of the lift. He said,

> "According to this figure (Fig. 2), a plane tangent to the rear edge and the breast corners would also *pass through* the entire front edge of the lift."

Taking the Examiner at his word that the term "*passing through*" would include a line contact, such as was thought to be shown at "X" in Fig. 12 of this brief, the solicitor amended the claims, striking out the "*tangent to*"

expression which the Examiner had just declared would not describe this line contact, and substituting the term "passing through" which the Examiner had declared would describe the line contact. The claims were thus made broad enough to cover either a curved or a straight edged heel, and since the case no longer contained a claim limited specifically to the curved side edge heel, the applicant added claim 10 which has been held by all of the courts adjudicating the same, to be limited to the curved side edge heel.

The fact that the drawing was amended to make Fig. 2 conform to the other parts of the disclosure and that descriptive matter of the particular embodiment of the Tufford heel disclosed in the application was amplified at the same time, has nothing to do with the case. The suit is on the claims, not on the drawing. Defendant seeks to limit the patent to the drawings. Defendant would heed the amendment to the drawing and ignore the amendment to the claims.

In view of this analysis of the claims, it would seem to be a work of supererogation to genealogize the claims in suit, but as so much has been said on the subject, we will trace the genealogy of claim 5 which, when separated into its elements, reads as follows:

> "A heel lift (a) of substantially non-metallic resilient material (b) having its body portion of concavo-convex form (c) on every line of cross section (d) the concave upper face lying entirely below a plane *passing through* the rear upper edge and the breast corners of the lift."

(1) The reissue application as filed contained a group of claims reciting elements (b) and (c). (R. p. 234.)

For example a claim numbered:

"(5) A cushion heel lift having

(b) a concavo-convex form

(c) on every line of cross section."

These were rejected. The Examiner thought that this limitation did not make the claims patentable over Nerger. Wherever this question has been squarely before the courts in this litigation, the judges have disagreed with the Examiner on this point.

(2) Without acquiescing in this position of the Examiner, but still arguing forcibly against it, the solicitor included claims reciting the elements a, b and c. (R. pp. 248 and 249.)

For example claim—

"(5) A heel lift of

(a) resilient material comprising

(b) a body portion of concavo-convex form

(c) on every line of cross section and normally held in such form by its own inherent resiliency."

(3) The Examiner thought that this expression did not differ from Nerger. The Sixth Circuit Courts ruling on this point have differed with the Examiner.(11) Still

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(11) In an unpublished opinion by Judge Westenhaver in the Tee Pee litigation he said:

"This conclusion renders unnecessary a re-examination of the question whether invention can be based upon Tufford's advance over Nerger merely by eliminating the spring plate which was a material element of the Nerger invention, and *whether a heel lift without the plate, yet constructed in strict conformity to the shape of the heel lift described by Nerger, would be an infringement of any of the claims of Tufford's patent. I held the affirmative of both propositions in Fetzer & Spies Leather Co. vs. I. T. S. Rubber Co. and U. S. Rubber Co. vs. I. T. S. Rubber Co., and do not understand that my conclusions were in either respect criticized or disapproved by the Circuit Court of Appeals but merely that in the latter case the Court preferred to rest its affirmance upon the narrower ground.* Counsel for defendant urge in their brief what seems to me to be conclusive reasons why the conclusions then expressed by me are sound. Such reconsideration as I have since given to these questions confirms me in the belief that my conclusions were correct."

Judge Westenhaver's opinion in the *Fetzer & Spies* case referred to by him was incorporated in the opinion of the Sixth Circuit Court of Appeals (260 Fed. 941). In the *Tee Pee* case that court discussed without deciding this point.

arguing that the claims differed from Nerger, the solicitor added claims (R. p. 254), including Claim 5, which recited the limitations (a), (b), (c) and (e).

"(5) A heel lift
(a) of substantially non-metallic resilient material having
(b) its body portion of concavo-convex form
(c) on every line of cross section
(e) the concave upper face lying entirely below a plane *tangent to* the rear upper edge and the breast corners of the lift."

This claim, when in this form, is said by defendant to be limited to the curved side edge or three-point contact. Assuming that this is so, there is another amendment to be reckoned with for

(4) the claim was again amended (R. p. 258). Amendment (e) with its three-point contact or curved side edge limitation was cancelled out and amendment (d), agreed by the Examiner to be broad enough to include the straight side edge heel, was substituted therefor, and the claim assumed its present patented form, which, when itemized, is as follows:

"(5) A heel lift
(a) of substantially non-metallic resilient material
(b) having its body portion of concavo-convex form
(c) on every line of cross section
(d) the concave upper face lying entirely below a plane *passing through* the rear upper edge and the breast corners of the lift."

Mr. Tufford and his solicitor had, between amendments (3) and (4) labored with the Examiner in oral interviews showing him the Tufford and Nerger heels, mold, etc., and had convinced him of the error of his previous

rejections, for it was then that the broadening of claims 5 to 9 by the elimination of *tangent to* and the substitution of *passing through* occurred. As the last amendment had cleared the case of all claims limited to the curved side edge and as it was desired that the patent should contain such a claim, also claim 10 was added with an avowed statement to that effect. The addition of claim 10 is alone sufficient to rebut the contention that the other claims are so limited and the same. Its addition would have been superfluous were that so.

(3) It is proposed to read "on every line of cross section" into claims 7 and 9. This expression appears in claims 5, 6 and 8, where it modifies both the concave and the convex faces. It does not occur in claim 9 at all. In claim 7 it modifies only the convex face.

It has been held that the term "body portion of concavo-convex form on every line of cross section" occurring in claims 5, 6 and 8 define the so-called "saucer" formed heel and distinguish from the scoop form of the Nerger heel. With this we agree. These three claims differ from Nerger, therefore, in two respects, i. e., the exclusion of the metallic plate and the scoop form.

This limitation was omitted entirely from claim 9. Nothing is said there about the form of the heel. The plan of defining the form was abandoned entirely and the faces were defined. The term "on every line of cross section" was omitted entirely and the following supplied —"the attaching face of which is concave and the tread face of which is convex."

This claim therefore differs from Nerger only in the omission of the plate. The saucer-shaped limitation can be included in the claim only by reading "on every line of cross section" twice into the claim, first, after "concave" and second, after "convex." This, the defendant

asks the court to do that he may escape the charge of infringement.

The liberties proposed to be taken with claim 7 are not so great. It is asked that the limitation be read into this claim only once. Claim 7 like claim 9 omitted the saucer form limitation—"its body portion of concavo-convex form on every line of cross section" and included the following—"a body portion, the attaching face of which is concave and the tread face of which is convex on every line of cross section."

Here, as in claim 9, we find a marked departure from the practice of defining the form as a whole which was followed in claims 5, 6 and 8 and the analysis of the heel into its opposite faces that the desired distinction might be made, showing a clear intention in both claims 7 and 9 to distinguish from the "saucer" limitation of claims 5, 6 and 8. This limitation was in claim 7 omitted from the description of the attaching face, but added to the description of the tread face so that claim 7 differs in this respect from both claim 9 and claims 5, 6 and 8 and from Nerger in reciting both the omission of the plate and the saucer shaped tread face.

That these limitations thus intentionally omitted from claims 7 and 9 cannot be read into them, is conclusively settled by the authorities we have cited, *supra*.

The genealogy of claim 7 repels any effort to read "on every line of cross section" after "attaching face" in that claim.

The original reissue application contained two claims, 5 and 6, (R. p. 234) which read as follows:

—5—

"A cushion heel lift having a concavo-convex form on every line of cross section."

—6—

"A cushion heel lift, the attaching face of which is concave and the tread face of which is convex on every line of cross section."

It is apparent that the draftsmen of the claims did not intend that "the attaching face" in claim 6 should be modified by the expression "on every line of cross section," or that that expression should be read into claim 6, for if that were done, these claims 5 and 6 would be coextensive. Just below these claims appeared original claim 8 which read as follows:

—8—

"A cushion heel lift, *the attaching face of which is normally concave,* and *the tread face of which is normally convex on every* line of cross section thereby to cause the entire margin of the lift to snugly engage the heel of a shoe when said lift is positioned on the heel, and pressure applied to the convex face thereof to flatten said lift."

It would be just as unreasonable and as contrary to the plain intention to read "on every line of cross section" after "concave" in claim 8, as in claim 6.

The original claim 8 was cancelled and reproduced with certain changes as claim 7 on pages 248 and 249 of the record where the expression "the attaching face of which is concave and the tread face of which is convex on every line of cross section" is preserved. This claim 7 was cancelled and reappears with further changes as claim 7 on page 254 of the record, and finally after the amendment at page 258 of the record, as a claim of the patent. The patent claim is, therefore, directly traceable from its inception where the distinction between "concavo-convex form on every line of cross section" and "the attaching face of which is concave, and the tread face of which is

convex on every line of cross section," was clearly made by the examiner.

The genealogy of claim 9 also repels any effort to read "on every line of cross section" into this claim.

At the time that the Examiner was defining the meaning of these various expressions, employing the terms "concave" and "convex," (record pages 234 and 235) claims were inserted using the terms "concavo"-"convex on every line of cross section," "the attaching face of which is concave and the tread face of which is convex on every line of cross section" and "a normally convex tread face, and a normally concave attaching face," which appeared in original claim 10. If "on every line of cross section" had been read into the original claim 10, it would have been co-extensive in substance with original claim 8 presented with original claim 10. The presentation of two claims reciting the same elements and the same function, the one containing and the other not, the term "on every line of cross section" establishes conclusively that this expression was not intended to and could not be read into original claim 10. This latter term was preserved in substance along with the claims using the other two terms throughout the prosecution of the reissue application. Original claim 10, rewritten with some modification, but still preserving the concave and convex statement divorced from the "on every line of cross section" statement appears as claim 8 of the record, page 249. With certain changes, it appears again with the term "concave" and "convex" still divorced from the expression "on every line of cross section," at page 254, as claim 9, and with the further amendment made at record page 259 to this claim, it appears as claim 9 of the patent in suit.

The birth-marks thus acquired by these claims at their inception and clearly defined then by comparison with other

claims, have been preserved throughout the genealogy of the claims and now appear in them as patented. The present attempt to remake the claims under the circumstances violates the clear intention of the draftsman of the claims and the Examiner as well as the rule of law forbidding the remaking of claims.

There is no reason why the claims should be remade. All of them admittedly distinguish from the Nerger patent, the sole survivor of the many patents originally relied upon, in reciting the omission of the metal plate.([12]) If the Examiner thought that such was not a patentable distinction, Judges Westenhaver and Luce, thought so and the Sixth Circuit Court of Appeals assumed that this was so. Mr. Tufford so contended to the end. Claims 5, 6 and 8 admittedly differ from the Nerger patent also by reciting the saucer-shaped limitation.

ARGUMENT: All this technical argument takes no note of the fact that even though the claims were thus remade, there would be infringement under the rule of equivalency. Discussion of solicitor and Examiner, for the most part ambiguous and indefinite, is the main reliance

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([12]) We could not improve upon Judge Westenhaver's finding on this subject (*260* Fed. 945):

> "Moreover, even if the Ferguson or Nerger heel lifts had, in practice, accomplished the same results as the Tufford heel lift, the latter is, in my opinion, still such an advance over the prior art therein disclosed as would amount to patentable invention. The metallic circular washer of the Ferguson and the metallic spring frame with lateral arms of the Nerger heel are obvious disadvantages, and the evidence shows that no rubber heel lift embodying these features is or could be successful in practice. They destroy in large part the resiliency of the heel, which is the main purpose of all rubber heel lifts. They shorten the life of the heel lift, and increase the rapidity with which it wears out. They enhance substantially the cost of manufacture, for a heel lift carrying a metallic plate cannot be molded at a single operation from one piece of rubber, but must be molded in two sections, with two operations."

Since the validity of the claims is admitted, we do not enlarge upon this recital or recount the facts and evidence upon which it is based.

for the contention that the claims be remade to limit the patent to impotency.([13])

Defendant seeks to borrow from the arguments of solicitor and Examiner. The rule at circuit is that these arguments cannot create an estoppel.([14]) The First Circuit Court of Appeals relied in its last opinion largely upon the arguments of solicitor and examiner and its opinion bristles with the court's interpretation of these arguments in support of its restriction of the claims.

Neither remaking nor request therefor was suggested when the admission of validity was made. The plaintiff proceeded in the preparation and submission of his case on the basis that the concession applied to the claims as they appear and Defendant was prompt and vigorous in insisting that Plaintiff's case be so limited. Had we been forewarned by pleadings or other timely advice, we could and would have submitted proof to the effect that "rear" was omitted from claim 8 intentionally and that the Examiner said to Mr. Tufford personally and orally that there was a great difference between the Tufford heel and the Nerger heel, and that he wanted Mr. Tufford to have a broad patent.

([13]) The arguments are grouped as follows:

(1) That Nerger was not concavo-convex on every line of cross section. This does not apply to claims 7 and 9. This expression could not apply to the edges which, of course, are not lines of cross section, but boundary lines. The Examiner did not agree with the Applicant. Whose argument is right then, and which, if either, constitutes the alleged estoppel?

(2) That Nerger's cancavity terminates at the breast so as to leave an opening that prevented the performance of a desired function when the Nerger heel was flattened. This limitation appears in none of the claims. It is proposed to read it in.

(3) That Nerger does not show the concave face of the lift lying entirely below a plane *tangent to* the rear upper edge and breast corners of the lift. This term was once in claims 5, 6, 7 and 9. It never was in claim 8 and is not in any claim in suit.

([14]) *Spalding vs. Wanamaker*, 256 Fed. 530 (C. C. A. 2); *Pangborn vs. Sly*, 284 Fed. 217 (C. C. A. 4).

Such wholesale remaking of claims would be destructive of the examination system of the United States patent practice, for, if the Court is to remake the claims, the work of the Examiner and solicitor is bootless. Neither the public nor the inventor could know the limitations to a patent or how the claims would be turned this way or that, like a nose of wax, by the courts.

The proposed remaking of the claims would come dangerously near to violating if indeed, it did not violate, the well established rule that language in a claim will not be construed to make the claim co-extensive with another claim. It is true that in no case would the verbiage be co-extensive but that is of little moment since substance is the important consideration and remaking the claims as Defendant asks would have the effect of making different claims the same in substance. Reading "rear" into claim 8 would make the limitation respecting the relation of the face to the plane the same in verbiage and substance as in the other claims and would make the claim co-extensive in substance with claim 5. Reading the curved side edge or three-point contact limitation into claim 5 would make that claim for all practical purposes co-extensive with claim 10. Reading "on every line of cross section" into claims 7 and 9 would make those claims co-extensive in substance with each other and with claim 5.

Construction of the claims as they read and without remaking them as Defendant asks, results in a series of claims each differing from the other in substance and each composed of several vital elements. The last element in each claim in suit regarding the position of the attaching face to the plane and over which there is so much controversy describes structure without a re-entrant portion which would prevent the automatic sealing effect. It was important to jettison both re-entrant portions and plates

which would destroy the automatic sealing effect of the patented device.

Nor do the claims, construed as they read and without remaking, seek to recapture what was claimed and cancelled in the original file wrapper. This question was squarely before the Court of Appeals in the Sixth Circuit who in a *per curiam* opinion said (260 Fed. 947):

> "It is said that the substance of the additional claims secured by reissue was asked for and refused in the original application, and hence the reissue was invalid. We do not so interpret the history of the original application."

In view of this we do not think we should burden this Court with an analysis of and a comparison of each of the claims presented in the original application with the five claims in suit. Although the First Circuit Court of Appeals, differed with the Sixth Circuit on this point also, without, however, favoring us with a statement of which claims in the original it thought Plaintiff was seeking to recapture.([15]) It would seem sufficient to call attention to

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([15]) The only suggestion on this point found in the opinion of the First Circuit Court of Appeals is the statement on page 782 of Federal Reporter 1, Second Series, as follows:

> "The proceedings in the Patent Office clearly disclose that the claims in the original application, covering a heel having a concave attaching face and its upper side edges, breast corners, and its rear upper edge lying in the same plane, were disallowed upon references to prior patents; that he acquiesced in such rejection; and that such acquiescence was not occasioned by inadvertence or mistake."

The claims referred to were, of course, much broader than the language quoted. They were broad enough to cover a heel having both the straight edge and the curved edge. They were broad enough to cover the defendant's heel and the plaintiff's heel. It would be just as reasonable to assume that claims limited to the curved side edged heel were invalid in the reissue as to assume that claims covering the straight side edged heel were invalid in the reissue because of these broad claims which were presented in and cancelled from the original application. We recognize the rule that a claim presented and cancelled cannot be recaptured by the reissue, but this rule does not forbid the making in the reissue of a limited claim when a claim had been cancelled from the original application which was broad enough to cover a device described by the limited claim in the reissue. Applicant does not, under such circumstances, seek to recapture what has been presented and cancelled.

the fact that not a single claim in the original application specifically excluded the plate or recited the element in the claims in suit which relates to the position of the attaching face with respect to the reference plane whether such element be left as it reads in the claim or amended as Defendant asks. The violation of the claim as Defendant proposes makes no difference in that respect. In addition to these common recitations, individual claims recite subject matter not recited in any claim in the original application. Each claims 5, 6 and 8 recite "concavo-convex on every line of cross section." Claim 7 recites "convex on every line of cross section." Claim 6 recites "the location of the nail openings near the center." Claim 7 recites "normally held in such form by its own inherent resiliency." Claim 8 recites "a body portion of uniform thickness."

The only claim in the original application which mentions the edges are the claims on page 272 of the record as amended and as amended these claims are misdescriptive since Mr. Tufford's application did not disclose a heel having all its edges occupying the same plane. The claims were void because not supported by the disclosure. It is difficult to conceive of accident or mistake more worthy of correction by reissue than that resulting from the presentation in the original of misdescriptive claims. It also follows, *ipso facto*, that there is no effort to recapture these claims.

The amendments to the specification and to Fig. 2 of the reissue drawing (R. pp. 257 and 260) did not change the disclosure. The former supplemented the description of the particular spherical embodiment disclosed in the original specification and the latter caused Fig. 2 to conform to the other figures of the drawing. The fact that broad terms used are said to describe the particular em-

bodiment shown does not negative the fact that such terms also describe other structures embodying the essential principles of the invention. All through this litigation, the Defendant has asked that Mr. Tufford be limited to the particular embodiment illustrated and described in his patent and denied equivalents because of these amplifying amendments. Not even the First Circuit Court of Appeals sustained this contention (281 Fed. 5).

It has also been insistently contended that the edge of the heel is a part of the heel's face, and therefore the edges must be below the reference plane. Even the Court of Appeals in the First Circuit rejected this contention. As that court pointed out, the claims say that the rear edge is in the plane and therefore applicant intended to define the edge as not a part of the face because the face is said to be below the plane and the rear edge in the plane. (281 Fed. 8.) If the edges were a part of the face, the rear edge would then be both in and below the plane.

The courts have, and this Court probably will be bombarded with these specious technical arguments all designed to draw attention away from the substance and the merit of the invention and its history, and to narrow the protection due the inventor. This Court has recently (261 U. S. 63) restated the rule that a meritorious invention will not be whittled away by legal technicalities. The three trial Judges, Westenhaver, Brown and Luce were close to the devices themselves. They saw the devices operated and heard the witnesses. The usefulness of Mr. Tufford's discovery and the advance he made in the art were clearer to them. This accounts for their liberality. The Courts of Appeals saw and heard none of these things. The rubber exhibits have hardened and dried in the years intervening between trial and hearing on appeal and hence

we now get from them an inadequate appreciation of the usefulness and the advance of the patented invention. The commercial history of the Tufford heel supports the conclusions of its usefulness and advance found by these three trial Judges and its right to a liberal construction.

VIII.

CONCLUSION: Defendant's proposition is plain and daring. Defendant appropriates the substance of an invention which is meritorious and useful and which has substantially advanced this art and which invention is admittedly covered by a valid patent. To relieve itself from its embarrassment, Defendant asks this Court to remake the claims against the patentee, that there may be no infringement where infringement otherwise exists. Nothing warrants so radical a change in the administration of the patent law and one which this Court has herebefore repeatedly refused to make, even to save claims, which stood invalid because of this Court's refusal to remake them.

On the other hand, the claims are entitled to a liberal construction, if such were necessary to hold infringement, because of the usefulness of the invention and the substantial advance made by it and the indubitable appropriation of its substance by the Defendant. The mere fact that there are three different judicial interpretations of the file wrapper already establishes that doubt about a technical matter which is always resolved in favor of a meritorious invention.

IX.

Res Adjudicata: It is contended by the Plaintiff that the conduct of the Essex Company, Defendant here, in participating in and controlling and paying all the expenses of the suit brought by Plaintiff against Wendt

& Company of Detroit, Michigan, a customer of the Essex Company, on the Tufford patent in suit, including the payment of all the expenses of the nominal Defendant, the amount awarded as profits and all counsel fees, with the full knowledge of the Plaintiff that said Essex Company was so doing, amounts to a complete estoppel upon Defendant to deny to any extent the validity of the Plaintiff's Tufford patent, or to deny that the heels charged to be an infringement in the present case are in fact an infringement of the Tufford patent, such heels being identical with the heels restrained in the Wendt case.

The proceedings in the Wendt case were specifically as follows:

I. The Bill of Complaint, Order to show cause why preliminary injunction should not issue, and supporting affidavits were filed April 1st, 1920. (R. p. 183.)

II. Service of the Bill, the Order to show cause, and the affidavits on Wendt on April 6th, 1920. (R. p. 183.)

III. Wendt immediately notified the Essex Company of the suit. (R. p. 296.)

IV. Essex Company notified its New York patent attorneys, the Varney firm. (R. p. 344.)

V. The Varney firm appoints the firm of Angell and Turner, of Detroit, to act as its local solicitor in behalf of the Essex Company. (R. p. 156.)

VI. Angell and Turner, not yet of record, as counsel for Essex, procures consent to adjournment of hearing on injunction (Telegram April 16, 1920, R. p. 156, letter April 26, 1920, R. p. 155). (R. p. 298.)

VII. Mr. Whittemore, one of Mr. Varney's partners goes to Detroit and examines papers and exhibits and searches for a missing exhibit heel in the case. (R. p. 155.)

VIII. Direction by Essex New York attorneys to Angell and Turner to handle the Wendt case (Letter July 30, 1920, R. p. 151).

IX. Angell asks Varney for further instructions. (R. pp. 154, 150.) Such instructions given (R. pp. 153 and 147). Varney instructs Wendt through Angell what to do in suit. (R. p. 153.)

X. Essex Rubber Company guarantees Wendt against all expenses that he might be put to in the suit. (R. p. 297.)

XI. The Essex Company notified Wendt that it would not defend the suit, but would allow the same to go by default. (R. p. 11.)

XII. Accordingly, Angell and Turner did let the case go by default. (R. p. 155.)

XIII. Decree *pro confesso nisi* was entered June 17, 1920. (R. p. 189.)

XIV. A letter from Angell and Turner to Mr. Varney dated October 1, 1920, (R. p. 150) announcing agreement as to terms of settlement of case between Angell and Turner and attorneys for the Plaintiff.

XV. A letter from Mr. Varney to the Angell firm dated October 4, 1920, approving the terms of settlement.

XVI. Stipulation regarding the settlement and stating the terms thereof, and waiving appeal from the final decree of the court in the case signed by counsel for plaintiff and Angell and Turner, counsel for Defendant, entered November 1, 1920. (R. pp. 192 and 193.)

XVII. Final decree entered November 1, 1920, pursuant to the stipulation embodying the substance thereof and holding the patent valid and infringed by the sale of Plaintiff's Exhibit, Defendant's heels, "Tight Edge," as to claims 5 to 10, inclusive, of the patent. (R. p. 193 *et seq.*)

XVIII. The Essex Rubber Company paid through Mr. Wendt the amount of the judgment, the court costs, the local attorneys of Mr. Wendt, and their own attorneys, Angell and Turner, and the Varney firm. (R. pp. 299 and 307.)

XIX. On April 20, 1920, the Essex Rubber Company wrote to Mr. Wendt that the Varney firm was leaving Judge Angell to take care of the interests of the Essex Rubber Company for the present. (R. p. 136.)

XX. On April 13, 1920, the Essex Rubber Company wrote to Wendt, instructing Wendt to be careful to instruct Wendt's local attorney that he should not appear as representing Wendt. (R. p. 133.)

It thus appears, from the foregoing, that Wendt a customer of Essex was instructed by Essex to take no action in the suit, but to suffer a default; that Angell and Turner were employed by Essex to represent their interests; that they took action, by way of stipulations, amounting to a general appearance in the case; that they arranged with counsel for Plaintiff upon the terms of a decree for money in settlement of the cause; that they entered into a stipulation as to those terms and, waiving an appeal, from any decree that might be entered; that a final decree was entered to which they consented, as appears in the body of the decree, in which decree the patent was found valid and infringed by the sale of heels identical with those charged to be an infringement in the instant case and in which there was awarded to Plaintiff, as profits, the amount agreed upon in the stipulation, and which decree also directed a perpetual injunction against the Defendant.

In fine, it appears that the Defendant Wendt was instructed to default and do nothing, which instruction he followed, and the Essex Company, through attorneys of

its selection, directed and controlled all that was done in the case down to the entry of the final decree for and on behalf of the Essex Company, receiving their compensation from the Essex Company and from no other source. The Essex Company, therefore, had control of the defense of this suit, if anybody did, from start to finish, and was as clearly in privity with the nominal Defendant, Wendt, its customer as it is possible for one to be, who is not actually, in name, a party to the record.

There can be no doubt as to the identity of causes of action and of the infringing devices in the two suits. In the Wendt suit claims 5 to 10, inclusive, of the Tufford patent were declared valid and infringed and the infringing heels Plaintiff's Exhibit Defendant's Heels, "Tight Edge" were identically like the heels charged in the present case to be infringements (R. pp. 185, 187, 323, 324 and 32), and were heels in which the side edges were straight and not curved. Hence the final decree in this Wendt case determined for all time as between the Plaintiff and the Essex Company as privy to that suit, that heels having all the other characteristics of the Tufford heels as well as straight side edges are infringements of the Tufford patent. To complete the estoppel, it appears that the Plaintiff knew all the time that the Essex Company was defending and controlling the suit against Wendt and that Wendt had no control or say in the matter. (R. pp. 287 and 288.)

Respectfully submitted,

MELVILLE CHURCH,
F. O. RICHEY,
Attorneys for
The I. T. S. Rubber Company.

RICHEY & WATTS,
Of Counsel.

No. 229

Office Supreme Court, U. S.
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Clerk

IN THE

Supreme Court of the United States

OCTOBER TERM, 1925

THE I. T. S. RUBBER COMPANY,
Petitioner,

vs.

ESSEX RUBBER COMPANY,
Respondent.

ON PETITION FOR WRIT OF CERTIORARI DIRECTED TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE FIRST CIRCUIT.

BRIEF FOR THE RESPONDENT.

LUCIUS E. VARNEY,
of Counsel for Respondent.

IN THE

Supreme Court of the United States

OCTOBER TERM, 1924.

THE I. T. S. RUBBER COMPANY,
Petitioner,

vs.

ESSEX RUBBER COMPANY,
Respondent.

BRIEF FOR RESPONDENT.

Respondent agrees that the Court in the Sixth Circuit has given the patent a broader scope than was accorded by the Court below; but this difference in scope is purely academic, for practically and commercially it is of no importance. The petitioner itself has so maintained in the Tee Pee case, *Tee Pee Rubber Company* v. *I. T. S. Rubber Company, 268 Fed. Rep. 250, 257;* and no rubber heel manufacturer today would consider it an advantage to substitute the narrower interpretation of the Court below for that of the Sixth Circuit which all manufacturers, including this respondent, have adopted and followed in commercial practice ever since it was announced (1919). *U. S. Rubber Co.* v. *I. T. S. Rubber Co., 260 Fed. Rep. 947.*

The rubber heel-lifts to which the patent relates are concavo-convex in shape before being applied to a shoe-heel. In every case where the patent has been litigated, it was either conceded or found that the patent was valid for a particular variety of concavo-convex lift. This variety was characterized by the curvature of the upper and lower faces of the lift which is that of a sphere, or substantially so, and which normally results in making the sides of the lift arched instead of plane or straight. This patented shape has accordingly been denominated by the Courts as "spherical" and the patented heel-lift resulting therefrom as the "three-point contact heel"; and, as just noted, this heel was in every litigated case either conceded or found to be within the petitioner's monopoly.

The only question between the Sixth Circuit and the First Circuit was as to the test to be laid down for determining whether a heel-lift was within this monopoly or not. In the Sixth Circuit, the Court thought and held that the peculiar shape of petitioner's lift was inherent in any concavo-convex lift which was "saucer-shaped" as distinguished from "scoop-shaped"; it found that the nearest patent in the prior art (Nerger) had a relatively low-breast edge making Nerger's lift "scoop-shaped"; and it therefore laid down the determining criterion of infringement to be the height of the breast edge of the lift with respect to its upper face. If the breast was high enough to make the heel "saucer-shaped" rather than "scoop-shaped", then there was infringement irrespective of any other considerations. In the First Circuit, the Court thought and held that the patent was limited to the arched side

edges which, as before noted, everybody concedes to be within the petitioner's monopoly.

In stating it, the difference between the two decisions may seem substantial; but when translated to the heels themselves, it is very slight indeed, so slight, in fact, that it is often difficult to determine. It is simply this: a concavo-convex rubber heel-lift with a low-breast edge is not an infringement anywhere; one with a high-breast edge is an infringement in the Sixth Circuit but not in the First in the absence of the other patented features conceded by everybody.

Following the holding in the Sixth Circuit which came down in 1919, all rubber heel manufacturers, including this respondent, accepted that decision and the criterion of infringement laid down and thereafter made the breasts of their concavo-convex heels low so as to avoid infringement.

Following shortly on this, the Tee Pee case, aforesaid, came before the Court in the Sixth Circuit. There, the petitioner maintained that the Tee Pee heel, which had a low-breast, nevertheless acted the same as the patented (Tufford) heel, that is to say, the two heels were alike in function and results. To this contention, that Court, finding non-infringement, replied as follows, 268 Fed. Rep. 257:

> "If it may be true that sufficiently skillful manipulation of the Tee Pee lifts will make them for a time and in a degree, act like the Tufford lifts, and if it should therefrom be inferred that this distinction in shape between Tufford and the Tee Pee is immaterial, the further inference will be inevitable—since the Tee Pee must be classed with Nerger (prior art) as to this shape—that

there was no substantial distinction in this respect between Nerger and Tufford, and that Tufford and the Patent Office were wrong in the theory upon which alone issue of the Tufford patent was procured."

Respondent believes therefore that this petition should be denied because the difference between the two decisions, when translated into the heels themselves, becomes, as heretofore contended by the petitioner itself, inconsequential. This conclusion is also confirmed by the fact that no rubber heel manufacturers since 1919 have ever considered it an advantage to put out concavo-convex heels with a high-breast edge. When the Court of the Sixth Circuit drew the line between a high-breasted heel and a low-breasted one everybody accepted it,—there was immediate acquiescence.

The decision in the First Circuit came about in this way. This suit was begun in June, 1920, after respondent had ceased to manufacture high-breasted heels following the decision of the Court in the Sixth Circuit. When sued, therefore, respondent was only putting out low-breasted heels which it has continued to do ever since. But being sued on the theory that both the high-breasted heels and the low-breasted heels were infringements, it defended on both,—it was necessary to defend on the high-breasted heels in order to avoid damages for past infringement. It has succeeded in its defence of both forms of heels.

But respondent does not wish to go back to the high-breasted heels even though the decision below permits it to; indeed, respondent would consider it a hardship if it were required to do so. Its low-breasted heel meets all the requirements

of the trade for this type (concavo-convex) of rubber heel; and that is what all rubber heel manufacturers have found. Nobody wishes to put out high-breasted heels,—everybody is willing to accord to the patent that field, in accordance with the decision in the Sixth Circuit, simply because there is no advantage in invading it.

But, naturally, the petitioner itself is anxious for more—to it the decision in the Sixth Circuit is really no better than the decision in the First. It realizes, as it maintained in the Tee Pee case, that even the broader decision does not help it commercially because of the fact that there is no practical advantage in the behavior of high-breast heels over low-breast heels. What the petitioner wants is a chance to argue again, as it did in the Tee Pee case, aforesaid, that its monopoly should be independent of this criterion, that is, that it should include both high-breast heels and low-breast heels—something neither Court would concede.

Respondent submits that the opinions alone in this case and in the cases referred to clearly show that that is what petitioner is after and that the difference between the decisions in the First and Sixth Circuits is wholly unsubstantial and trivial and of no practical importance either to petitioner or the public and is merely being used as a pretext for a further hearing.

Respectfully submitted,

L. E. VARNEY,
Of Counsel for Respondent.

New York,
Dec. 30, 1924.

MAR 8 1926
WM. R. STANSBURY
CLERK

Supreme Court of the United States

OCTOBER TERM, 1925.

No. 229.

THE I. T. S. RUBBER COMPANY,
Petitioner,

vs.

ESSEX RUBBER COMPANY,
Respondent.

BRIEF FOR RESPONDENT

LUCIUS E. VARNEY,
FREDERICK L. EMERY,
Of Counsel for Respondent.

CHAS. F. YOUNG CO., Printers, 127 Water St., N. Y.

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Opinion of District Court (on motion) dismissing the bill on the face of the patent for non-infringement. 270 Fed. Rep. 593.

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No. 229.

THE I. T. S. RUBBER COMPANY,
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Respondent.

JURISDICTION.

This patent case comes here from the first circuit, certiorari having been allowed because a different interpretation was given to the patent in the sixth circuit. This difference is discussed *infra*, p. 43.

The final decree of the court below was entered October 23, 1924 (Rec. p. 362); the petition for certiorari was filed December 22, 1924 and allowed January 12, 1925.

The Patent in Suit.

The validity of the patent in suit was conceded in the answer (Rec. p. 10), infringement alone being denied.

The patent in suit (Tufford patent, copy inserted at page 164 of the record) is a reissued patent entitled *Resilient Heel.* It covers what is more correctly called

a *heel-lift* which is generally about one-half the thickness of a whole heel, is made of rubber, and is nailed to the heel proper (shoe heel) to provide a yielding, as distinguished from a rigid, heel. As such, rubber heel-lifts are in common use and have been known for many years.

These heel-lifts are of two types, the flat type and the concavo-convex type. Both were old when Tufford made his invention. The flat type is cemented to the shoe heel and then nailed, the cement being used to prevent the rubber heel, in use, from working away from the leather heel around the edges. The concavo-convex type is secured to the shoe heel without the use of cement by placing the concave side thereof against the shoe heel, pressing the same flat against the shoe heel, and nailing. The distortion of the rubber produced by pressing the curved heel down flat and so maintaining it by nailing, tends to keep the edges of the rubber lift tightly pressed against the shoe heel, thus making cementing unnecessary. This distinguishing characteristic of concavo-convex heel-lifts is often referred to as a "tight-edge effect" and was known and alluded to as far back as 1899 in Ferguson's patent No. 638,228 (Rec. following page 280) in the following terms:

> "It is obvious that when the concavo-convex heel-section is screwed tightly against the leather heel surface said heel-section will thus be forced to assume the straight or horizontal form of the leather heel-lifts, and owing to the natural tendency of said heel-section to assume its normal curved form it will be seen that the tendency of the raised marginal portion will be to cling closely to the surface of the leather, thereby overcoming the usual tendency of

rubber heel attachments toward lifting up or separating from the leather at the edges."

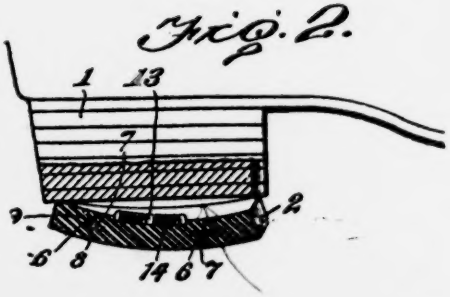
The Tufford heel-lift belongs to the concavo-convex type; and it is obvious that when Tufford filed his original patent application (September 15, 1914), he was only entitled to cover such specific improvements in concavo-convex heel-lifts as he had devised.

Tufford's improvements, as he sets them forth in his patent, are of three kinds. The first has to do with the fastening means which he claims to have improved by providing peculiarly shaped metallic washers through which the nails pass; the second has to do with channels or grooves formed in the concave attaching face; and the third has to do with the form or shape of the heel-lifts themselves.

The first and second of these alleged improvements are covered in claims 1 to 4 inclusive of the patent; and the third, the shape-defining improvements, are covered by claims 5 to 10 inclusive. Since the bill of complaint (Rec. bottom of page 6) limits the charge of infringement to claims 5 to 9 inclusive, we have only to consider these particular claims and the part of the specification which defines the shape or form of the lift upon which these claims are based.

Claim 5, which is typical of the claims in suit, is as follows:

> "5. A heel lift of substantially non-metallic resilient material having its body portion of concavo-convex form on every line of cross section, the concave upper face lying entirely below a plane passing through the rear upper edge and the breast corners of the lift."



Reproduction of Figure 2 of the patent in suit, illustrating a shoe-heel with one of the patented rubber lifts placed in the relation which it occupies thereto before it is flattened down and secured against the shoe-heel. This cut is a longitudinal section taken through the center of the shoe-heel and hence only shows half of the rubber lift. Note particularly that the upper side-edge of the lift, denoted by the arrow, does not contact with the shoe-heel, but is subtended below the plane of the underside of the shoe-heel.

This claim is not difficult to understand even without the specification or drawing; but reference to figure 2 of the patent (reproduced opposite) shows clearly the shape which the patentee had in mind. Figure 2 is described in the patent as "a front to rear sectional view through the lift in position disposed against the under side of a shoe heel and immediately prior to application thereto." It shows that the upper side edges of the rubber-lift, one of which edges is indicated by the arrow in the cut, are arched below the leather heel and hence do not touch the leather heel until the lift has been pressed down and flattened against the leather heel. Before the rubber lift is flattened by being pressed onto the leather heel, it touches the leather heel only at three points,—at the rear end and at the two breast corners; and for this reason is often referred to as the "three-point-contact" lift.

When therefore the claim states that the patented lift has "the concave upper face lying entirely below a plane passing through the rear upper edge and the breast corners of the lift", we understand at once that Tufford refers to this arching of the sides so that the lift, when brought in contact with a shoe heel and before being flattened, touches the shoe heel only at the rear upper edge and the two breast corners,—*i. e.*, at three points which define a plane below which all the other points in the upper concave face lie.

If there were any doubt about this interpretation of the clause, we have only to turn to line 91 of page 2 of the specification (Rec. following p. 164) which is as follows:

"By references to Figs. 2 and 4 of the drawings, it will be seen that the concave upper face of the lift lies entirely below a plane passing through the rear upper edge and breast corners of the lift whereby to cause the entire margin of said lift to exert a uniform pressure on the heel of a shoe when the lift is positioned on the heel and the convex face thereof depressed to flatten said lift. *In other words, owing to the curvature of the concave attaching face of the lift, the rear upper edge and breast corners of said concave attaching face are disposed in a plane above the upper side edges and the breast edges of the lift.*"

We have italicized the last sentence in the above quotation to call particular attention to the very specific and definite meaning which Tufford assigns to this particular clause in all of the claims under consideration. He means to have it clearly appear in his patent that this clause in the claims defines a structure in which *the upper side edges of his heel-lift lie below the reference plane*, which is a very characteristic structure and differentiates the Tufford lift, as we shall later show, from the prior art.

For example, we shall point out later when discussing the file wrapper (*infra*, p. 17), how Tufford inserted this italicized portion of the specification during the prosecution of his application in the patent office and while it was under rejection upon Nerger's patent of November 6, 1900 (Rec. following p. 280), which shows a lift with its upper side edges in a single plane, that is, without any arching and precisely like the side edges of respondent's lifts.

The question is then,—and we think it is the only substantial question in this case, since the validity of the Tufford patent has been admitted in respondent's answer—whether the Tufford patent, and particularly claims 5 to 9 thereof, can be held to cover any concavo-convex rubber lifts except the three-point-contact lifts, that is, those which have the arched side edges so defined in these claims, illustrated in the drawing, and very particularly and definitely described in the specification.

This court, particularly, in a long line of decisions*, has called attention to the fact that one important function of letters patent for inventions is to inform the general public precisely what the patentee has covered by his monopoly and precisely what field is left open for exploitation by others. These decisions point out that when the patentee has explained and claimed his invention in plain language, the public may rely upon that plain language and may safely contract and otherwise do business upon the assumption that the patentee will be held to what he plainly describes and claims as his invention even though it may later appear that his invention was actually broader in scope than he thought when he drew his patent.

This is the very simple case of a rubber heel. There is nothing technical or difficult in the language used

*See for example:

McClain v. *Ortmayer*, 141 U. S. 419; *Brooks* v. *Fiske*, 15 How., 212, 214; *Bates* v. *Coe*, 98 U. S., 31. See also *Evans* v. *Hall Co.*, 223 F. R., 539, 541; *O. H. Jewell Co.* v. *Jackson*, 140 F. R., 340, 347.

to describe it and no reason at all why the patentee's perfectly plain language should not prevail. Anyone familiar with the English language can read and understand the patent and therefore should be safe in acting upon it. Indeed, if the decisions of this court just alluded to can be applied at all, it would seem that they must be applied here.

Rule of Equivalents.

But petitioner has contended in both courts below that under the doctrine of equivalents, Tufford has a right to extend his patent to cover other shapes of heel-lifts provided they function the same way and realize the same advantages and results. But the rule of equivalents cannot be so applied (*Westinghouse* v. *Boyden Power Brake Co.*, 170 U. S. 537, 568-569; *Hubbell* v. *United States*, 179 U. S. 77, 86); for the rule always requires the patented *combination* to be present in some form. If, for example, a claim has three elements, each of these three elements must be found in an infringing structure. One or more of the elements, it is true, may have a different form from that prescribed in the patent; but each and every element must be present and perform the same function, service or purpose as the corresponding element of the claim.

We have nothing of that kind in this case. What the petitioner wants the court to do is to read the arched side edges out of the claim altogether, leaving nothing substituted for this feature; for the moment the location of these side edges becomes unimportant, that moment the last element of the claim drops out entirely. Nothing is substituted for it and hence there is nothing left to perform the same function as that element of the claim. To say, as petitioner does, that the heel-lift *as a whole* functions in the same way and realizes the same results and advantages as the patented heel-lift *as a whole*, is simply to say that a heel-lift having all but the last element of the claim is just as good as a heel-lift having all the elements of the claim. Such situ-

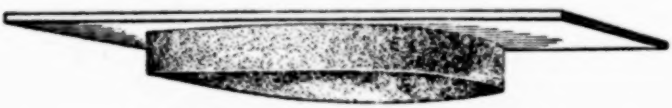
ations have arisen before: but this court has always held that *unless all the elements of the claim are present there is no infringement.*

This rule is so familiar that it is not believed necessary to add any citations; instead, the court is referred to article 349 of *Walker on Patents* and the cases there cited, where the rule is stated as follows: "A combination is an entirety. If one of its elements is omitted, the thing claimed disappears. Every part of the combination claimed is conclusively presumed to be material to the combination, and no evidence to the contrary is admissible in any case of alleged infringement. The patentee makes all the parts of a combination material, when he claims them in combination and not separately."

Comparison of the Patented Heel-Lift With Respondent's Heel-Lift.

Petitioner's commercial heel-lift made under the patent in suit has always been of the three-point-contact type, that is, formed with its side edges arched as illustrated on the opposite page, whereas all respondent's heel-lifts have been made with their upper side edges lying all in the same plane. For comparison, one of respondent's heels is also illustrated on the opposite page, both heels being there shown in relation to the reference plane passed through the two breast corners and rear edge.

Petitioner's commercial heel-lift made under the patent in suit, shown in its relation to a plane passing through its breast corners and rear upper edge. This cut shows clearly why the patented heel is called a three-point-contact heel.



Respondent's heel-lift shown in its relation to a plane passing through its breast corners and rear upper edge. It will be noted that the reference plane necessarily passes through the entire upper side and rear edges because all of respondent's heels are made with their upper side and rear edges in a single plane.

Dismissal on Face of Patent.

This case was originally heard by the district court on a motion to dismiss. The motion to dismiss was brought on in this wise: the respondent sought and obtained, by a bill of particulars, a stipulation defining the precise heels upon which infringement was based; it then moved to dismiss the bill on the ground that it was apparent from the face of the patent that the heels thus alleged to infringe, each of which had its upper side edges in the same plane, could not possibly infringe the claims in suit, and that no evidence could be introduced which would change what was apparent upon, and conclusively fixed by, the face of the patent. (For stipulation and proceedings on motion to dismiss, see Rec. pp. 8, 9.) This motion was granted and the bill dismissed by Anderson, *J.*, who filed a carefully written opinion which is not included in the transcript but is reported in 270 Fed. Rep. 593.

We particularly call Judge Anderson's opinion to the attention of this court because we think that the scope of the patent, which is the only issue here, can and should be determined from the face of the patent without considering the extraneous matters which were offered in evidence.

The practice of determining simple questions of infringement at the outset on motions to dismiss was first established by the court of appeals for the seventh circuit in *Bronk* v. *Charles H. Scott Co.*, 211 Fed. Rep. 338, where it was pointed out that the purpose of the new equity rules permitting a defendant (by bill of particu-

lars or interrogatories) to get into the record of the case at the outset precisely what is claimed to infringed, was "to enable the court to make a summary disposition of a cause by applying the law to an admitted state of facts." In a simple patent case, where the terms of art are clear, where there is no need of expert testimony to explain the functions and operation of a machine or to elucidate some technical matter, and where it appears that no additional evidence whatever could possibly make the clear terms of the claims cover the alleged infringing device, the new equity rules certainly offer an opportunity for a summary disposition of the case. Rule 29, when invoked in such a case, permits the district court to decide whether, in its opinion, the case can probably be disposed of on the face of the patent or whether it should be held for trial on pleadings and proof.

Take the present case, for example. Judge Anderson thought it could be disposed of on the face of the patent for non-infringement, and he accordingly dismissed the bill before any proofs were taken (Rec. p. 9; opinion in 270 Fed. Rep. 593). The court of appeals reversed the decree so entered, on the ground that the plaintiff (petitioner) should have been permitted to take proofs, and so sent the case back for trial (281 Fed. Rep. 5). After the case was heard on pleadings and proof, Bingham, *J.*, for the district court reached the same conclusion as Anderson, *J.*, had previously reached, namely, that there was no infringement; and so the bill was again dismissed. Thereafter, the court of appeals affirmed the decree on the same ground, *viz.*

non-infringement. Thus, the same conclusion was reached by both the district court and the court of appeals on pleadings and proof which Anderson, *J.*, at the outset, had reached on the face of the patent alone by the summary procedure approved in *Bronk* v. *Scott Co., supra.*

The advantage of that summary procedure is that many simple patent cases may be disposed of without the expense of taking proofs which, in patent cases generally, is very burdensome. We realize that, oftentimes, attempted short cuts in litigation result in more expense in the end. But the discretion vested in the district courts under rule 29, permitting those courts to hear the merits of a motion to dismiss or to hold the case for pleadings and proofs according as one or the other of these courses seems best upon a general survey of the case presented by the motion, would seem to go far toward making this a salutary practice *in simple patent cases.*

Since the publication in the *Federal Reporter* of Judge Anderson's opinion dismissing the case, on motion, for non-infringement, counsel for respondent has had many communications from members of the bar concerning this procedure; and it is believed that the approval of this court would go far toward encouraging the bar and the courts to use this summary method wherever possible in simple patent cases. Disapproval of this method and the reversal of Judge Anderson by the court of appeals in this case, if it stands, will tend just the other way.

The File Wrapper Defense.

It has already been pointed out that the patent in suit is a reissued patent, the original patent being No. 1,110,730 dated September 15, 1914 (copy in the Rec. at page 236). Both the file wrapper of this original patent as well as the file wrapper of the reissue patent are in the record. The former is printed beginning at page 263 of the record and the latter beginning at page 229 of the record.

On page 26 of the record, the district court's (Bingham, *J.*) very clear summary of this defense is stated as follows:

> "In the reissued patent he first sought claims for 'a heel lift having a concavo-convex form on every line of cross section'—very broad claims, and in nowise limited as to character or location of the edges of the attaching face of the heel. He was denied these. He then asked for claims somewhat more limited, calling for 'a lift of resilient material comprising a body portion of concavo-convex form on every line of cross-section and normally held in such form by its own inherent resiliency', but so far as the character and location of the edges of the attaching face were concerned equally as broad as the first asked for. These claims were denied and he acquiesced. Finally, on October 13, 1915, he submitted five claims substantially like those previously submitted but all containing the clause 'the concave upper face lying entirely below a plane passing through the rear upper edge and the breast corners of the lift' or its equivalent, which defined the character and location of the edges of the attaching face.

"Such being the case, it necessarily follows that claims which were allowed with the qualifying clause cannot be construed broadly and to cover what would be embraced within the claims as they stood June 22, 1915, or October 13, 1915; for to do so would render the qualifying clause meaningless and give to the present claims an interpretation such as the plaintiff would only have been entitled to had the earlier claims of June 22 and October 13, 1915, not been rejected. The patentee having narrowed his claims by the insertion of the restricting clause, in order to obtain any claims under the reissued patent, cannot by construction or by resorting to the doctrine of equivalents, give the claims the larger scope which they might have had without the restricting clause. Weber Electric Co. *v.* Freeman Electric Co., 256 U. S. 668, 677. Having acquiesced in the rejection of the claims as offered on June 22 and October 13, 1915, he is now estopped from claiming the benefit of those claims or such a construction of his present claims as would be equivalent thereto. Morgan Envelope Co. *v.* Albany Paper Co. 152 U. S. 425, 428, 429. Thomas *v.* Rocker Spring Co., 77 Fed. 420."

There are two points to be noted in considering the file wrapper:

First, that the patentee, Tufford, by reissuing his original patent, sought to add thereto broad claims which, had they been granted, would have given him a monopoly of every heel "concavo-convex on every line of cross-section", that is, irrespective of any other limitation whatever; but the patent office refused to allow any claim as broad as this and forced him to restrict his

claims by the addition of a qualifying clause defining the location of the upper side edges of the lift with reference to a plane passing through the two breast corners and upper rear edge.

Second, that the meaning of this qualifying clause is not open to question because the proceedings in the patent office show precisely what that clause was understood to mean when it was inserted both by the patentee and the patent office. As was stated by this court in *Goodyear Dental Vulcanite Co.* vs. *Davis,* 102, U. S. 222, 227,

> "when a patent bears on its face a particular construction, inasmuch as the specification and claims are in the words of the patentee, it is reasonable to hold that such a construction may be confirmed by what the patentee said when he was making his application. The understanding of a party to contract has always been regarded as of some importance in its interpretation."

In the present case, the file wrapper not only shows how the patentee and the patent office understood the qualifying clause, but also shows that it was only after Tufford had changed his drawing so that the heel-lift illustrated in the drawing would exactly conform to the three-point-contact interpretation of the qualifying clause, that the patent office would allow the claims in issue here.

With regard to the first of these two points, it is only necessary to draw attention to the following portions of the file wrapper of the reissue patent:

(1) Rec. pp. 233, 234, where are set forth the claims asked for when the reissue application was filed. The first four of these claims are the four claims granted and issued in Tufford's original patent. The remaining six claims are the additional claims asked for in the reissue application, of which claim 5 is to be particularly noted, being as follows:

> "A cushion heel lift having a concavo-convex form on every line of cross-section."

By inserting that claim, plaintiff in fact asked for a monopoly of every rubber heel-lift which was concavo-convex on every line of cross-section irrespective of whether it was of the three-point-contact form or not, or had a metal plate embedded therein or not, or, indeed, had by other characteristics whatever.

(2) Rec. p. 238, which shows that all of the claims except the first four (which had been granted in the original patent), were rejected. Rec. p. 243, which shows that this rejection was again repeated after the patentee had replied to it. Rec. p. 245, which shows that claims 5 and 6 were cancelled and the remaining rejected claims amended and submitted again with an argument which appears on pages 246 and 247. Rec. p. 248, which shows that the amended claims were a third time rejected, this time on Nerger's patent of November 6, 1900. Rec. pp. 248, 249, which show that in view of this rejection upon Nerger's patent an entire new set of claims were substituted for all of the claims except the first four which, as before noted, had issued in the original Tufford pat-

ent. Rec. p. 252, which shows that these new substituted claims were also rejected upon Nerger's patent.

(3) Rec. p. 254, which shows that again an entire new set of claims were substituted for all of the claims except 1 to 4 and that each of these new claims contains for the first time a qualifying clause defining the position of the concave upper face with reference to a plane. Incidentally, this qualifying clause is exactly the same as that in the claims here sued on with the exception that the words, *tangent to,* appear in the place of the words "passing through".

Summarizing, at this point: It appears that the patentee had so far obtained the allowance of no claims beyond those secured in his original patent, namely, claims 1 to 4, and that to meet the citation of Nerger's patent he was obliged to add the qualifying clause in question. Furthermore, from the fact that this qualifying clause, as appears, was added after a personal interview with the Examiner at which Tufford had produced one of his commercial lifts for the Examiner's inspection (Rec. p. 255, near the bottom) it is apparent that this qualifying clause was drawn to define the three-point-contact form of lift, that is, applicant's commercial form which is the same as that shown in the drawing.

With regard to the second point above referred to, namely, the understanding of the patentee and the patent office as to what this qualifying clause meant when it was inserted, we call attention to the following parts of the patent office proceedings:

(4) Rec. pp. 256, 257, which shows that the Examiner refused to allow the claims, even with the qualifying clause inserted, because figure 2 of the drawing, as filed, did not show a three-point-contact heel. It will be seen that the Examiner analyzed figure 2, as it then stood, and held that all the points in the breast edge appeared to lie in a straight line passing through the two corner points whereas in the sample lift shown him at the interview "all the points of its breast except the two corner points lie below the straight line passing through these two points" (Rec. p. 257). And so the Examiner refused to allow the claims,—not because they were not in proper form but because the patentee's drawing, as he analyzed it, showed that one of the upper edges (the breast edge) was a straight edge whereas the claims, as he considered them, were for dipped or arched edges, thus forming a three-point-contact heel like the sample lift which had been shown to him. *This obviously left it to Tufford to change the drawing and accept the claims with the interpretation given to them by the Examiner or to stand for the broader construction which petitioner now insists on and appeal from the Examiner's ruling if the latter would not yield.*

(5) Rec. pp. 258, 259 and 260, which show that Tufford accepted the Examiner's view and changed the drawing to remove all traces of a straight-edge heel. Rec. pp. 257, 258, which show that, at the same time, an amendment was made to the specification to make the specification consistent with the change in the drawing. Rec. p. 258, which shows that an amendment was also

made to the claims striking out the words "tangent to" and inserting the words *passing through* because it was evidently thought more correct to speak of a plane passing through three points than as tangent to them.

Summarizing again, it appears from the file wrapper that the patent office was willing to allow claims to cover the patentee's commercial form of heel-lift, that is, one embodying the three-point-contact type and that to define this three-point-contact type the qualifying clause was inserted in the claims; but that the patent office was unwilling to have the claims issue until the drawing and specification had been so changed as to remove every suggestion that *any* upper edge of the heel-lift could be straight, *i. e.*, lie in the reference plane, as distinguished from being arched below that plane, thus showing that the patent office did not intend to grant claims 5 to 9 of the patent unless they were absolutely and strictly confined to the three-point-contact type; and that when this was done by the patentee's acceptance and compliance, said claims were allowed and the patent issued.

Authorities on File Wrapper Defense.

We would observe that this is not merely a case where the file wrapper proceedings in the Patent Office make clear how the language of the claims was understood by the patentee at the time they were allowed, but is a case where the patentee, in order to get the claims, was forced to amend his patent application so as to show clearly that the claims were granted with the limited and restricted meaning which the Examiner had imposed upon them.

If in the one case, it might be argued that the claims ought to be given as broad an interpretation as they will bear notwithstanding that at the time they were allowed they were thought to have a more restricted meaning, it cannot be so argued here where the patentee, as a condition precedent to allowance, acquiesced in the restricted meaning of the claims by changing his specification and drawing in response to the Examiner's insistence that without such change the claims would not be allowed.

One of the most recent patent cases cited by the Supreme Court involving the effect of acquiescence in the Patent Office is *Weber Electric Co.* v. *Freeman Electric Co.*, 256 U. S. 668. On page 677 of the opinion in that case, the Supreme Court said as follows (Itals. ours):

> "*Having thus narrowed his claim* against rotary movement *in order to obtain a patent, the patentee may not by construction, or by resort to the doctrine of equivalents, give to the claim the larger scope which it might have had without the amendments, which amount to a disclaimer* of rotation as an operative feature of his device."

In another case, *Morgan Envelope Co.* v. *Albany Paper Co.*, 152 U. S. 425, the Supreme Court said at pp. 428 and 429 (Itals. ours):

> "the patentee having once presented his claim in that form, and the Patent Office having rejected it, and he having acquiesced in such rejection, he is, under the repeated decisions of this Court, now estopped to claim the benefit of his rejected claim *or such a construction of his present claim as would be equivalent thereto.*"

It does not make any difference in applying the principle of acquiescence, if an applicant for patent who amends his claim after rejection continues to maintain that the original claim, before amendment, was not met by the prior art cited in rejecting it and that his invention is really broader than the amended claim which the Examiner has insisted upon and which was made in pursuance of the Examiner's insistence. This last rule has been stated by Mr. Justice Taft when sitting as circuit judge in *Thomas* v. *Rocker Spring Co.*, 77 Fed. Rep. 420, as follows (Itals. ours):

> "We come now to the novel question presented in this case. It is argued, and the circuit court held, that because the applicants, after the rejection of the claim, and after inserting the required limitations in the specifications, protested that the examiner was wrong in rejecting the claims, and advised him that they proposed to insist on a construction of claims as amended to cover the same ground as the rejected claims, the ruling of the patent office is not to be given the same effect as it would otherwise have. It seems to be contended that an applicant

can qualify or minimize the effect of his acquiescence in the rejection of a claim by stating to the patent office that it is not an acquiescence, and that he expects to insist upon his right to cover the same ground as the rejected claim covered, under other and amended claims. We are clearly of opinion that he cannot thus destroy the effect of a patent office ruling. *If he dissents from it, he should appeal from the ruling.* In this case, if, as the applicants continued to assert in their letters to the patent office, they propose to claim that their invention covered spiral springs used in the platform rocking chairs, they should have carried the question of their right to do so on the occasion of the rejection of the specific claim therefor to the successive appellate tribunals in the patent office, and thence, if necessary, by appeal into court. Not having done so, they must be taken as having acquiesced in the rejection; there is no middle ground. Because of this acquiescence the patent of complainant cannot be construed to embrace any combination of spiral springs with the rockers of platform rocking chairs."

Claim 8.

Petitioner has heretofore made much of the fact that in claim 8 the word *rear* does not appear in the qualifying clause before the words "*upper edge*" and that while all of the claims in suit, except claim 8, specify that the concave upper face of the lift lies entirely below a plane passing through the *rear* upper edge and the breast corners of the lift, claim 8 specifies that this reference plane passes through the upper edge and breast corners, without stating *what part* of the upper edge it passes through. Petitioner argues from this that claim 8 must be construed to mean that the reference plane passes through the *entire* upper edge.

The Court of Appeals, passing on this contention, held as follows (Rec. p. 361):

> "The District Court has found that it clearly appears that a mistake was made both by the Examiner and the applicant in the omission of the word 'rear' before the words 'upper edge' in claim 8 of the reissue patent, and it has been strenuously argued before us that this was error as the court is without power to revise the plain, unambiguous language of the claim. That the claim must be read in the light of the specifications and drawings is too well established to need the citation of any authorities.
>
> Under R. S. sec. 4916 a reissue patent can only be granted for the same invention for which the original patent was granted. Mahn *v.* Harwood, 112 U. S. 354; Parker & Whipple *v.* Yale Clock Co., 123 U. S. 87. In the latter case the court said at page 98:

'Corrections may be made in the description, specification or claim where the patentee has claimed as new more than he had a right to claim, or where the description, specification or claim is defective or insufficient; but he cannot under such an application make material additions to the invention which were not described, suggested, nor substantially indicated in the original specifications, drawings, or patent office model.'

According to the original specification and drawings of the applicant the upper side edges of the entire concave surface of the Tufford lift do not lie in a plane passing through the breast corners and all the upper edges of the lift; and this was expressly disclaimed by the applicant's attorney. Claim 8 of the reissue patent without the word 'rear' before the words 'upper edge' is invalid because not for the same invention as described in the original specification and drawings and would have been so found by the Examiner had he not believed, as it clearly appears from the file wrapper he did, that the word 'rear' appeared in the claim before the words 'upper edge.'

While the defendant has admitted the validity of the patent it has in its answer alleged that the scope of the patent is limited by the proceedings in the Patent Office as shown by the file wrapper.

Construing the claim in the light of the specification and drawings, as well as of the proceedings in the Patent Office, we have no doubt that the words 'upper edge,' used in this claim, refer to the rear upper edge; for, if this were not so, the claim would be invaiid. The plaintiff's invention, therefore, is limited to a heel lift concavo-convex on every line of cross section, whose concave face lies entirely

below a plane passing through its two breast corners and rear upper edge and is not infringed by the defendant's heels."

The District Court reached the same conclusion, reasoning as follows (Rec. pp. 20-22*):

"It will be seen that each of these claims, with the exception of claim 8, contains a clause wherein the concave upper face is described as 'lying entirely below a plane passing through the rear upper edge and the breast corners of the 'lift'; and that in claim 8 the language of the claim is the same with the exception that the word 'rear' before 'upper edge' is omitted. It appears, however, from an examination of the file-wrapper of the reissued patent that the omission of the word 'rear' in the eighth claim was a clerical error due to oversight; that counsel for the applicant and the examiner in charge of the application understood that all these claims as drawn at the time they were allowed contained the word 'rear' preceding the words 'upper edge'. This appears from what will be found in the file-wrapper of the reissued patent beginning on Rec. p. 254 and extending to Rec. p. 260. On Rec. p. 257 the examiner says: 'In each of the claims 5, 6, 7, 8 and 9 applicant specifies 'that the concave upper face lies entirely below a plane tangent to the rear upper edge and the breast corners of the lift' and it there appears that these claims were rejected not because of the wording of the claims, but be-

*NOTE: In the above-quoted opinion of the District Court the references to the pages of the *exhibit* file wrapper have been changed to indicate the corresponding pages in the *printed* file wrapper in the present record.

cause of one of the drawings (Fig. 2) filed in the case. This drawing (Fig. 2) did not at that time conform to the shape of the plaintiff's heel and, because of that, the claims were disallowed as they would not read upon Fig. 2. The only change thereafter made in the claims as they then stood was the insertion of the words 'passing through' for 'tangent to' in the clause here in question, and to define the meaning of the clause as amended, Figure 2 having been changed to conform to the plaintiff's heel, the following provision was inserted in the specification:

> 'By references to Figs. 2 and 4 of the drawings, it will be seen that the concave upper face of the lift lies entirely below a plane passing through the rear upper edge and breast corners of the lift whereby to cause the entire margin of said lift to exert a uniform pressure on the heel of a shoe when the lift is positioned on the heel and the convex face thereof depressed to flatten said lift. In other words owing to the curvature of the concave attaching face of the lift, the rear upper edge and breast corners of said concave attaching face are disposed in a plane above the upper side edges and the breast edges of the lift.'

"This amendment in connection with new Figure 2 clearly shows that the plaintiff's heel was to have a rear upper edge and breast corners located 'above the upper side edges and the breast edges of the lift', and that the words 'passing through' meant a plane passing through the rear upper edge and breast corners and above the side and breast edges.

"The conclusion that the word 'rear' was omitted from the clause under consideration in claim 8 through inadvertence and was a clerical error is

further shown by the language used in the claim itself, for a plane passing through the upper edge, if upper edge meant the entire upper edge as in defendant's heel, would pass through the breast corners as well, and there would have been no occasion for stating in that clause that it passed through the breast corners. Then again, down to the time it was pointed out in the decision of the Court of Appeals of June 7, 1922, the plaintiff had always recognized that this clause in claim 8 read the same as it does in the other claims; that was its position before the District Court before the case was taken to the Court of Appeals; and has apparently been its position before other courts where these claims have been considered."

The face of the patent indisputably establishes that the clause in claim 8 defining the upper face of the lift with respect to the reference plane, refers to the same structure, namely, the three-point-contact structure shown in the drawing, to which the corresponding clause in each of the other claims in suit refers; for, if the clause in claim 8 had meant to imply that the reference plane passed through *all* of the upper edge, then it would have been superfluous for that clause to state that it also passed through the "breast corners", since, obviously, if the plane passed through all of the upper edge it would necessarily pass through the breast corners in which the upper edge terminates. Thus, the inclusion of the words "breast corners" shows conclusively that the words "upper edge" only refer to a portion of the upper edge.

If the words "upper edge" stood alone in the claim

there might be some ground for contention that all of the upper edge was meant; but by defining the plane as passing through the upper edge *and breast corners* as well, the claim itself supplies the internal evidence that only a part of the upper edge not adjacent to the breast corners was intended. This interpretation still leaves room for differentiation in the scope of the qualifying clause in both cases, since in the one case the portion of the upper edge through which the plane passes would be strictly limited to the rear upper edge whereas in the other case it might include a more extended portion.

The other internal evidence of the unsoundness of petitioner's contention is that claim 8, if interpreted as petitioner would have it, will not read upon the drawing nor accord with the specification. The drawing does not have its entire upper edge formed so that a plane could pass through it, and the specification particularly points out (line 101 *et seq.*, page 2 of the patent, printed in Rec. following page 164) that "the rear upper edge and breast corners of said concave attaching face are disposed in a plane above the upper side edges and the breast edge of the lift". One of the first canons of patent interpretation is that a claim must read upon the specification and drawing.

It is unnecessary therefore to look into the Patent Office proceedings to see what the Patent Office and patentee intended by the language used or to show that the word *rear* was omitted from claim 8 through the inadvertence and mutual mistake of the Examiner and the applicant. But if recourse is to be had to the Patent Office proceedings, it will be found that that is precisely

what did happen, as both the court of appeals and the district court below held. It will also be found that in the application for the original patent, of which the patent in suit is a reissue, claims were sought and rejected which called for "the edges of the attaching face all occupying the same plane" (Rec. p. 275, near the bottom). This was noted by both courts below in their opinions, and both courts held that by the cancellation of those claims, Tufford disclaimed any such form of heel-lift.

Claim 10.

This claim is not in issue; but petitioner has pointed out the difference between the language defining the reference plane in claims 5 to 9 and the language defining the reference plane in claim 10, arguing that unless different interpretations are based thereon, claim 10 will become the same as one or more of claims 5 to 9. But such contention overlooks the fact that claim 10 is differentiated from claims 5 to 9 in other respects than by the language defining the reference plane. Judge Bingham has pointed this out so clearly in the opinion in the District Court that we quote the same herewith (Rec. p. 26):

> "It has been argued before me that claims 5, 6, 7, 8 and 9 of the patent cannot be differentiated from claim 10, if the restricting clause of these claims is given the same meaning as the restricting clause in claim 10, and which the specification says means the same. I do not think this is so. Claim 5 is differentiated from all other claims in that it requires the heel lift to be of 'substantially non-metallic resilient material'. Claim 6 is differentiated by the heel being provided with 'nail receiving openings located near the center thereof'; claim 7 by the fact that the heel is 'normally held in such form by its own inherent resiliency'; claim 8 by the body portion of the heel being of 'uniform thickness throughout its entire area'; claim 9 by 'the concave face of the lift being unbroken.' Claim 10 is differentiated from claim 5 by the clause 'substantially resilient material' which is not necessarily non-metallic as in claim 5; from claim 6 by

not having nail receiving openings; from claim 7 by not being held in shape by its own inherent resiliency; from claim 8 by not being of uniform thickness throughout its entire area; and from claim 9 by not having its face limited to an unbroken concave face. Claims 5, 6 and 8 in express terms provide that the body portion of the heel shall be 'of concavo-convex form on every line of cross section'; claims 7 and 10 that the attaching face of the heel shall be 'concave and the tread face convex on every line of cross section'. Claim 7 also contains a whereby clause which states in substance that the elements of the claim are such as to cause the entire margin of the lift to exert a uniform pressure on the shoe heel when said lift is positioned on the heel, and the evidence shows that this uniform pressure can be obtained only in case the breast edge is raised, as well as the side and rear edges. This being so, it follows that the elements described in claim 7 call for a heel the concave face of which is concave on every line of cross section. And what is true of claim 7 is true of claim 10. Claim 9 does not use the term 'on every line of cross section' either as to the concave face or the convex tread, but contains a whereby clause in which it states that 'when the convex tread face is depressed to flatten said lift a suction will be created between the lift and the heel to hold the attaching face of the lift throughout its entire extent in contact with the exposed face of the heel'. While the language of this whereby clause is not the same as the whereby clause in claim 7, it means the same, and the evidence shows that the result here claimed can be produced only in case the breast is raised as well as the side and rear edges of the heel. Further-

more, if claims 7, 9 and 10 are not capable of this construction, they would seem to be invalid, as calling for a heel not disclosed in the specification."

This point was also dealt with in another case where the court disposed of it as follows (*I. T. S. Rubber Co.* v. *United Lace & Braid Mfg. Co.*, 266 Fed. Rep. 375, 379):

> "The argument that through a comparison with claim 10 the claims in suit are to be broadened, and to be so read as to exclude the side edges from the face, seems to me artificial and unsatisfactory, and to require that we should give different meanings to phrases which the specification uses as alternative descriptions of the structure showing the drawings. It does not seem to me essential to make this distinction in order to preserve the substance of the invention which Tufford made."

The Omission of a Metallic Plate.

In some of the suits brought under the Tufford patent, petitioner has argued that the omission of a metallic plate such, for example, as is shown in Nerger's patent, was itself an invention irrespective of anything else which Tufford did; and that Tufford's patent should be broadly construed so as to include all concavo-convex heels where the metallic plate has been omitted.

Even if it could be said that the omission of the plate was an invention by itself, still Tufford is clearly precluded from asserting that his present claims are drawn to cover that invention because he particularly asked for such claims when his application was pending in the Patent Office and when those claims were rejected upon Nerger he withdrew them. This appears in that portion of the file wrapper beginning on page 248 of the record. Beginning on the top of that page, it will be seen that certain claims were rejected upon Nerger's patent then cited by the Patent Office for the first time; and that, in the next amendment filed by Tufford, he cancelled the rejected claims and substituted four new ones numbered 5 to 8 inclusive, of which the following is typical:

> "5. A heel-lift of resilient material comprising a body portion of concave-convex form on every line of cross section *and normally held in such form by its own inherent resiliency.*"

The italicized clause in the claim of course refers to the omission of the plate which Nerger's heel had; for in the "Remarks" which Tufford submitted with these

new claims to support their patentability over Nerger's patent, he refers in the first two paragraphs to several disadvantages which he says Nerger's plate introduces. Then he says that he has overcome all of these objectionable features, that his lift is "devoid of spring or metal plates or other reinforcements" and is "retained normally in its concavo-convex form by the inherent resiliency of the lift only"; and that "by having applicant's lift devoid of metal plates and the like, not only is a greater suction produced but the margin of the heel may be trimmed to fit heels of different sizes * * * thus rendering it unnecessary for the shopkeeper to keep various sizes of heels constantly in stock."

To these remarks, the Patent Office Examiner replies (Rec. p. 252) refusing to concede that the omission of Nerger's plate amounted to invention and again holding that Nerger's patent meets the claims. The claims were accordingly rejected and Tufford was advised that he might "regard this rejection as final if he so desires." That meant that Tufford might appeal from the ruling that it was not invention to omit the metallic plate. But Tufford did not take an appeal. On the contrary, he cancelled the claims and inserted claims 5 to 9 of the patent which now form the basis of the present suit.

It may be pointed out additionally that the Court of Appeals for the Sixth Circuit and the Court of Appeals for the Seventh have both refused to hold that the omission of Nerger's plate in itself involved invention. *Tee Pee Rubber Co.* v. *I. T. S. Rubber* Co., 268 Fed. Rep. 250, 254; *U. S. Rubber Co.* v. *I. T. S. Rubber Co.*, 288 Fed. Rep. 786, 793.

Infringement.

In the present case, respondent is charged with infringement because of its manufacture of two different species of the concavo-convex type of heel-lifts; one, the closed-breasted species like those of "Plaintiff's Exhibit 1, Series A," and the other, the open-breasted species like those of "Plaintiff's Exhibit 2, Series B." Neither species has the three-point-contact feature and hence, if the patent is limited to the three-point-contact feature as both the District Court and the Court of Appeals have held, then neither the Series A nor the Series B heels infringe.

If the decisions of the Court of Appeals of the Sixth Circuit be followed in determining the scope of the patent, then the closed breasted type of Series A heels are infringements but the Series B heels, being open-breasted, are not infringements.

But if this court finds that each of claims 5 to 9 in suit is limited to a rubber heel-lift having its upper side edges arched so as to form a lift of the three-point-contact type, as was held by both courts below, then it is immaterial whether respondent's heels have an open breast or a closed breast; they do not infringe because their upper side edges lie all in one plane.

The Suction Test.

Many of the heels in evidence can be made to stick down to a smooth flat surface by suction; and plaintiff has endeavored to introduce this test as a criterion of infringement. If the heels stick down, plaintiff contends, this is evidence of the intensive sealing around the edges which the patent in suit contemplates and, therefore, such heels should be presumed to have the structure covered by the patent in suit and to be infringements.

The Court of Appeals in the Sixth Circuit has spoken of this alleged test of infringement as follows, *Tee Pee Rubber Co.* v. *I. T. S. Rubber Co.*, 268 Fed. Rep. 250, 256-7:

> "As shown by the opinion in this case, we reached the conclusion that the Tee Pee lifts did not have the peculiarly shaped surface, called saucer shape, which was characteristic of the Tufford invention, but had, rather, the scoop shape which served to classify them with the earlier Nerger device. This conclusion was fortified by observation of the samples submitted, and by certain manipulation by us of the exhibits, as recited. From these, we inferred that the Tee Pee lifts did not have that automatic, intensive sealing at the edges which was symptomatic of the Tufford invention, as we interpreted the claim under discussion. Upon application for rehearing, counsel for plaintiff now challenge the accuracy of the observation and experiments recited in the opinion, *and insist that they can, by experiment in open court, if permitted a reargument, demonstrate that the Tee Pee*

lifts will adhere by suction and will have this intensive sealing, even at the center of the breast edge.

Since counsel have not had the opportunity, we must, in passing on the rehearing petition, assume that they would be able to succeed in their proposed experiments; and, if what was said in the opinion on this subject were vital to the conclusion reached, a rehearing should be permitted. However, we do not regard it as vital."

The Court of Appeals for the Seventh Circuit, quoting the foregoing excerpt from the decision of the Court of Appeals for the Sixth Circuit, spoke as follows about the suction test, *United States Rubber Co.* v. *I. T. S. Rubber Co.*, 288 Fed. Rep. 786, 791:

"We assume that the terms as used are intended to express the pressure of the atmosphere against the exterior of a body that has a vacuum in its interior. Admittedly, when appellee's lift is flattened against a perfectly smooth surface, so smooth that, when the face of the rubber comes in close contact with it, no air can enter between the two surfaces, a vacuum exists in the interior, so that there is a resulting suction on the interior, and air pressing on the exterior. This is due to the air pressure, and to nothing else. It may result from a scoop-shaped object as well as a saucer-shaped one. Its existence all depends upon the existence of a vacuum.

Entirely different, in its source and cause, in our opinion, is the advantage of the Tufford lift's gripping power. That is due to the tendency of curved rubber to regain its shape when flattened. It certainly cannot be contended that a vacuum can be created by any of these lifts upon ordinary leather

heels. It is the gripping power on all its edges that distinguishes the Tufford from the Nerger and appellant's heels, not its suction, which is valueless as an operative element. *Such suction or sealing may or may not be a symptom of Tufford's lift. It may or may not be a symptom of appellant's lift.*"

We think the foregoing quotations leave nothing to be added by way of comment upon the alleged suction test.

The Interpretation Given to the Patent in the Sixth Circuit.

The litigation under the patent in suit was begun in the sixth circuit; and the Court of Appeals there filed its first two opinions on October 7, 1919. These opinions were in two suits which were argued together, namely, *Fetzer and Spies Leather Co.* v. *I. T. S. Rubber Co.*, 260 Fed. Rep. 939, and *United States Rubber Co.* v. *I. T. S. Rubber Co.*, 260 Fed. Rep. 947. In the first of those cases, the infringing heel was a very close copy of the heel illustrated in the patent itself, that is, was of the three-point-contact type; while in the second of those cases, the infringing heel had its upper side edges all in a single plane, like the upper side edges of respondent's heels here. In both of those suits, the validity of the patent was in issue and the principal defense against validity was based upon what a prior patentee, one Nerger, had and did.

The reported opinion in the Fetzer and Spies case states (260 Fed. Rep. 942, 943) that numerous witnesses were called to support Tufford's contention that his invention accomplished the results claimed for it; and, as appears, a very substantial quantity of evidence was introduced as the basis of the fact findings set forth in that opinion relative to the history, development, exploitation, commercial success and results of Tufford's invention.

In addition, it appears, that evidence was also introduced in that case of Nerger's prior activities; for in speaking of Nerger's patent, the court remarked (p. 940) that any uncertainty about what that patent disclosed

was removed "by the evidence as to what Nerger did". See also page 945, where the court refers to testimony in deposition form about the previous sale and use of Nerger's heel, etc. In short, there was substantial evidence in one or both of those suits tending to throw considerable light on what Nerger had and did prior to Tufford, beyond what Nerger's patent disclosed.

In the present suit there is no evidence bearing upon the history, development, exploitation, commercial success, etc., of Tufford's invention; neither is there any evidence, except the Nerger patent, of what Nerger had and did prior to Tufford. It is important to keep this in mind in considering the findings and conclusion of the Court of Appeals for the Sixth Circuit, because, as we shall show, that court was led to its conclusion regarding the scope of the Tufford patent by carefully comparing what the prior patentee, Nerger, had and did with what Tufford had and did.

Turning first then to paragraph numbered "2" of the opinion in the United States Rubber Co. case (260 Fed. Rep. 947), we find it stated that the infringing heel-lift in the Fetzer and Spies case was of the three-point-contact type, while that in the United States Rubber case had "the upper edge of the sides and rear all in the same horizontal plane". That opinion then proceeds to discuss the question, whether the phrase "the concave upper face lying entirely below a plane passing through the rear upper edge and the breast corners of the lift" confines the invention to the three-point-contact type or includes heel-lifts having their upper side and rear edges in the same horizontal plane.

In its discussion of this issue, the court refers to the specification of the patent and notes that in the specification there are two phrases defining the upper face of the lift in similar, though not identical, language and that those phrases are coupled to each other by the connective phrase "In other words" thus:

> "By references to Figs. 2 and 4 of the drawings, it will be seen that *the concave upper face of the lift lies entirely below a plane passing through the rear upper edge and breast corners of the lift* whereby to cause the entire margin of said lift to exert a uniform pressure on the heel of a shoe when the lift is positioned on the heel and the convex face thereof depressed to flatten said lift. *In other words,* owing to the curvature of the concave attaching face of the lift, *the rear upper edge and breast corners of said concave attaching face are disposed in a plane above the upper side edges and the breast edges of the lift.*" (Page 2 of the patent, lines 91-105; Rec. following, p. 164.)

The court in the sixth circuit, after thus alluding to the two descriptive phrases, decides the point as follows (p. 949):

> "The presence of this double and declaredly alternative use of the two phrases presents a serious question, and must challenge the rightfulness of the theory that they mean different things when found in the claims; but, in spite of this, we think the theory should be accepted. 'In other words' does not necessarily imply exact equality. The words are often used to connect thoughts which are similar, but not identical, *and to make them, in this case,*

> *a controlling declaration of identity, would be to permit what we think the substance of the invention, the advance which Tufford had made over Nerger, to be appropriated with impunity.* We will not unnecessarily give claims a construction leading to that result."

The result thus reached by the court in the sixth circuit, *on a record which contained full evidence of what Nerger had and did,* was that Tufford was the first to disclose a heel-lift concavo-convex *on every line of cross-section* and that "The reissued claims (claims 5-10) are limited *to the precise distinction from Nerger, viz., to a lift concavo-convex in all cross-sections*" (p. 947).

But the Patent Office, *which had no evidence before it of what Nerger had and did, except the Nerger patent,* did not reach that conclusion at all. It reached precisely the opposite conclusion; for it found that Nerger's lift *also* "has an upper surface concave on any line of cross-section and a tread surface concentric thereto" (Rec. p. 252). That is to say, the Patent Office held that Nerger's lift was concavo-convex on every line of cross-section. Thus, the very feature which the court in the sixth circuit found to distinguish Tufford's lift from Nerger's lift, the Patent Office found to be actually contained in Nerger's lift. Having so found, the Patent Office rejected Tufford's claims and advised him that the rejection might be regarded as final, if he so desired, which meant that Tufford might appeal (Rec. pp. 252-253); Tufford did not appeal but cancelled t rejected claims and inserted claims 5 to 9 which now form (with a very slight change) the claims in suit (Rec. pp. 253-254) and

which for the first time, in addition to reciting that the heels are "concavo-convex on every line of cross-section", also recite that "the concave upper face lies entirely below a plane tangent to the rear upper edge and breast corners".

And likewise, both courts below, having before them only what the Patent Office had so far as Nerger's lift was concerned, found identically with the Patent Office and therefore held that Tufford had not been allowed claims broad enough to include *all* lifts concavo-convex on every line of cross-section but, rightly or wrongly, had been required to amend his claims by including therein the phrase defining the location of the upper face and side edges with respect to a reference plane; and so concluded that respondent's heels with their upper side edges all in one plane did not infringe.

The court in the sixth circuit gave the name "saucer-shaped" to lifts concavo-convex on all lines of cross-section, to distinguish from the Nerger form which it called "scoop-shaped"; and in a later case, *Tee Pee Rubber Co.* v. *I. T. S. Rubber Co.*, 268 Fed. Rep. 250, the court in the sixth circuit made diagrams illustrating its use of these terms. But neither of the courts in the first circuit found it necessary to make this distinction because both of those courts held, as we have just seen, that as the result of the proceedings in the Patent Office, Tufford could not now maintain a monopoly of all heel-lifts concavo-convex on all lines of cross-section (saucer-shaped heels) and hence did not find it necessary, in determining the question of infringement, to distinguish between "saucer-shaped" and "scoop-shaped" lifts. Per contra, both

courts below found that by amending his claims when they were under rejection by the Patent Office so as to include the descriptive phrase defining the location of the upper face with respect to the reference plane, Tufford could not now successfully maintain that any heel-lifts having their upper side and rear edges all in one plane were infringements. And since all respondent's heels were of that type the bill was dismissed for non-infringement.

The Issue of Estoppel.

Petitioner charges in its bill of complaint, and has argued in both courts below, that respondent participated in the defense of certain prior infringement suits brought under the patent here in suit and is therefore estopped by the judgments in those suits to contest the validity and scope of said patent here.

Assuming that such issue is properly raised by the pleadings in this case, we submit that since petitioner has sought and obtained the writ bringing the case here, upon the ground that two circuit courts have differently interpreted the patent and that therefore this court should determine the scope of the patent for the whole country, it cannot consistently maintain, now that the case *is* here, that respondent cannot be heard upon the very matter which brought it here, namely, the scope of the patent.

Briefly, the facts upon which the estoppel is based are these: Respondent is a manufacturer of rubber heels with its plant and principal place of business in New Jersey, and sells to jobbers located in different parts of the country. Before the action in this case was brought, petitioner sued some of respondent's jobbers in the Middle West. Respondent was not a party to any of these suits and they were not defended. Eventually, *pro confesso* orders were taken therein and interlocutory decrees entered adjudging the patent valid and infringed and sending the cases to a master to take an account of the profits and damages. Respondent thereupon effected a settlement of the profits and damages,

the accountings were waived, final decrees were entered, and respondent paid the costs.

Both the district court and the court of appeals below held that respondent's conduct in these prior suits did not preclude it from contesting fully all patent issues raised by the pleadings in the present action.

If, now, petitioner insists that before these patent issues can be considered here there is an issue of estoppel to be determined by this court, that in effect will be to contend that no patent questions should be heard here on account of the previous conduct of the respondent.

It is submitted therefore that unless petitioner, who brought the case here by representing to this court that the scope of the patent *would be* open for settlement, is prepared to waive the alleged estoppel, this court ought to dismiss the petition as one in which the case, as developed, makes it appear that the writ was improvidently granted. *Furness & Co.* v. *Yang-Tsze Asso.*, 242 U. S. 430; *Layne & Bowler Corp.* v. *Western Well Works*, 261 U. S. 387; *Southern Power Co.* v. *North Carolina Pub. Ser.*, 263 U. S. 508.

The estoppel is pleaded in paragraph 6 of the bill of complaint printed at pages 2 to 6 of the record; and more than half the entire record is made up of evidence which relates to this issue of estoppel and nothing else. This evidence has been so carefully digested by Judge Bingham in the district court and his findings of fact so clearly stated, that we cannot do better here than quote Judge Bingham's summary and findings of fact. At least, we think this court will accept the fact findings of the trial judge so far as this issue is concerned. We therefore

quote from the opinion of the district court (Rec. pp. 15 to 20):

> "In view of the foregoing the plaintiff alleged that the Essex Rubber Company was estopped, by the decree in the Hackman case, to contest the issue of infringement in this case as to heels like Exhibit No. 1, Series A, and by the decree in the Urbansky case to contest that issue as to heels like Exhibit 1, Series A, and Exhibit 2, Series B.
>
> "In support of its allegations as to the Hackman matter it appeared that Hackman & Co. were dealers in rubber heels and had purchased heels from the Essex Rubber Company like those here in question. The plaintiff introduced a certified copy of the record in that suit, which comprised a bill of complaint charging infringement of the plaintiff's patent by the sale of Essex Tite-Edge heels like Exhibit 1, Series A, a motion for a preliminary injunction, a portion of a decree granting a preliminary injunction, a decree styled a final decree, but in fact being only an interlocutory decree *pro confesso*, as it referred the case to a master to ascertain, state and report to the court an account of the damages and profits due to infringing the plaintiff's exclusive rights. The record does not show that Hackman & Co. appeared in the case or filed an answer or that anyone else appeared and filed an answer either in Hackman & Co.'s behalf or in behalf of themselves; and as the record fails to show that a final decree was entered, it necessarily follows that neither Hackman & Co. nor the defendant here is estopped by the interlocutory decree *pro confesso*. McGourkey *v.* Toledo & Ohio Ry., 146 U. S. 536, 545; Smith *v.* Vulcan Iron Works, 165 U. S. 518, 524; Humiston *v.* Stainthorp, 2 Wall. 106; Australian Knitting Co. *v.*

Gormley, 138 Fed. 92, 100, and cases there cited. This renders it unnecessary to consider whether the Essex Rubber Company could, in any view, be regarded as a party to the cause and bound by a decree therein if a final decree had been entered. But I find that the Essex Rubber Company did not defend or control the suit; that on being notified by Hackman & Co. of the bringing of the suit it replied that it would not defend it but would reimburse them, in case they concluded not to defend, for damages that might be recovered against them; and that Hackman & Co. replied that they had no intention of defending the suit.

"As to the Urbansky matter it appeared that Thomas Urbansky & Sons Co. were also dealers in heels purchased from the Essex Rubber Company, and the plaintiff introduced a certified copy of the record in that case, comprising a bill of complaint charging infringement of plaintiff's patent by the sale of Essex Tite-Edge heels, a motion for preliminary injunction, an interlocutory decree pro confesso directing a reference to a master for an accounting, an order fixing the compensation of the master and stenographer and directing that the same be taxed as costs, and an order stating that, as a settlement had been made of all claims for profits, the reference to the master was withdrawn, the interlocutory decree made final, and the plaintiff was to pay all costs. There is nothing in the record that shows anyone filed an appearance or answer in that case for the defendant or took any action in its behalf. The inference to be drawn from the record is that, after the case was sent to the master, before whom it was necessary for the complainant (the present plaintiff) to adduce evidence showing what

its damages were, the plaintiff procured an agreement with Thomas Urbansky & Sons Co. as to the amount due it, obtained satisfaction thereof, and then had an order entered making the interlocutory decree pro confesso final without having any sum adjudged due it as damages, but ordering that the costs incurred be paid by itself.

"The deposition of Thomas J. Urbansky, vice-president and secretary of the Urbansky Company, was introduced in evidence. In it he testified that after the suit was brought against his company he wrote to the Essex Rubber Company that they had been sued and that the Essex Company replied advising the Urbansky Company to let the matter go by default and it would reimburse them for the expense they were put to; that if this request had been contrary to their own interests they would not have acquiesced in it; that neither the Essex Company nor anyone representing them took any part in the conduct of the litigation; that all the Essex Company did was to reimburse them for what they paid out; that he personally arranged the settlement with Mr. Fales, attorney for the plaintiff; that Fales undertook to make him account for damages and profits from the sale of other types of heels in addition to the Tite-Edge; that the Essex Company reimbursed him but that he did not rely upon its promise to do so, as the expense was small and it would have been the same anyway because that company had not undertaken to protect his company against any losses when the goods were purchased. The correspondence between the Urbansky Company and the Essex Company shows that the latter advised the former that it would stand behind its jobbers and pay any judgment which might be obtained against them by

reason of any infringement caused by the handling or sale of its goods; that what The I. T. S. Rubber Company was suing its jobbers for was to compel it to submit its case to the courts out in Cleveland, but that it did not propose to do that, as it had its disadvantages. The deposition of E. D. Fales, a member of the firm of Richey, Slough & Fales, counsel for the plaintiff in this suit, was introduced in evidence and related to the matter now under consideration. Mr. Fales had charge of the Hackman and Urbansky suits as counsel for the plaintiff, and, after taking the depositions of Mr. Urbansky and others in this suit, gave his own deposition. Fales testified that Urbansky told him that the Essex Company had agreed to reimburse his company and that his company was conducting the case subject to the direction and suggestions of the Essex Company, and was doing nothing otherwise. But the correspondence introduced through these witnesses shows that Urbansky made the settlement with the plaintiff without any direction or suggestion from the Essex Company and that all the Essex Company did was to reimburse him after it was notified of the settlement.

"Taking into consideration all the evidence in the case, I find, as a fact, that the Urbansky Company of its own accord permitted the suit to go by default and adjusted and settled the matter of accounting after the interlocutory decree *pro confesso* was entered; that the final judgment made no award of damages, as they had been adjusted and settled by Urbansky out of court; and that the Essex Company did not control the disposition of the case either openly or otherwise. And I rule that the Essex Company is not estopped by the decree in the Urbansky case to contest the question whether heels

like Exhibit 1, Series A, and Exhibit 2, Series B, infringe the claims here in issue.

"In the suit against Wendt & Co. F. O. Richey and E. D. Fales were the counsel, and Campbell, Bulkley & Ledyard were the solicitors for the plaintiff. The record in that case consists of a bill in equity charging the defendant with infringement of the claims here in issue by the sale of Essex Tite-Edge heels like Exhibit 1, Series A; the affidavit of John G. Tufford; the affidavit of Frank M. Slough; an order entered May 3, 1920, to take the bill *pro confesso*, no appearance having been entered on the part of the defendant or answer or other pleading filed, although they should have been on or about the 26th of April, 1920; a copy of an order filed April 1, 1920, directing Wendt & Co. to appear on the 19th of April, 1920, and show cause why an injunction should not issue as prayed for in the bill; an interlocutory decree *pro confesso* entered June 17, 1920, appointing a commissioner to ascertain, take and state an account, and adjudging that the plaintiff on such accounting should have the right to cause the examination of the defendant, his associates, clerks, servants, workmen and other employees, and the production of books, vouchers and documents of such defendant, and that such defendant attend before the master, and awarding a perpetual injunction and costs; a copy of the perpetual injunction filed June 24, 1920; a stipulation filed November 1, 1920, signed September 13, 1920, by F. O. Richey and E. D. Fales as counsel for the plaintiff, and Angell & Turner for the defendant, in which it was stipulated that the defendant would pay at once to the plaintiff one thousand dollars in cash, that the plaintiff would accept the one

thousand dollars in lieu of profits and damages and that no appeal should be taken from the final decree of the court in the case; a copy of a final decree entered November 1, 1920, reciting that the defendant, having made settlement of all claims and profits for the sum of one thousand dollars, the reference to the master was withdrawn, and the plaintiff recover of the defendant the sum of one thousand dollars and the order for an accounting be withdrawn. It further recited the matters set out in the interlocutory decree *pro confesso* as to validity and infringement.

"The record in the Jones & Rosser suit differs in no material respect from the facts shown in the record in the Wendt suit. Both suits were begun at the same time; the patent relied on by the plaintiff in each was the same; the heels charged to be infringements were the same, and the orders taking the bills *pro confesso*, the interlocutory decrees *pro confesso* were of the same character and the respective dates at which they were entered up were the same. As to both matters it appears that Wendt, on April 7, 1920, and Jones & Rosser on April 12, 1920, notified the Essex Rubber Company of the commencement of the suits by The I. T. S. Rubber Company against them, and that the orders to show cause why a temporary injunction should not issue were returnable April 19, 1920, that the Essex Company, being unaware of what heels the plaintiff was relying upon in these suits as infringements, arranged, through Angell & Turner, attorneys in Detroit, to procure, if possible, a postponement of the hearings on temporary injunction so that it might have an opportunity to examine the exhibits and determine whether it desired to appear

and defend; for, if the heels relied upon as infringements included the new type of heel which it was manufacturing, it desired to appear and defend, otherwise not; that Angell & Turner conferred with plaintiff's local counsel, who agreed to a postponement as the plaintiff was desirous of having the Essex Rubber Company appear and defend the suits in that district; that the infringing heels relied upon in the two suits were produced for the examination of New York counsel representing the Essex Company, who, after examining the heels and ascertaining that they did not include the Essex Company's new type of heel, on April 28, 1920. wrote plaintiff's counsel that the Essex Company would not appear and, on April 29, 1920, they wrote Angell & Turner, who also informed plaintiff's counsel that the Essex Company did not wish to appear; that, no appearances having been entered and no answers filed in either case, orders taking the bill *pro confesso* were entered May 3, 1920, and that on June 17, 1920, interlocutory decrees *pro confesso* were entered in both suits; that in July, 1920, the defendants having been ordered to account and the Essex Company being informed of this and having previously written Wendt and Jones & Rosser that they would reimburse them for any losses they sustained by reason of suits, suggested to Wendt and Angell & Turner that they procure an adjustment of the damages and profits in the respective suits; that Wendt and a representative of the firm of Angell & Turner, having ascertained about what the plaintiff would be entitled to recover as damages and profits in the respective suits, proposed a settlement of a thousand dollars and costs in the Wendt suit and two hundred dol-

lars and costs in the Jones & Rosser suit, which were accepted by the plaintiff and final judgments *pro confesso*, based upon these agreements and the interlocutory decrees were entered; that Wendt paid the judgments in the respective suits and was reimbursed by the Essex Company.

"Down to the time of the entry of the interlocutory decrees *pro confesso* and the issuing of the notices to the respective defendants to appear and account, I find that the Essex Company did not exercise control over the management and conduct of the suit; that the respective defendants allowed them to go by default of their own free will, and that the plaintiff had no reason to understand or believe that it was managing or conducting the cases.

Rule 16 in equity provides:

> 'It shall be the duty of the defendant, unless the time shall be enlarged, for cause shown, by a judge of he court, to file his answer or other defense to the bill in the clerk's office within the time named in the subpoena as required by rule 12. In default thereof the plaintiff may, at his election, take an order as of course that the bill be taken *pro confesso*, and thereupon the cause shall be proceeded in *ex parte*.'

"When the orders and interlocutory decrees *pro confesso* were entered, the cases thereupon, as required by the above rule, proceeded *ex parte*. Threafter neither Wendt & Co. nor Jones & Rosser, nor anyone else, had any right to appear and never did appear as a party in defense of either suit. *Frow* v. *De La Vega*, 15 Wall. 522, 554; *Thomson* v. *Worcester*, 114 U. S. 104, 119. And when Wendt &

Co. and Jones & Rosser went before the master in response to his summons to account, they did so as witnesses in the plaintiff's behalf and in no other way. And the fact that the Essex Company co-operated with Wendt and Jones & Rosser through Angell & Turner to bring about adjustments of the damages and profits, which adjustments were used by the plaintiff, in place of the master's findings, as a basis upon which, in part at least, to obtain the final decrees, does not seem to me to be such an exercise of control of the cases as would make the Essex Company a party defendant, even though the plaintiff understood that Angell & Turner represented the Essex Company as well as Wendt and Jones & Rosser in adjusting the damages and profits.

"Before the damages were adjusted the issue of infringement upon which the plaintiff here relies had been decided by the court and embodied in the *pro confesso* decrees (*Thomson* v. *Worcester*, 114 U. S. 104, 113), and, although these decrees did not become binding as an estoppel until the entry of the final decrees and the expiration of the term at which they were entered (*L. E. Waterman Co.* v. *Modern Pen Co.*, 193 Fed. 242, 243), no one sought or procured leave to appear as a party or to in any way interrupt the *ex parte* course which the cases were to take under he rule. After the entry of the *pro confesso* decrees and as long as they stood unrevoked, Wendt & Co. and Jones & Rosser were absolutely barred and precluded from alleging anything in opposition to or in derogation of them, and, as the decrees were never revoked, they were bound by them as to the question of infringement from the date of their entry. *Thomson* v. *Worcester*, 114 U. S. 104, 114.

> Under the circumstances I find that the Essex Company did not control either the Wendt or Jones & Rosser suits, and rule that they are not estopped from contesting the question of infringement raised in this case."

In the court of appeals, the principal point relied upon by petitioner in respect of the issue of estoppel was that the attorneys (Angell and Turner of Detroit) hired and paid by the respondent here, put their names to the final decree in the Jones & Rosser suit (Rec. p. 178) and to a stipulation for final decree in the Wendt suit (Rec. p. 193), petitioner arguing that that of itself was such a participation by respondent in each of those cases as to bar respondent's right to litigate any of the issues settled by those decrees.

As already noted in the quoted portion of Judge Bingham's opinion, Angell & Turner were retained by respondent's New York counsel to get information as to what heels those two suits involved and to get a postponement of a motion for preliminary injunction in one of the suits. Angell & Turner had no authority to enter any appearances nor to take any action whatever in those suits except to seek an adjournment. They were fully instructed that the respondent did not wish to defend unless respondent's new form of lift was to be made the basis of a charge of infringement. As soon as respondent's New York counsel could get out to Detroit and ascertain that the new form of respondent's heels was not involved, Angell & Turner were promptly notified that respondent would not defend but would allow the cases to go by default (Rec. p. 155). And the

Detroit counsel were asked to notify respondent's New York counsel when any accounting proceedings were brought on in pursuance of the interlocutory decrees entered (Rec. p. 155). This was during the month of April, 1920; thereafter nothing occurred until the middle of July, 1920, when the following letter was addressed to one of the Detroit firm of attorneys by one of respondent's New York attorneys (Rec. p. 154).

"New York, July 7, 1920.

Dear Judge Angell:

I understand that Mr. Wendt has been ordered to account to the I. T. S. Company in the Heel litigation and that he has communicated with you in the matter. Will you please advise him on this accounting?

For your information I may say that the Essex Rubber Company has now been sued by the I. T. S. Company in Boston and the matter will be fought out there. I suggest therefore, that you get as long a postponement as possible on this accounting. We will probably communicate with you further.

Very truly yours,

MANVEL WHITTEMORE."

At this time Wendt had no longer the status of a party to the suit but was merely a witness summoned to give a deposition on the accounting. He was however entitled to counsel; and respondent here, having agreed to pay whatever was recovered on the accounting, was also entitled to have a legal representative attend the proceedings and advise the witness. The instructions given to the Detroit attorneys were in no

way inconsistent with the issues settled by the *pro-confesso* decrees. No attempt was made to reopen or upset those decrees. The only question left open and of interest to either party was the *amount* of recovery. Had the Detroit attorneys attempted to reopen the decrees or do anything in derogation thereof, that would have necessitated other instructions and further authority.

The Detroit attorneys replied on July 15 that "it might be advisable to settle on some basis." (Rec. p. 153.) The New York attorneys wrote on July 20 suggesting that $1,000 be offered (Rec. p. 152) and this was done (Rec. p. 150). On July 26, the Detroit attorneys asked to be advised if they should take any action in the accounting in the Jones & Rosser suit as to which they had been approached by a Mr. Wicker who had been handling that matter as attorney for Jones & Rosser (Rec. p. 152); and the Detroit attorneys were accordingly advised to handle both of these accountings together (Rec. p. 151). On September 8, the Detroit attorneys wrote that plaintiff desired to settle both cases for $1,000 a case (Rec. pp. 150-1). The New York counsel replied to settle the Wendt case at that figure (Rec. p. 150), and finally on October 1, Detroit counsel wrote that a settlement of the Wendt case for $1,000 had been agreed to, that Mr. Wendt had given a check for that amount, but that the costs still remained to be settled for (Rec. p. 150). On November 1, the Detroit attorneys wrote that they had arranged a settlement in the Jones & Rosser case for $200 and costs and that a stipulation to that effect had been signed and entered (Rec. p. 147).

That correspondence tells the whole story. It explains exactly what took place,—what led up to the approval of the final decree by the Detroit attorneys in the Jones & Rosser case and to the signing of the stipulation for the final decree in the Wendt case. We have recited all of the instructions which were given to the Detroit attorneys and everything the Detroit attorneys did. It would be pushing technicalities beyond the limit to hold that because these Detroit attorneys attached their signatures to the papers in question merely to approve the settlement that had been reached in each case,—the only thing they had authority to approve—can now deprive the respondent here of its day in court. So long as the interlocutory decrees required no approval whatever on the part of this respondent, or anybody else, save only in respect of such matters as were left open for settlement, any formal signatures appearing on the final decrees and purporting to approve the same, or to consent to their entry, relate only to such matters as were left open and needed approval and consent for the purpose of entry.

Summarizing then: The moment petitioner got its decrees *pro confesso*, it was entitled to proceed to final decrees. To do so, it started accounting proceedings. Settlements were made and the accountings waived. Petitioner did not need the approval of anybody in order to enter final decrees except in so far as these decrees evidenced the amount of recovery set forth therein which had been agreed upon. To evidence this agreement on the amount of the recovery, the Detroit attorneys signed their names,—to the final decree in one case and to the stipulation for the final decree in the other case. Their approval and consent to anything else was mere sur-

plusage and even if given, would have been wholly beyond their authority to give. Petitioner never at any time believed that respondent was attacking the interlocutory decrees.

This court has recently (January 11, 1926) handed down an opinion involving a similar question of estoppel but on a different state of facts. *Independent Wireless Telegraph Co.* v. *Radio Corporation of America,* No. 87, October Term, 1925. In that case, the court was dealing with the effect of a decree on a party beyond the reach of process who, though a necessary party had declined to take part in the case though he knew of its imminent pendency and of his *obligation to join;* and in deciding the point, this court referred to the prior case of *American Bell Telephone Co.* v. *National Telephone Co.,* 27 Fed. Rep. 663. In both of those cases, one of the controlling factors was the existence of an obligation binding the party to join in litigation against its licensees—the litigation which had resulted in the decree sought to be enforced aganst it. In the present case, there were neither licensees nor obligations to defend. Respondent never agreed to *defend* the suits against its jobbers and was under no obligation to do so. Moreover, those suits could be prosecuted to a conclusion without the necessity of joining the respondent. Furthermore, respondent never at any time participated in the defense of the suits against its jobbers and hence never voluntarily made itself a party thereto, as the defendant did in the case of *American Bell Telephone Co.* v. *National Telephone Co.* It seems clear, therefore, that there is nothing in the decision of this court in the Independent Wireless case that can be applied to the present situation.

SUPREME COURT OF THE UNITED STATES.

No. 36.—October Term, 1926.

The I. T. S. Rubber Company, Petitioner, *vs.* Essex Rubber Company.	On Writ of Ceritorari to the United States Circuit Court of Appeals for the First Circuit.

[November 22, 1926.]

Mr. Justice Sanford delivered the opinion of the Court.

This is a suit in equity brought by the I. T. S. Rubber Company against the Essex Rubber Company in the Federal District Court for Massachusetts, for the infringement of United States patent No. 14,049, on resilient heels, reissued to the I. T. S. Company January 11, 1916, as assignee, on an original patent to John G. Tufford, issued in 1914. After final hearing on the pleadings and proof[1] the bill was dismissed by the District Court for want of infringement. This was affirmed by the Circuit Court of Appeals, 1 F. (2d) 780. And there being a conflict of opinion with the Circuit Court of Appeals for the Sixth Circuit as to the scope of the patent, this writ of certiorari was granted.

The Essex Company, which manufactures and sells the heels alleged to infringe, expressly admitted the validity of the reissued patent. And the only questions are: First, whether it is estopped to deny infringement; second, if not, whether infringement is shown.

1. In the courts below the I. T. S. Company relied on estoppels by reason of adjudications in various prior suits brought by it in the Sixth Circuit against dealers in the Essex Company's heels. In the brief for the I. T. S. Company in this Court it is asserted, in general terms, that the action of the Essex Company "in suits brought against its jobbers in the Sixth Circuit estop it from denying infringement here," and that the Circuit Court of Appeals erred in holding that it was not estopped by the

[1] Various intermediate proceedings, on a preliminary motion to dismiss, appear in 270 Fed. 593 (D. C.), 276 Fed. 478 (C. C. A.), and 281 Fed. 5 (C. C. A.).

decrees in such suits. The argument in the brief, however, specifies and deals with only one of such prior suits; and there being as to the others no semblance of compliance with the requirements of Rule 25 of this Court,[2] we need consider only the suit specifically relied on.

That was a suit brought by the I. T. S. Company against one Wendt, a dealer in Essex heels of a type involved in the present suit, in which infringement of the patent was adjudged. The I. T. S. Company contends that the Essex Company, although not a party of record, took entire control of the defense, participated in the suit until the final decree, paid all the expenses, and is now estopped from denying infringement as therein adjudged.

The material facts found by the District Court are: The Essex Company, after being notified by Wendt of the commencement of the suit, notified the counsel of the I. T. S. Company that it did not wish to, and would not, appear. Wendt thereafter voluntarily allowed the suit to go by default, and an order was entered taking the bill *pro confesso*. This was followed by an interlocutory decree *pro confesso* adjudging the infringement of the patent and Wendt's liability for damages and profits, and ordering an accounting. Down to the entry of this decree the Essex Company exercised no control over the management and conduct of the suit. Thereafter the Essex Company, having previously written Wendt that it would reimburse him for any losses he sustained by reason of the suit, suggested that he and counsel whom it had employed procure an adjustment of the damages and profits. Wendt and the counsel for the Essex Company thereupon secured an agreement to settle the case by Wendt's payment of $1,000. This was embodied in a stipulation signed by the I. T. S. Company's counsel and by the Essex Company's counsel as counsel for Wendt, and filed in the case. This stipulation, with the interlocutory decree, was thereafter made the basis of a final decree, re-adjudging

[2]This rule provides that the brief for the plaintiff in error, appellant or petitioner shall contain, *inter alia*, a "concise statement of the case, containing all that is material to the consideration of the questions presented, with appropriate page references to the printed record," cl. 2(d); a "specification of such of the assigned errors as are intended to be urged," cl. 2(e); and an "argument exhibiting clearly the points of fact and of law being presented," cl. 2(f). 266 U. S. 671.

the infringement, reciting the settlement, and adjudging that the I. T. S. Company recover of Wendt $1,000 and the costs of the suit. Wendt paid this judgment and was reimbursed by the Essex Company. The District Court further found specifically that, under the circumstances, the Essex Company did not control the suit; and held that, even though the I. T. S. Company understood that the counsel negotiating the settlement represented the Essex Company as well as Wendt in adjusting the damages, it was not estopped from contesting the question of infringement raised in the present case.

On the appeal the Circuit Court of Appeals stated that the record showed clearly that the Essex Company refused to become a party to the suit or assume any control over it, and took no part in the conduct or control of the suit, "but only in the adjustment of the damages" after the *pro confesso* decree had been entered; and approved both the findings and ruling of the District Court.

There is nothing which, under the well settled rule, *Del Pozo* v. *Wilson Cypress Co.*, 269 U. S. 82, 89, justifies us in disturbing the concurrent findings of fact of the two courts below; and we concur in their ruling that on the facts thus found the Essex Company is not estopped from contesting the question of infringement.

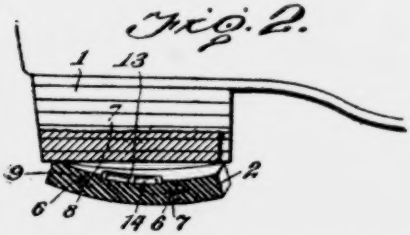
2. The question of infringement as here presented turns upon matters of law arising out of a file wrapper defense interposed by the Essex Company, which insists that the reissued patent, although valid, was so limited in scope by the proceedings in the Patent Office that the Essex heels do not infringe.

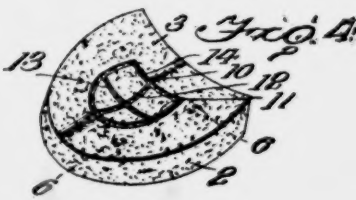
The patent covers the part of a shoe commonly called a rubber heel, or cushion heel lift.[3] This is usually made of rubber, and is attached to the under side of the leather heel so as to furnish a yielding, resilient heel, giving softness to the tread and quietness in walking. These heels, which are in common use, are of two types, the flat and the concavo-convex, both of which were old when Tufford made his invention. The flat heel, which is the older, is cemented to the leather and then fastened on by nails or screws. The driving in of the nails or screws, however, has a tendency to cause the rubber to spring away from the leather around the edges

[3]The under layers of shoe heels were called "lifts" by the cobblers.

and produce an open seam. In the concavo-convex type the body of the rubber heel is curved downwards. It is attached to the leather heel, without any cement, by placing its upper concave side under the leather, pressing it upward flatly and then nailing or screwing it on tightly. This, through the tendency of the rubber to resume its original curved form, tends to keep it tightly pressed upwards against the leather and overcome the tendency of the flat heels to separate from the leather at the edges. This characteristic of the concavo-convex heels, often called "the tight-edge effect," was referred to as early as 1889 in Ferguson's patent No. 638,228.

The Tufford heel is of the concavo-convex type. We insert here reproductions of Figure 2 of the drawings of the reissued patent, which is described as "a front to rear sectional view through the lift in position disposed against the under side of a shoe heel and immediately prior to application thereto", and shows one-half of the lift on a median section; and of Figure 4, which is described as "a perspective view looking at the upper side of the lift removed."





The reissued patent contains ten claims. The first four, which repeat the claims of the original patent, relate merely to the form and position of the washers in a cushion heel lift, and to grooves, channels and suction areas in its concave surface. They are not here involved. The others are additional claims relating to shape defining improvements. The bill charges infringement of the new claims 5 to 9, inclusive. Claim 5 reads:

"A heel lift of substantially non-metallic resilient material having its body portion of concavo-convex form on every line of cross section, *the concave upper face lying entirely below a plane passing through the rear upper edge and the breast*[4] *corners of the lift.*"

[4]The "breast" is the front face of the heel.

The last clause in this claim, which we have italicised—about which the present controversy turns—is contained in all the other claims in suit in identical or precisely equivalent words, except that in claim 8 the word "rear" does not appear before the words "upper edge."[5] For immediate purposes we treat claim 5 as typical of all the claims in suit, passing for the moment the consideration of the question whether there is any essential distinction in respect to claim 8.

The Essex Company contends: (1) That by the proceedings in the Patent Office these claims were limited to the form of concavo-convex heel lift in which the concave upper face lies entirely below a plane passing through the rear upper edge and breast corners, that is, one in which, owing to the curvature of the upper face, only its rear edge and breast corners lie in the same horizontal plane, and its side and breast edges, as well as all other portions of its surface, lie below the plane passing through and defined by these three points—this being referred to as the "three-point-contact" form, since when the lift is brought in contact with the leather heel, before being flattened, only the rear edge and two breast corners will touch the leather. (2) That the claims, thus limited, are not infringed by the Essex heels, as their upper side edges, having no vertical curve, lie in and not below the plane passing through the rear edge and breast corners.

The file wrapper shows that on the application for the reissued patent it contained as first presented no reference to the position of the upper rear edge and breast edges of the lift in relation to the other portions of its upper surface. Several new claims were submitted some of which, at least,[6] described a lift having its attaching face concave on every line of cross section. These were rejected by the examiner on reference to Nerger's patent No. 661,129. Another set of claims was then substituted describing a heel lift of resilient material comprising a body portion of concavo-convex form on every line of cross section and normally held in such form by its own inherent resiliency. These were also rejected by the examiner on reference to Nerger.

After an interview with the examiner in which the applicant exhibited samples of his own lift and the Nerger lift, he then

[5]All these claims are set forth in full in the opinion of the Circuit Court of Appeals, at p. 781.

[6]The file wrapper does not set forth all of these claims.

amended the specification by inserting the statement: "By reference to Figs. 2 and 4 of the drawings, *it will be seen that the concave upper face of the lift lies entirely below a plane tangent to the rear upper edge and the breast corners of the lift*, whereby to cause the entire margin of said lift to exert a uniform pressure on the heel of a shoe when the lift is positioned on the heel and the convex face thereof depressed to flatten said lift." He also substituted another set of claims, 5 to 9, inclusive. Claim 5—which was typical of all the others unless claim 8 was differentiated by the fact that the word "rear" did not appear before the words "upper edge"—read: "A heel lift of substantially non-metallic resilient material having its body portion of concavo-convex form on every line of cross section, *the concave upper face lying entirely below a plane tangent to the rear upper edge and the breast corners of the lift.*"

In presenting these amendments counsel for the applicant urged that Nerger's lift was not concavo-convex on every line of cross section since the deepest portion of the concavity in its upper surface was at the breast; and that its concave upper surface did not lie entirely below a plane tangent to the rear edge and breast corners. In replying, the examiner, after calling attention to the fact that on the application for the original patent the applicant had presented claims for a lift in which all the edges of the attaching face occupied the same plane—which were rejected—stated that Figure 2 of the drawings indicated the same construction and did not show a lift whose concave upper face lay entirely below a plane tangent to the rear upper edge and breast corners, as set forth in the amendment to the specification, since a point midway between the breast corners was in contact with the upper heel, and "a plane tangent to the rear edge and the breast corners would also pass through the entire front [breast] edge"; that the applicant's sample lift did "not correspond to the drawing, since all the points of its breast except the two corner points lie below a straight line passing through these points"; that in "each of the claims 5, 6, 7, 8 and 9 the applicant specifies that the concave upper face lies entirely below a plane tangent to the rear upper edge and the breast corners"; and that these claims do "not read on the drawing, and are therefore rejected."

To meet this rejection the applicant further amended the specification by substituting for the prior amendment the statement:

"By references to Figs. 2 and 4 of the drawings, it will be seen that the concave upper face of the lift lies entirely below a plane passing through the rear upper edge and breast corners of the lift . . . *In other words, owing to the curvature of the concave attaching face of the lift, the rear upper edge and breast corners of said concave attaching face are disposed in a plane above the upper side edges and the breast edges of the lift.*" He also amended each of the claims by substituting the words "passing through" for "tangent to"—corresponding to the change that had been made in the specification—and added claim 10, reading: "A heel lift of substantially resilient material comprising a body portion, the attaching face of which is concave and the tread face convex on every line of cross section, the rear upper edge and breast corners of the concave attaching face of the lift being disposed in a plane above the upper side and breast edges of said concave attaching face." In presenting these amendments counsel for the applicant stated that the matter quoted by the examiner from the file wrapper of the original patent merely showed, if anything, that error had crept into the prosecution of the original application, which should be corrected; that as Figure 4 of the drawings showed "that the breast lift was cut away on a curved line, the attaching face of the lift at the breast thereof must necessarily lie in a plane below the breast corners and the rear edge of said lift or, in other words, the rear upper edge and breast corners of the concave attaching face are disposed in a plane above the upper side and breast edges thereof"; that the showing in Figure 2 was therefore obviously erroneous, and, although claim 10 read upon it without any correction, it did not clearly illustrate the applicant's invention; and that permission was requested to correct the drawing. This was granted, and Figure 2 was changed to the form which we have reproduced in this opinion, showing that the upper side and breast edges lie below a plane passing through the rear edge and breast corners. The new claims were then allowed, and the patent was re-issued.

It thus appears that the applicant acquiesced in the successive rejections by the examiner on reference to Nerger of claims for a lift having its attaching face concave on every line of cross section and for a lift of resilient material of a concavo-convex form on every line of cross section, and that to meet this reference he amended the specification so as to state not only that the concave upper surface lies entirely below a plane passing through the rear upper

edge and breast corners, but that "in other words", owing to the curvature of the concave attaching face the rear upper edge and breast corners are disposed in a plane above the upper side and breast edges; amended the claims to describe a lift whose concave upper surface lies entirely below a plane passing through the rear upper edge and breast corners; and finally changed his drawing so as to correspond precisely with these amendments—and that then, and not until then, were the claims allowed.

We think that by this proceeding the claims were limited to the specific form of a "three-point-contact" lift, that is, to one in which, owing to the vertical curve of the upper side and breast edges, these edges, as well as all other portions of the upper surface, lie below the plane passing through and defined by the rear upper edge and breast corners. We cannot agree with the opinion of the Circuit Court of Appeals for the Sixth Circuit in *United States Rubber Co.* v. *I. T. S. Rubber Co.*, 260 Fed. 947, 948, that claim 10, which contains the limiting clause "the concave attaching face of the lift being disposed in a plane above the upper side and breast edges", is the only one which is limited to the three-point-contact lift. It is true that if the limiting clause in claims 5 to 9, "the concave upper face lying entirely below a plane passing through the rear upper edge and breast corners," stood alone, there might be some question as to whether the side and breast edges were to be considered as a part of the upper face. However, the meaning of this clause was made entirely clear by the last amendment to the specification, adding to the previous statement that the concave upper face lies entirely below a plane passing through the rear upper edge and breast corners, that, "in other words", the rear upper edge and breast corners are disposed in a plane above the upper side and breast edges. We are unable to agree with the view that the phrase "in other words" was here used to connect alternative thoughts which were not identical, and think that they were used in their ordinary sense to introduce a specific element of the identical matter previously described, precisely defining a lift whose upper surface lies below a plane passing through the rear edge and breast corners as one whose upper side and breast edges lie below this plane—this being emphasized by the statement made by counsel for the applicant and the corresponding change which was made in the drawing. The limiting clause in claims 5 to 9 must therefore be read in the sense in which it is thus defined by the specification, that is, as referring to a

three-point-contact lift whose side and breast edges, as well as all other points in its upper surface, lie below the plane passing through the rear edge and breast corners.

There is no ground for differentiating claims 5 to 9 from claim 10 in this respect in order to give effect to claim 10. The Circuit Court of Appeals for the Sixth Circuit expressly declined to rest its conclusion on this ground (p. 948). And as to this it sufficies to say, that, as was pointed out by the District Judge, claims 5 to 9 are sufficiently differentiated in other respects by the presence of subsidiary elements relating to the character of the material, nail openings, etc., that do not appear in claim 10.

We find, further, no significance in the substitution of the words "passing through" for "tangent to" in the specification and claims. These phrases were used interchangeably by the examiner. The applicant pointed out no distinction in their meaning, and, so far as appears, merely adopted "passing through" as the preferred form of equivalent expressions. And they have no difference in meaning as used in the specification and claims; the one phrase as well as the other aptly defining the plane passing through the upper rear edge and breast corners.

We also find that the fact that the word "rear" does not appear before the words "upper edge" in claim 8 is not a ground upon which it may be differentiated from the others. It appears that this omission was inadvertent and unnoticed. The applicant called no attention to the omission and did not differentiate this claim from the others in his effort to avoid the reference to Nerger's patent. The examiner stated that "each of the claims 5, 6, 7, 8 and 9" specified a plane tangent to "the rear upper edge and the breast corners." And we cannot believe that if the applicant's counsel intended to differentiate this claim from the others by the omission of the word "rear," he would have failed to disclose the distinction which he had in mind and permitted the examiner to pass upon the claim under a misapprehension as to its language. It was also stated by the District Judge that at the preliminary hearing on the motion to dismiss, the I. T. S. Company recognized that this clause in claim 8 read the same as in the other claims; that this had apparently been its position before other courts where these claims had been considered[7];

[7]Thus in the *U. S. Rubber Co.* case the Circuit Court of Appeals for the Sixth Circuit stated that "each of the claims 5 to 9, inclusive," contain the limiting clause referring to "a plane passing through the rear upper edge and breast corners."

and that it did not change its position in this respect until after the Circuit Court of Appeals on the hearing in that court on the motion to dismiss had called attention to the omission of the word "rear." We concur in the finding of the District Judge that the omission of the word "rear" was through a clerical error due to oversight, and that both the counsel for the applicant and the examiner understood that it was contained in claim 8 as well as the others; and we are of opinion that the claim should be construed and have the same effect as if it had been included. This is not in any real sense, a re-making of the claim; but is merely giving to it the meaning which was intended by the applicant and understood by the examiner.

Furthermore, if by the omission of the word "rear" this claim should otherwise be regarded as calling for a lift whose upper face lies entirely below a plane passing through the entire "upper edge" and the breast corners, thereby making it a claim for a lift having all its upper edges in the same plane, such a construction would not only conflict with the express disclaimer of counsel for the applicant, but, as held by the Circuit Court of Appeals, render the claim invalid as being for a different invention from that described in the specification and drawings of the original patent. *Mahn* v. *Harwood*, 112 U. S. 354, 359; *Parker & Whipple Co.* v. *Yale Lock Co.*, 123 U. S. 87, 97. And, so construed, it would not read on the specification and drawings of the re-issued patent.

Having thus reached the conclusion that all of the claims in suit are limited to the three-point-contact form of lift, it is unnecessary to determine here whether in calling for a lift of concavo-convex form on every line of cross section, any of them are also limited to a "saucer-shaped", as distinguished from a "scoop-shaped", lift, that is, to one having in its upper surface a low spot centrally disposed which is below the lowest point in the breast edge, as has been held by the Circuit Courts of Appeals for the Sixth and Seventh Circuits.[8]

It is well settled that where an applicant for a patent to cover a new combination is compelled by the rejection of his application by the Patent Office to narrow his claim by the introduction of a

[8]Fetser & Spies Leather Co. *v.* I. T. S. Rubber Co., 260 Fed. 939, United States Rubber Co. *v.* I. T. S. Rubber Co., *supra*, 950, Tee Pee Rubber Co. *v.* I. T. S. Rubber Co., 268 Fed. 250, Hill Rubber Heel Co. *v.* I. T. S. Rubber Co., 269 Fed. 270, and I. T. S. Rubber Co. *v.* Tee Pee Rubber Co, 288 Fed. 794, in the Sixth Circuit; and United States Rubber Co. *v.* I. T. S. Rubber Co., 288 Fed. 786, in the Seventh Circuit.

new element, he cannot after the issue of the patent broaden his claim by dropping the element which he was compelled to include in order to secure his patent. *Shepard* v. *Carrigan*, 116 U. S. 593, 597. If dissatisfied with the rejection he should pursue his remedy by appeal; and where, in order to get his patent, he accepts one with a narrower claim, he is bound by it. *Shepard* v. *Carrigan, supra*, 597; *Hubbell* v. *United States*, 179 U. S. 77, 83. Whether the examiner was right or wrong in rejecting the original claim, the court is not to inquire. *Hubbell* v. *United States, supra*, 83. The applicant having limited his claim by amendment and accepted a patent, brings himself within the rules that if the claim to a combination be restricted to specified elements, all must be regarded as material, and that limitations imposed by the inventor, especially such as were introduced into an application after it had been persistently rejected, must be strictly construed against the inventor and looked upon as disclaimers. *Sargent* v. *Hall Safe & Lock Co.*, 114 U. S. 63, 86; *Shepard* v. *Carrigan, supra*, 598; *Hubbell* v. *United States, supra*, 85. The patentee is thereafter estopped to claim the benefit of his rejected claim or such a construction of his amended claim as would be equivalent thereto. *Morgan Envelope Co.* v. *Albany Paper Co.*, 152 U. S. 425, 429. So where an applicant whose claim is rejected on reference to a prior patent, without objection or appeal, voluntarily restricts himself by an amendment of his claim to a specific structure, having thus narrowed his claim in order to obtain a patent, he "may not by construction, or by resort to the doctrine of equivalents, give to the claim the larger scope which it might have had without the amendments which amount to a disclaimer." *Weber Elec. Co.* v. *Freeman Elec. Co.*, 256 U. S. 668, 677.

It results that as the claims in suit were limited by the proceedings in the Patent Office to the specific form of a three-point-contact lift, they are not infringed by the heels made by the Essex Company, which are not three-point-contact lifts, their upper side edges having no vertical curve and lying entirely in the same horizontal plane as the rear edge and breast corners. Nor can they be held to be infringements even if we assume that, as asserted, they function in the same manner as three-point-contact lifts, and would infringe, as was conceded in the District Court, if the claims were not restricted by the limiting clause and were entitled

to a construction warranting a wide range of equivalents. By the limitation of the claims in the Patent Office proceeding to the three-point-contact lift the patentee made this precise form a material element, and having thus narrowed the claims, cannot, as was said in the *Weber Electric Company* case, now enlarge their scope by a resort to the doctrine of equivalents. This would render nugatory the specific limitation.

The decree is accordingly

Affirmed.

A true copy.

Test:

Clerk, Supreme Court. U. S.